LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
FEB 8 1963
JOHN F. DAVIS, CLERK

# Supreme Court of the United States

OCTOBER TERM, 1962

No. 322

ALEXANDER T. SPERRY, *Petitioner*

v.

STATE OF FLORIDA, ex rel. THE FLORIDA BAR

On Writ of Certiorari To The
Supreme Court of the State of Florida

## RESPONDENT'S BRIEF

SHERWOOD SPENCER
1909 Tyler Street
Hollywood, Florida

J. LEWIS HALL
121½ E. Jefferson Street
Tallahassee, Florida

DONALD J. BRADSHAW
205 Bank of Inverness Building
Inverness, Florida

J. NIXON DANIEL, JR.
7th Floor, Brent Annex
Pensacola, Florida

JOHN HOUSTON GUNN
1534 duPont Building
Miami 32, Florida

*Counsel for Respondent*

F. TROWBRIDGE VOM BAUR
*Of Counsel*

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

# INDEX


| | Page |
|---|---|
| Opinion Below | 1 |
| Questions Presented | 1 |
| Constitutional and Statutory Provisions and Administrative Regulations | 4 |
| The Interest of the United States | 4 |
| Statement of the Case | 7 |
| 1. Petitioner's Acts in Florida | 9 |
| 2. The Injunction and Holding of the Court Is Only Partly Contested by Petitioner | 10 |
| 3. Summary of the Opinion Below | 11 |
| 4. The Decision Below Did Not Enjoin Petitioner "From Practice Before the Patent Office" | 13 |
| 5. Significance of the Fact that Petitioner "Holds Himself Out" to Practice Patent Law in Florida | 14 |
| Summary of Argument | 18 |
| Argument | 21 |
| Point One: The Florida Bar Is an Official Arm of the State System of Administration of Justice | 21 |
| Point Two: What Acts Constitute the Practice of Law in Florida Has Been Decided by the Florida Supreme Court as a Matter of State Law, and Should Be Accepted as Such by This Court | 24 |
| Point Three: The States, in the Exercise of the Police Power, Have the Right to Control and Regulate the Practice of Law | 25 |
| A. In General | 25 |
| B. The Fact That the Practice of Law Involves Federal Subject Matter Does Not Diminish the Power of the State to Regulate It | 26 |

Page

C. Admission to Practice Before a Federal Tribunal Does Not Entitle One to Practice Law in a Particular State ..... 28

1. Admission to Practice Before a Federal Court Does Not Entitle One to Practice in a Particular State ..... 28

2. Admission to Practice Before a Federal Administrative Agency Does Not Entitle One to Practice Law in a Particular State ..... 29

POINT FOUR: The Courts Vested With Judicial Power Have the Exclusive Right to Admit Persons to the Bar and to Disbar, and to Define What Constitutes the Practice of Law and to Exclude Unauthorized Persons Therefrom. The Legislature Has No Power to Authorize People to Practice Law .. 46

A. The Courts Vested With Judicial Power Have the Right to Admit to the Bar and to Disbar.. 46

B. "Authority to Admit to the Bar and to Disbar Necessarily Carries With It Power to Define What Constitutes the Practice of Law and to Exclude Unauthorized Persons Therefrom" .. 46

C. Neither the Legislature Nor an Administrative Agency May Authorize a Person to Practice Law Before the Agency ..... 47

POINT FIVE: Congress Has Not Attempted to Authorize the Commissioner to Authorize the Petitioner to Practice Law Relating to Patents, But Only to Prevent Incompetent and Disreputable Persons From Representing Inventors Before the Patent Office ..... 49

A. The Statute On Its Face Is Essentially of a Housekeeping Character and Does Not Purport to Authorize Anyone to Practice Law Relating to Patents ..... 49

B. Practice "Before" the Patent Office Means "in the Presence of the Patent Office" ..... 54

Page

C. In 1938 the Rules of the Patent Office Expressly Disclaimed Any Intention of "Authorizing Persons Not Members of the Bar to Practice Law" ..... 55

D. The Legislative History of § 487 Confirms the Housekeeping Character of the Statute ..... 58

E. Admission to Practice Before the Patent Office Does Not Entitle Petitioner to Practice Patent Law in the Federal Courts ..... 58

POINT SIX: If the Statute Could Be Construed to Mean That Congress Has Authorized the Commissioner to Authorize the Petitioner to Practice Law Relating to Patents in Florida, It Would Be Invalid as an Unconstitutional Delegation of Legislative Power ..... 60

POINT SEVEN: If the Statute Could Be Construed to Authorize the Commissioner to Authorize the Petitioner to Practice Law in Florida Relating to Patents, It Would Also Exceed the Powers Conferred on the Federal Government in the Constitution and Invade the Powers Reserved for the States by the Tenth Amendment ..... 66

A. Introduction ..... 66

B. Except for the Protection of an Inventor's Exclusive Right to an Invention, the Patent Clause of the Constitution and the Patent Laws Passed by Congress Are Subject to the Police Power of the States ..... 67

C. Even with Respect to an Inventor's Exclusive Right to an Invention, the State May Make "Reasonable Regulations" Concerning It .... 80

D. Even a Broad Grant of Power Such as the Right of Congress to Regulate Interstate Commerce, Can Be "Burdened" by the Police Power to Some Extent ..... 80

E. Cases Relied on by Petitioner Do Not Support Its Position ..... 82

Page

POINT EIGHT: The Necessary Effect of Petitioner's Claim Is to Seek to Inject a Host of Lay Practitioners Into the Practice of Law Throughout the States, to "Thwart the Control of the Courts Over the Practice of Law and Irreparably Impair the Sound Administration of Justice" ..... 84

POINT NINE: Preserving the Integrity of the Legal Profession and Practice of Law by Unqualified Persons Is a Matter of Vital Concern to the Public. A Strong Bar Is Positively Essential to the Public Welfare ..... 85

CONCLUSION ..... 94

APPENDIX ..... A-1

Constitution of the United States ..... A-1

Constitution of the State of Florida ..... A-1, A-2

Acts of Congress ..... A-2

Rules of Practice of the United States Patent Office in Patent Cases ..... A-4

(1) Rules of Practice, U. S. Patent Office, Edition of February 1, 1929 ..... A-4

(2) Current Rules of Practice ..... A-8

Current Trademark Rules of Practice of the U. S. Patent Office ..... A-14

## CITATIONS

**Cases:**

*Agran* v. *Shapiro* (1954), 127 Cal. App. 2d 807, 273 P. 2d 619 ..... 37

*Agran* v. *Shapiro* (Calif. Super. Ct., App. Dept. 1956), 22 Unauthorized Practice News No. 4, p. 34, Dec. 1956 ..... 43

*Allen* v. *Riley* (1906), 203 U.S. 347, 51 L. Ed. 216, 27 S. Ct. 95 ..... 20, 75, 80

*Appeal of Bailey* (Ohio App. 1956), 137 N.E. 2d 528 .. 48

*Auerbacher* v. *Wood* (1947), 139 N.J.E. 599, 53 A. 2d 800 ..... 29

Page

*Bigrow* v. *Hiatt* (D.Pa. 1947), 70 F. Supp. 826 ..... 55
*Bradwell* v. *Illinois* (1873), 16 Wall 130, 21 L. Ed. 442 19
*Bump* v. *District Court of Polk County* (1942), 232 Iowa 623, 5 N.W. 2d 914 ..... 46
*Chicago Bar Association* v. *Kellogg* (1949), 338 Ill. App. 618, 88 N.E. 2d 519 .....6, 12, 30
*Chicago Bar Association* v. *United Taxpayers of America* (1941), 312 Ill. App. 243, 38 N.E. 2d 349 ..... 48
*Clark* v. *Austin* (1937), 340 Mo. 467, 101 S.W. 2d 977.. 48
*Clark* v. *Reardon* (1937), 231 Mo. App. 666, 104 S.W. 2d 407 ..... 91
*Crown Die & Tool Company* v. *Nye Tool & Machine Works*, 261 U.S. 24, 67 L. Ed. 516, 43 S. Ct. 254 .. 79
*Cummings* v. *Missouri* (1867), 4 Wall. 277, 18 L. Ed. 356 ..... 25
*DePass* v. *B. Harris Wool Co.* (1940), 346 Mo. 1038 144 S.W. 2d 146 ..... 29
*Depew* v. *Wichita Ass'n of Credit Men* (1935), 142 Kan. 403, 49 P. 2d 1041, cert. denied 297 U.S. 710, 80 L. Ed. 997, 56 S. Ct. 574 ..... 29
*Emmons* v. *Smitt* (CA 6, 1945), 149 F. 2d 869, cert. denied, 326 U.S. 746, 90 L. Ed. 446, 66 S. Ct. 59 .... 26
*Ex Parte Davis* (1933), 333 Mo. 262, 62 S.W. 2d 1086, 89 A.L.R. 589 .....46, 55
*Ex Parte Garland*, 4 Wall. (1867) 333, 18 L. Ed. 366 .. 20
*Fox Film Corp.* v. *Royal* (1932), 286 U.S. 123, 76 L. Ed. 1010, 52 S. Ct. 542 .....78, 79
*Ginsburg* v. *Kovrak* (1958), 392 Pa. 143, 139 A. 2d 889 .....26, 28
*Goldsmith* v. *United States Board of Tax Appeals* (1926), 270 U.S. 117, 70 L. Ed. 494, 46 S. Ct. 215.. 49
*Greenough* v. *Tax Assessors* (1947), 331 U.S. 486, 91 L. Ed. 1621, 67 S. Ct. 1400 ..... 24
*Grievance Committee* v. *Coryell*, 190 S.W. 2d 130 (Tex. Civ. App. 1945) ..... 92
*Hexter Title & Abstract Co.* v. *Grievance Committee* (1944), 142 Tex. 506, 179 S.W. 2d 946 ..... 90
*Hoffmeister* v. *Todd* (Mo. 1961), 349 S.W. 2d 5 ..... 48
*Huron-Portland Cement Company* v. *City of Detroit* (1960), 362 U.S. 440, 4 L. Ed. 2d 852, 80 S. Ct. 813 81
*Hutchinson* v. *Stone* (1920), 79 Fla. 157, 84 So. 151 ... 55
*In Re Baker* (1951), 8 N.J. 321, 85 A. 2d 505 ..... 93

Page

*In Re Bercu* (1948), 273 App. Div. 524, 78 N.Y.S. 2d 209, 9 A.L.R. 2d 787, affirmed 299 N.Y. 728, 87 N.E. 2d 451 ..... 45
*In Re Gibbs* (Arizona 1929), 278 P. 371 ..... 45
*In Re Lockwood* (1894), 154 U.S. 116, 38 L. Ed. 929, 14 S. Ct. 1082 ..... 25
*In Re Lyon* (1938), 301 Mass. 30, 16 N.E. 2d 74 ..... 29
*In Re Murphy* (1947), 321 Mass. 206, 72 N.E. 2d 413 .. 55
*In Re Opinion of the Justices* (1935), 289 Mass. 607, 194 N.E. 313 ..... 46
*Johnson* v. *Maryland* (1920), 254 U.S. 51, 65 L. Ed. 126, 41 S. Ct. 16 ..... 82
*Jordan* v. *Overseers of Dayton*, 4 Ohio 295 ..... 72
*Kingsland* v. *Dorsey* (1950), 338 U.S. 318, 94 L. Ed. 123, 70 S. Ct. 123 ..... 83
*Leslie Miller, Inc.* v. *Arkansas* (1956), 352 U.S. 187, 1 L. Ed. 2d 231, 77 S. Ct. 257 ..... 82
*Long* v. *Rockwood* (1928), 277 U.S. 142, 72 L. Ed. 145, 48 S. Ct. 461 ..... 78, 80
*Martin* v. *Walton* (1961), 368 U.S. 25, 7 L. Ed. 2d 5, 782 S. Ct. 1 ..... 25
*McClurg* v. *Kingsland* (1843), 1 How. 202, 11 L. Ed. 102 ..... 67
*Mitchell* v. *Greenough* (CA 9, 1958), 100 F. 2d 184, cert. denied, 306 U.S. 659; 83 L. Ed. 1056, 59 S. Ct. 788 26
*Noble* v. *Hunt* (1957), 95 Ga. 804, 99 S.E. 2d 345 ..... 29
*Panama Refining Co.* v. *Ryan* (1935), 293 U.S. 388, 79 L. Ed. 446, 55 S. Ct. 241 ..... 62, 63
*Patterson* v. *Kentucky* (1879), 97 U.S. 501, 24 L. Ed. 1115 ..... 20, 68, 69, 72, 76
*People* v. *Goodman* (1937), 366 Ill. 346, 8 N.E. 2d 941 48
*People* v. *Lawyers Title Corp.* (1940), 282 N.Y. 513, 27 N.E. 2d 30 ..... 93
*People* v. *People's Stock Yards State Bank* (1931), 344 Ill. 462, 176 N.E. 901 ..... 46
*Petition of Florida State Bar Association*, 40 So. 2d 902 21
*Petition of Kearney* (Fla. 1953), 63 So. 2d 630 4, 11, 13, 28, 45
*Phillips* v. *Ballinger* (1916), 37 App. D.C. 46, 49, appeal dismissed *sub nom. Phillips* v. *Fisher* (1913), 229 U.S. 630, 57 L. Ed. 1358 ..... 49, 51

Page

*Randall* v. *Brigham* (1869), 7 Wall. 523, 19 L. Ed. 285 25
*Re Isserman* (1953), 345 U.S. 286, 97 L. Ed. 1013, 73 S. Ct. 676 ..... 25
*Re Summers* (1945), 325 U.S. 561, 89 L. Ed. 1795, 65 S. Ct. 1307 ..... 25
*Rhode Island Bar Assn.* v. *Automobile Serv. Assn.* (1935), 55 R.I. 122, 179 A. 139 .....46, 85
*Richmond Association of Credit Men* v. *Bar Association* (1937), 167 Va. 327, 189 S.E. 153 ..... 29
*Saier* v. *State Bar of Michigan* (CA 6, 1961), 293 F. 2d 756, cert. denied, 368 U.S. 947, 7 L. Ed. 2d 343, 82 S. Ct. 388 ..... 25
*Schecter Poultry Corp.* v. *United States* (1935), 295 U.S. 495, 79 L. Ed. 1570, 55 S. Ct. 837, 97 A.L.R. 947 .....63, 65
*Schware* v. *Board of Bar Examiners*, 353 U.S. 232 (1957), 1 L. Ed. 2d 796, 77 S. Ct. 752 ..... 25
*Stack* v. *P. G. Garage, Inc.* (1951), 7 N.J. 118, 80 A. 2d 545, 547 ..... 84
*Starr* v. *State Board of Law Examiners* (CA 7, 1947), 159 F. 2d 305 ..... 25
*State Ex. Inf. McKittrick* v. *C. S. Dudley & Co.* (1937), 340 Mo. 852, 102 S.W. 2d 895 ..... 29
*State ex rel. Daniel* v. *Wells* (1939), 191 So. Car. 468, 5 S.E. 2d 181 ..... 48
*State ex rel. Johnson* v. *Childe* (1941), 139 Neb. 91, 295 N.W. 381 ..... 47
*State ex rel. Wright* v. *Barlow*, 131 Neb. 284, 268 N.W. 95 (1936); 132 Neb. 166, 271 N.W. 282 (1937) .... 91
*State* v. *Murnane* (1927), 172 Minn. 401, 215 N.W. 803 55
*State* v. *Perkins* (1934), 138 Kan. 899, 28 P. 2d 765 ... 88
*State of Wisconsin* v. *Keller*, 16 Wis. 2d 377, 114 N.W. 2d 796 (1962), petition for certiorari filed Oct. 12, 1962, 31 U.S. Law Week 3104 (No. 429, Oct. Term, 1962) .....4, 48
*Theard* v. *United States* (1957), 354 U.S. 278, 1 L. Ed. 2d 1342, 77 S. Ct. 1274 .....19, 25, 46, 84
*Topliff* v. *Topliff* (1892), 145 U.S. 156, 36 L. Ed. 658, 12 S. Ct. 825 ..... 13
*United States* v. *Darby*, 312 U.S. 100, 85 L. Ed. 609, 61 S. Ct. 451, 132 A.L.R. 1430 ..... 81

Page

*Webber* v. *Virginia* (1881), 103 U.S. 344, 26 L. Ed. 565 20, 69, 73, 76
*West Virginia State Bar* v. *Earley* (1959), 144 West Va. 504, 109 S.E. 2d 420 ..... 85
*Wheaton and Donaldson* v. *Peters and Grigg* (1834), 8 Pet. 591, 8 L. Ed. 1055, 1080 ..... 68

**Opinions of the Attorney General:**

13 Ops. Att'y Gen. 150 ..... 53
16 Ops. Att'y Gen. 488 (1880) ..... 49, 52

**Constitution, Statutes and Regulations:**

Constitution of the United States:
Article I, Section 8, clause 8 ..... 20, 33, 67, 68, 74, 79, App. A-1
Article I, Section 8, clause 18 ..... App. A-1
Article VI, clause 2 ..... App. A-1
Amendment X ..... App. A-1

Constitution of the State of Florida:
Article II ..... App. A-1
Article V, § 1 ..... App. A-2
Article V, § 23 ..... 22, App. A-2

The Integration Rule of the Supreme Court of Florida, Section 2, Article II ..... 22, App. A-2
Section 487 of the Revised Statutes, as amended by § 3 of the Act of Feb. 18, 1922, 42 Stat. 390, 35 U.S.C. § 11 (1946) ..... 49, 51, 52, 53, 54, 56-58, App. A-2
Section 483 of the Revised Statutes, as amended, 35 U.S.C. § 6 (last sentence) ..... App. A-3
Section 161 of the Revised Statutes, 5 U.S.C. § 22 ... 52, 53
Act of July 4, 1884, § 5, 23 Stat. 101, 5 U.S.C. § 493 50, 51, 52
Act of July 7, 1884, § 3, 23 Stat. 258, 5 U.S.C. § 261 38, 39, 50, 51
Act of June 10, 1921, 42 Stat. 25, § 311(f), 31 U.S.C. § 52(f) ..... 76

5 U.S.C. § 22 ..... 52, 53
5 U.S.C. § 261 ..... 38, 39, 50, 51
5 U.S.C. § 493 ..... 50, 51, 52
18 U.S.C. § 3182 ..... 55

Page

31 U.S.C. § 52(f) ..... 51
35 U.S.C. § 31 ..... 49, 57
35 U.S.C. § 32 ..... 49, 57
35 U.S.C. § 33 ..... App. A-1

**Rules of Practice of the Patent Office:**

Rule 17 ..... 31, 34, 35, 56, 57, 61, App. A-4, A-5, A-6
Rules 18-21 ..... App. A-6, A-7
Rule 341 ..... 57, 61, App. A-8, A-9, A-10
Rule 347 ..... 18 n. 2

Trademark Rule 2.12(d) ..... 57, App. A-15
37 C.F.R. §§ 1.31, 1.341-1.348 ..... App. A-8 to A-14
37 C.F.R. §§ 2.11-2.18 ..... App. A-14 to A-17
31 C.F.R. § 10.2(f) ..... 39, 42, 43
Rules of Practice of the United States Court of Customs and Patent Appeals, Rule 11 ..... 58

# Supreme Court of the United States

OCTOBER TERM, 1962

---

No. 322

---

ALEXANDER T. SPERRY, *Petitioner*

v.

STATE OF FLORIDA, ex rel. THE FLORIDA BAR

---

**On Writ of Certiorari To The Supreme Court of the State of Florida**

---

## RESPONDENT'S BRIEF

---

### OPINION BELOW

The opinion of the Supreme Court of the State of Florida (R. 51-68) is reported at 140 So. 2d 587.

### QUESTIONS PRESENTED

In 1928 Petitioner, a non-lawyer, was "recognized" by the Commissioner of Patents as "a person representing applicants or other parties before his office." In 1958, after practicing in several other jurisdictions, he moved to Tampa, Florida. There he proceeded to "hold himself out to the public as authorized to engage

in the practice of law in the patent field" (R. 2), to give opinions as to patentability and infringement of licenses, acts in Florida which, the Court below held, in an original proceeding brought by the Florida Bar, constitute the practice of law. Petitioner now claims that, by virtue of having been "recognized" by the Patent Office in Washington, D. C., he has a federal license to practice law relating to patents and trademarks in Florida, and to perform some but not all of the acts enjoined by the Florida Supreme Court.

The questions presented are:

1. Did Congress attempt to authorize the Commissioner of Patents to authorize the Petitioner to practice law relating to patents and trademarks in *Florida* by virtue of the provisions of section 487 of the Revised Statutes as amended by section 3 of the Act of February 18, 1922, 42 Stat. 390, which authorized the Commissioner to prescribe rules "governing the recognition of agents, attorneys or other persons representing applicants or other parties . . . in the presentation or prosecution of their applications or other business before" the Patent Office, and to "suspend or exclude . . . from further practice before his office any person, agent, or attorney shown" not to meet specified standards of conduct?

2. Did the Commissioner of Patents attempt to authorize Petitioner to practice law relating to patents and trademarks in *Florida* by virtue of the entry in 1928 of Petitioner's name on a "register" in the Patent Office in Washington, D. C., of "all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patents"?

3. If the statute and action of the Commissioner could be construed to amount to an attempted authorization to Petitioner to practice law relating to patents and trademarks in *Florida*, would the statute then be constitutional as a proper delegation of legislative power, in view of the fact that (a) the subject of authority to regulate the practice of law is not even mentioned as the subject of delegation, and (b) there is a complete absence of standards in the statute as to when, how or whether the Commissioner should authorize anyone to practice law?

4. If the statute and action of the Commissioner could be construed to amount to an attempted authorization to Petitioner to practice patent and trademark law in Florida, would the statute then be unconstitutional as an invasion of the province of the judiciary under Article III of the Constitution, the judiciary alone having power to admit persons to the bar and to disbar, and to define what constitutes the practice of law and to exclude unauthorized persons therefrom?

5. If the statute and action of the Commissioner could be construed to authorize Petitioner to practice law relating to patents and trademarks in Florida, and the obstacles stated in questions 3 and 4 could be overcome, then should not the statute be accommodated to the decision below, inasmuch as the statute bears no real relation to, and the decision below does not interfere with, the only power concerning patents granted by the States to the Federal government—protecting the exclusive right to an invention—(for "it is only the right to the invention or discovery, the incorporeal right, which the state cannot interfere with" *Webber* v. *Virginia* (1881), 103 U.S. 347, 26 L.Ed. 565)?

## CONSTITUTIONAL AND STATUTORY PROVISIONS AND ADMINISTRATIVE REGULATIONS

Pertinent provisions of the Constitution of the United States and of the Constitution of the State of Florida, and Section 2, Article II of the Integration Rule of the Supreme Court of Florida, relating to the control of the practice of law in Florida by the Florida Supreme Court, are set forth in the Appendix.

Also set forth in the Appendix are the statutes relating to the "recognition" of persons before the Patent Office, and the regulations of the Commissioner of Patents relating thereto.

## THE INTEREST OF THE UNITED STATES

In the brief of the United States as Amicus Curiae, it is stated that "The decision below threatens to interfere with the operation of various departments and agencies of the United States." (Brief, p. 2) We submit that the decision below does not have any such effect. Although the Solicitor General states that the decision below "prohibits such Patent Office practice" (Brief p. 2), we do not believe this fairly describes the decision below. The decision below expressly disclaimed any intention to interfere with "practice before the Patent Office."

In addition, the United States asserts, by reference to a Patent Office publication, that "of the 7,544 persons registered to practice before it, 1,801 were not members of any bar and 1,687 were not members of the bar of the state in which they were practicing. Thus 3,488 practitioners would be immediately affected by the ruling in the instant case and others like it, if it were to be followed. See *Petition of Kearney*, 63 So. 2d 630 (Fla); *Cf. State of Wisconsin* v. *Keller*, 16 Wis. 2d 377, 114 N.W. 2d 796, 801." (Brief p. 3).

The statements in the foregoing paragraph are in error for the following reasons:

1. It is common knowledge that, by virtue of the location of the Patent Office, there is a concentration in the District of Columbia of patent practitioners who are not members of the District of Columbia Bar. And Rule 96 of the Rules of the U. S. District Court for the District of Columbia provides specifically that the prohibition against the practice of law by persons not members of the D. C. Bar "shall not apply to practice before other federal Courts or executive departments, Government boards, commissions, or agencies, or to the holding out of the right to practice before such other federal Courts or executive departments or Government boards, commissions or agencies." Thus this Rule permits persons not members of the D. C. Bar to engage, in the District of Columbia, in so-called "administrative practice," including practice before the Patent Office, without being members of the D. C. Bar. Accordingly, the decision below could not presently have the slightest effect on the group of non-lawyer practitioners before the Patent Office located in the District of Columbia.

2. The statement that non-lawyer patent practitioners, not located in Florida, would be "immediately affected by the ruling in the instant case and others like it, if it were followed," is not clear. No non-lawyer practitioner in any state other than Florida would be affected in the slightest unless the Supreme Court of the particular state, after the institution and conclusion of the necessary litigation, should render a decision similar to the decision below. Even then, such a decision would not interfere with the non-lawyer's right to practice before the Patent Office it-

self. Moreover, it is noteworthy that over 10 years elapsed between the decision in a strikingly similar case, *Chicago Bar Association* v. *Kellogg* (1949), 338 Ill. App. 618, 88 N.E. 2d 519, and the institution of the instant lawsuit. In addition, the instant lawsuit would never have been brought had not the petitioner moved to Florida in 1958 and then proceeded to hold himself out to the public as entitled to practice law in the patent field in Florida.

3. Finally, as set forth *post*, p. 15-18, with respect to similar representations made in Petitioner's brief, even if the Florida decision were to be followed in all the States, the number of practitioners who would be affected—those holding themselves out to practice patent law—would only be a minute fraction of the 3,488 practitioners which the United States claims would be affected.

The United States also asserts (p. 3) that "It is worth noting that some of these registered lay practitioners are presently employed in the 'patents sections' of the several Military Services and that they perform duties within the territorial jurisdiction of the several states. If the ruling here reaches them, the national defense establishment will be affected." We do not believe the concern expressed for the "national defense establishment" has substance. So far as we know, no one has ever attempted to prevent an official who is in the Executive Branch of the Government and in the flow of power of the President under Article II of the Constitution, from performing the duties of his office, on the ground that he was engaged in the unauthorized practice of law. In addition, Florida became a Territory of the United States in 1828, and a State in 1845. It has always had military installations and, so far as

we know, no Florida official has ever attempted to interfere with the work of any military lawyer. Moreover, no such government official is involved in this case. The statement that "If the ruling here reaches them" is outside the issues, unrealistic conjecture.

## STATEMENT OF THE CASE

### 1. Petitioner's Acts in Florida

Petitioner began work in the field of patents as a patent searcher (R. 8). On January 12, 1928 (R. 8), his name was entered on the "Register" of the Patent Office as a "Patent Attorney," thus becoming "recognized" [1] by the Patent Office under the applicable statutory provision, as a "person representing applicants or other parties before his office". At that time, Petitioner listed himself on the records of the Patent Office as a resident of New York City. The Patent Office records also show that he moved to Washington, D. C., in 1944, and that in 1951 he shifted his residence to California.

In 1958, according to the same records of the Patent Office, Petitioner moved to Florida. He is not a lawyer; and he never became a member of the Florida Bar. Nevertheless, he proceeded to establish an office on the 8th Floor of the First National Bank Building in Tampa, Florida, with "Patent Attorney" advertised on the entrance door of his office. In addition, he caused himself to be listed in the August 1960 Yellow Pages of the local telephone directory as a "Patent Attorney" (R. 2).

---

[1] At that time a candidate for such "recognition" did not have to take an examination of any kind. Rather he was registered on the basis of affidavits as to his proficiency from those with whom he had worked. For the shortcomings of that practice, see the Brief of the American Bar Association as *Amicus Curiae*, App. C, p. C-6, footnote.

Promptly thereafter, in February 1961, Respondent The Florida Bar filed the "Petition for Rule to Show Cause" wherein it was alleged that by virtue of the acts above stated Petitioner here (respondent below) "holds himself out to the public as authorized to engage in the practice of law in the patent field" (R. 2). This allegation was not denied in Petitioner's Answer to the Petition and was therefore admitted.

More specifically, it was also alleged that Petitioner had, in Florida, rendered opinions as to patentability; had rendered infringement opinions advising clients as to whether existing patents provide a basis for a cause of action in the Federal Court; and had prepared numerous legal instruments including contracts, and applications for amendments to applications for letters patent, and has prepared briefs and authorities, etc. (R. 2, 3).

In his Answer and Defenses, Petitioner admitted "that he has held himself out as a 'Patent Attorney'" at his office in Tampa, and has caused his name "to similarly appear in the classified directory." (R. 6). However, after the litigation started, he discontinued holding himself out as a "Patent Attorney" (R. 7). But he did not discontinue doing legal work in the patent field. He admitted that, during the short time in which he had conducted operations in Florida, "he has rendered opinions as to patentability," and that "he has prepared and filed before the United States Patent Office applications for patents and amendments thereto and patent assignments." He admitted that he had "on one occasion advised a client as to whether an issued patent furnishes a basis of a cause of action for patent infringement, but says on that occasion the infringement opinion was part of his work in filing a

patent application for the client." He further admitted that he "has formulated license agreements in rough form, but states that he has never prepared a finished patent license." He denied that he has prepared "various contracts," except as previously admitted, and he denied that he had prepared "briefs and authorities with points and law relating thereto" (R. 7).

Petitioner also admitted that he "has likewise engaged in all phases of trademark practice before the United States Patent Office," (R. 8) even though the Rules of the Patent Office expressly forbid one not a lawyer from engaging in trademark practice when held by a state to be the unauthorized practice of law. A discussion of such trademark practice is presented in Appendix B of the brief of the American Bar Association as *amicus curiae*, 2 B 15-18.

As a result of the admissions in the Answer and Defenses, The Florida Bar promptly made a motion for summary decree in the Supreme Court of Florida, stating that Petitioner "had admitted performing all acts which The Florida Bar alleges are acts of unauthorized practice of law except that he denies that he has prepared various contracts and denies that he has prepared briefs; accordingly, your petitioner [Respondent in this Court] respectfully withdraws from the consideration of this Court the statements in its Petition charging Respondent with preparing contracts and briefs so as to enable the Court to have before it uncontradicted questions of fact." On the basis of this motion oral argument was had in the Supreme Court of Florida on 14 June 1961. Except for the allegations with respect to "preparing contracts and briefs" the allegations of the Petition of the Florida Bar were taken as admitted.

**2. The Injunction and Holding of the Court is Only Partly Contested By Petitioner**

The Court enjoined Petitioner from the following activities "*in this State*" (R. 67):

> "1. using the term 'patent attorney' or holding himself out to be an attorney at law in this state in any field or phase of the law (we recognize that the respondent according to the record before us has already voluntarily ceased the use of the word 'attorney');
>
> "2. rendering legal opinions, including opinions as to patentability or infringement of patent rights;
>
> "3. preparing, drafting and construing legal documents;
>
> "4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;
>
> "5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and
>
> "6. otherwise engaging in the practice of law."

The Court also stated that "*An issuance of an injunction*" *will not* "*in any way affect his right to practice before the Patent Office in Washington, D. C.*"

Petitioner does not contest the entire decree. Thus, he does not contest item 1 enjoining him from "using the term Patent Attorney or holding himself out to be an attorney at law in this State . . ." To the same effect, see the brief of the United States, page 20. Also, Petitioner does not contest item 3 enjoining him from "preparing, drafting and construing legal documents," including license agreements. And he does not contest item 6 of the injunction against otherwise engaging in the practice of law. Despite these accepted injunctive

provisions, however, he contends in this Court that he should be permitted to hold himself out as qualified to prepare patent applications, and to render legal opinions, including opinions as to patentability or infringement on patent rights.

### 3. Summary of the Opinion Below

The Florida Supreme Court entered its opinion and judgment on April 4, 1962 (R. 13-30). A Petition for Rehearing was denied on May 15, 1962 (R. 51), and the original opinion was then corrected to omit reference to a decision of a trial court in Ohio which had been reversed by an intermediate court in Ohio, and which is now on appeal to the Supreme Court of Ohio (R. 19, 31, 57).

So far as here pertinent, the decision below held *first*, in line with other state cases, that the judicial power to admit to the Bar and to disbar carries with it the power to prevent the practice of law by those who were not admitted to such practice (R. 53, 54). This power is enforceable by either contempt proceedings or injunction.

*Second*, the Court held that the "acts committed by the Respondent constituted the practice of law." (R. 55) In so holding, the Court followed a strikingly similar case, *Petition of Kearney* (Fla. 1953), 63 So. 2d 630. In that case Kearney, who was admitted to practice before the Supreme Court, the Tax Court, and the Treasury Department, but not the Florida Bar, had sought permission to hold himself out to practice in Florida as "Federal Tax Counsel," with his Court appearances to be limited to the Federal Courts and the Departments above mentioned. The Court held that the activity involved constituted one phase of the

practice of law in Florida, and that in order to so hold himself out and practice, Kearney would have to become a member of the Florida Bar under Section 2, Integration Rule.

The Court also cited a similar patent case, *Chicago Bar Association* v. *Kellogg*, (1949), 338 Ill. App. 618, 88 N.E. 2d 519, where Kellogg, who was not a lawyer, but was admitted to practice before the United States Patent Office, was enjoined from practicing law relating to patents in Illinois, though without prejudice to his right to practice before the United States Patent Office.

*Third*, the Court pointed out that the respondent had made the argument that the practice of "patent law" is not the "practice of law" (R. 58). But the Court rejected that argument, holding, in line with the other State cases that it is "*the character of the acts themselves*" which determine whether they constitute the practice of law (R. 58). Accordingly, the Court held that the practice of "patent law" is the "practice of law."

More specifically, the Court pointed out that

> "one who *holds himself out* to the public in this state as qualified to advise as to patentability and does so is engaging in the practice of law. The same is true of the act of advising as to the infringement of patent rights. Both require extensive knowledge of the law, statute and case, in a field of the law that is as technical and involved as any known today." (Emphasis added.)

The Court then went on to cite legal authorities to the effect that

> "The specifications and claims of a patent constitute one of the most difficult legal instruments to draw with accuracy."

quoting from *Topliff* v. *Topliff* (1892), 145 U.S. 156, 36 L.Ed. 658, 12 S.Ct. 825. And the Court accordingly held that the preparation of applications for patents, and amendments thereto, among the other acts, constitute the practice of law.

*Fourth*, the Court answered in the negative the question "whether the respondent, by virtue of his admission to practice before the Patent Office as a patent attorney, has the right to do these things in this state without admittance to The Florida Bar." After pointing out at some length and in some detail the legal character of applications for patents (R. 59-62), the Court followed the *Kearney* case, in which "we held that anyone who *holds himself out* to practice 'in any field or phase of the law' must be a member of The Florida Bar." (Emphasis added.)

#### 4. The Decision Below Did Not Enjoin Petitioner "From Practice Before the Patent Office"

Now, in this Court, however, Petitioner asserts strenuously that the decision below "has denied him" the "right" "to practice before the Patent Office." Petitioner's brief, p. 9. It is also asserted on the same page that "The present case is the first time that any state has ever held that patent agents could not practice before the Patent Office, . . ." Similar statements abound in Petitioner's brief, pp. 2, 7, 10, 11, and there is at least one comparable statement in the brief of the United States as *amicus curiae* where it is said that the question presented is "whether a state may prohibit such Patent Office practice . . ." (brief p. 2). In our view, however, these assertions do not fairly describe the decision below.

Also, the Court below did *not*, as asserted in the brief for Petitioner (p. 7), hold that "even though the Patent Office had licensed petitioner to practice before it, the state's police power permits it 'to deny [him] the right to so practice' in Florida (R. 55)." A fair reading of the paragraph in question shows that what the Court meant by "practice" was not the right to "practice before the Patent Office," but the right to "*practice law in Florida.*" Moreover, the implication given by this assertion of Petitioner is rebutted elsewhere in the Opinion (R. 67), and is unsupportable.

For the fact is that the Florida Supreme Court went out of its way to make clear that it was not in any sense endeavoring to interfere with Petitioner's right to practice before the Patent Office, saying that "*The issuance of an injunction . . .*" *will not* "*in any way affect his right to practice before the Patent Office in Washington, D. C.*" (Emphasis added.)

**5. Significance of the Fact That Petitioner "Holds Himself Out" to Practice Patent Law in Florida**

In the foregoing discussion we have purposely emphasized the phrase "*holding himself out*", which appears in eleven different places in the decision below. This repeated use of the phrase shows that the Florida Supreme Court was not concerned with activities of patent practitioners in Florida who do not hold themselves out to the public as entitled to practice patent and trademark law, such as full-time employees of corporations, government officials, etc.; and that the Court carefully confined its decision, in line with the allegations of the Petition for a Rule to Show Cause, to the case of a patent practitioner in Florida who admittedly "*holds himself out* to the public as authorized to engage

in the practice of law in the patent field" (R. 2). (Emphasis added.)

That is the only type of practitioner involved in this case. And in this connection it is noteworthy that Petitioner's brief suggests that the decision below provides a direct precedent for enjoining the activities of 62 of the 73 patent practitioners who have given the Patent Office a Florida mailing address. But the fact is that of the 73 patent practitioners there listed, The Florida Bar records show that 16 are members of The Florida Bar. Of the remaining 57, only 3, in addition to Sperry, appear to be "holding themselves out" to the public as entitled to practice patent law in Florida, by advertising in the Classified Telephone Directory in various Florida cities.

In summary, excluding Sperry, 16 out of 19, or 82.6 per cent of those who are "holding themselves out" to the public as entitled to practice patent law in Florida, are members of the Florida Bar. The remaining 53 practitioners, excluding Sperry also, are apparently either (1) enjoying their retirement in the Florida sunshine, or (2) enjoying full time employment in the patent departments of corporations, governmental agencies or other organizations, ordinarily working under the supervision of a patent lawyer. There is no reason to believe on this record that they are holding themselves out to the public as entitled to practice patent law, or that the decision below can affect them.

In addition, the marked difference between the true facts about the number of persons who are improperly "holding themselves out" in Florida and the Petitioner's suggestion that the decree will lead to enjoining 62 out of 73 Florida "practitioners", serves to demonstrate Petitioner's fundamental error in his in-

terpretation of the source of material for his statistics. The Department of Commerce booklet, "Patent Attorneys and Agents Available to Represent Inventors Before the United States Patent Office," which Petitioner states is his authority for his representation, is merely a published list of all persons who (1) have been recognized by the Patent Office and (2) have never specifically advised the Patent Office that they are *not* available to represent the inventor.

Yet there are practitioners who accept full time employment which precludes their representing applicants. Others retire, or die; and neither group is bound by any rule or custom to advise the Patent Office of this fact. Accordingly, it is plain that this list cannot be construed as a list of practitioners who are "holding themselves out" to the public in the communities which that publication lists as their residence. Indeed, the publication itself acknowledges this in its "Foreword," which states:

> "The list includes all registrants who have not informed the Patent Office that they are employees of the United States Government or full-time employees of corporations."

Moreover, it must be noted that while the Rules[2] require a lawyer, who has been duly recognized as a patent attorney, to advise the Patent Office when he changes his address, there is no parallel requirement that the Office be advised when the attorney secures admission to the local bar of his new residence. That being the case, the Patent Office records concerning bar membership cited by the Petitioner are only competent to establish the initial bar membership of a given reg-

[2] Rule 347, Rules of Practice of the United States Patent Office in Patent Cases (37 C.F.R. § 1.37).

istered practitioner as opposed to the sum total of his bar affiliations.[3]

The Petitioner makes precisely the same error when he represents (brief p. 36) that the 3,307 practitioners (over 45 per cent of the sum total of recognized patent practitioners) who are not listed in the Patent Office as being members of the Bar of the states where they reside will be adversely affected by a universal application of the holding of the Florida court.[4] For the Patent Office does not itself know how many of its practitioners are "holding themselves out." It does not know how many of its practitioners are engaged in full-time employment with various types of organizations. It does not know how many of its practitioners have joined the Bars of the jurisdictions wherein they now reside. Finally, it does not know how many of its practitioners have retired, or died. Accordingly, there is no conceivable way to support any of the figures suggested by the Petitioner or by the United States. But we think it fair to say that even a universal application of the decision below throughout the States would affect only a minute percentage of the estimates suggested by the briefs of the Petitioner and the United States—only those who are "*holding themselves out*" to the public as lawyers entitled to practice law relating to patents.

[3] For example, according to the records of The Florida bar and the Patent Office, four of the 16 Florida patent lawyers (25%) had moved to Florida since their recognition by the Patent Office and had never had occasion to advise the Patent Office of the fact that they had joined the Florida bar.

[4] The Brief of the United States makes a similar representation, but with a slightly different number being quoted. "Thus, 3488 practitioners would be immediately affected by the ruling in the instant case and others like it, if it were followed." (p. 3)

## SUMMARY OF ARGUMENT

Contrary to the assertions of Petitioner and the United States, the Court below did *not* enjoin Petitioner from "practice before the Patent Office." It did enjoin him from performing certain acts in Florida which do not constitute practice before the Patent Office.

Moreover, Petitioner does not contest the entire decree, particularly those items enjoining him from holding himself out as a "Patent Attorney," preparing, etc. legal documents generally, or otherwise practicing law. But the necessary thrust of Petitioner's contention is that he has a federal license, by virtue of having been "recognized" by the Patent Office, to do the other things enjoined by the decree, that is, to prepare patent applications in Florida and give legal opinions in Florida, as to patentability and infringement, and to hold himself out as qualified to do so.

Thus Petitioner contends that, although not a lawyer, he should be permitted to practice law relating to patents—outside the Courtroom—in Florida. While the practice of law by unqualified persons inside the Courtroom was a problem in early English and American history, today the main problem area of unauthorized practice, following the industrial revolution and the Civil War, is the practice of law by unqualified persons *outside* the courtroom. See the brief of the American Bar Association as amicus curiae, pp. 4, 25.

Petitioner's contention should be rejected for the following reasons:

First, only the States, in the exercise of the police power, have the right to control and regulate the practice of law. This right stems from a lawyer's relation to the responsibilities of a Court, and is part of the

system of administration of justice of the State. *Bradwell* v. *Illinois* (1873), 16 Wall 130, 21 L.Ed. 442; *Theard* v. *United States* (1957), 354 U.S. 278, 281, 1 L.Ed. 2d 1342, 77 S.Ct. 1274. Moreover, where the judicial power is vested in the Courts, neither the State legislature nor an administrative agency has power to authorize people to practice law. Also what constitutes the practice of law in a particular State is a matter of State law, not subject to review by this Court. Accordingly, the acts which the decision below found to constitute the practice of law in Florida should be accepted as such by this Court.

The fact that the practice of law involves federal matters does not diminish the power of the States to regulate the practice of law, and the fact that a person may be admitted to practice before this or other federal Courts, or a federal administrative tribunal, confers no right to practice law in a State.

*Second,* in our case Congress has not, in the 1922 statute providing for "recognition" of persons entitled to represent applicant before the Patent Office, attempted to authorize the Commissioner of Patents to authorize the Petitioner to perform acts constituting the practice of law relating to patents in Florida. Nor has the Commissioner attempted to so authorize the Petitioner.

*Third,* if it could be claimed that both Congress in the statute and the Commissioner have attempted to authorize the Petitioner to practice patent law in Florida, then the statute would be unconstitutional on several grounds.

A. It would be an unconstitutional delegation of legislative power, inasmuch as the "practice of law" is not defined in the statute as the subject matter of any attempted delegation of power with respect thereto,

and there is a complete absence of standards as to when, whether, how or on what basis the Commissioner should authorize the Petitioner to practice law.

B. Neither Congress nor a federal administrative agency may authorize anyone to practice law in the federal field or elsewhere. The power to admit to the bar and to disbar, and to define what constitutes the practice of law and to exclude unauthorized persons therefrom is a *judicial* power, vested in that branch of the Government in which the judicial power is vested. See *Ex Parte Garland* (1867), 4 Wall. 333, 18 L.Ed. 336. In the Constitution of the United States the judicial power is vested in this Court and other federal Courts. Accordingly, in the Federal field only the Courts may authorize people to practice law. Any attempt by Congress or an administrative agency to authorize people to practice law would be a nullity.

C. In Article I, section 8, the States conferred upon the Federal Government only very limited power relating to discoveries. The only real power conferred is the right to "secure," that is, to "shield," "guard" or "protect" the exclusive right to discoveries. So long as a State does not unreasonably interfere with that right, the patent laws passed by Congress are "subject to" the State police power. *Patterson* v. *Kentucky* (1879), 97 U.S. 501, 24 L.Ed. 1115; *Webber* v. *Virginia* (1881), 103 U.S. 344, 26 L.Ed. 565; *Allen* v. *Riley* (1906), 203 U.S. 347, 51 L.Ed. 216, 27 S.Ct. 95. The decision below certainly does not unreasonably interfere with that right—indeed, it does not interfere with it at all. Accordingly, if it could be claimed that the statute in question attempted to authorize Petitioner to practice law relating to patents in Florida, then it would exceed the power conferred on Congress and invade the police power of the States.

## ARGUMENT

### POINT ONE

### THE FLORIDA BAR IS AN OFFICIAL ARM OF THE STATE SYSTEM OF ADMINISTRATION OF JUSTICE

In September, 1947, the Florida State Bar Association, a voluntary Bar Association, canvassed the then 2700 lawyers of the State who reported that a majority of them were in favor of organizing the bar into a unified body and an official arm of the Supreme Court. The Florida Supreme Court then issued an order, *Petition of Florida State Bar Association* (1949), 40 So. 2d 902, organizing all of the lawyers of Florida into a single organization known as the Florida Bar. It now has in excess of 8000 members.

In the course of its opinion, the Florida Supreme Court noted that this action was taken in the exercise of the police power, specifically exercisable by that Court in which the judicial power of the State is vested. The court, among other things, said:

> "[6] . . . While the police power is generally considered an exclusive power of the legislature, it may for reasons not necessary to detail here, be exercised by the Courts."
>
> * * * * * * * * *
>
> "[10] . . . We think the independence of the judiciary is something more than a tinkling cymbal, in fact, we think it means that in those matters which are purely and essentially judicial the judiciary may chart its course without interference from other departments. . . ."

The Florida Supreme Court thereafter adopted a rule for the organization of the Florida Bar known as the Integration Rule, 31 Florida Statutes Annotated

Pages of the local telephone directory as a "Patent Attorney" (R. 2).

Promptly thereafter, in February 1961, Respondent The Florida Bar filed the "Petition for Rule to Show Cause" wherein it was alleged that by virtue of the acts above stated the Petitioner here (respondent below) "holds himself out to the public as authorized to engage in the practice of law in the patent field" (R. 2). This allegation was not denied in Petitioner's Answer to the Petition and was therefore admitted.

More specifically, it was also alleged that Petitioner had, in Florida, rendered opinions as to patentability; had rendered infringement opinions advising clients as to whether existing patents provide a basis for a cause of action in the Federal Court; and had prepared numerous legal instruments including contracts, and applications for amendments to applications for letters patent, and has prepared briefs and authorities, etc. (R. 2, 3).

In his Answer and Defenses, Petitioner admitted "that he has held himself out as a 'Patent Attorney' " at his office in Tampa, and has caused his name "to similarly appear in the classified directory" (R. 6). However, after the litigation started, he discontinued holding himself out as a "Patent Attorney" (R. 7). But he did not discontinue any legal work in the patent field. He admitted that, during the short time in which he had conducted operations in Florida, "he has rendered opinions as to patentability," and that "he has prepared and filed before the United States Patent Office applications for patents and amendments thereto and patent assignments." He admitted that he had "on one occasion advised a client as to whether an

issued patent furnishes a basis of a cause of action for patent infringement, but says on that occasion the infringement opinion was part of his work in filing a patent application for the client." He further admitted that he "has formulated license agreements in rough form, but states that he has never prepared a finished patent license." He denied that he has prepared "various contracts," except as previously admitted, and he denied that he had prepared "briefs and authorities with points and law relating thereto" (R. 7).

Petitioner also admitted that he "has likewise engaged in all phases of trademark practice before the United States Patent Office" (R. 8), even though the Rules of the Patent Office expressly forbid one not a lawyer from engaging in trademark practice when held by a state to be the unauthorized practice of law. A discussion of such trademark practice is presented hereinafter, Appendix B, pp. B-15-18.

As a result of the admissions in the Answer and Defenses, The Florida Bar promptly made a motion for summary decree in the Supreme Court of Florida, stating that Petitioner "had admitted performing all of the acts which The Florida Bar alleges are acts of unauthorized practice of law except that he denies that he has prepared various contracts and denies that he has prepared briefs; accordingly, your Petitioner [Respondent in this Court] respectfully withdraws from the consideration of this Court the statements in its Petition charging Respondent with preparing contracts and briefs so as to enable the Court to have before it uncontradicted questions of fact." (R. 11). On the basis of this motion oral argument was had in the Supreme Court of Florida on 14 June 1961. Except

for the allegations with respect to "preparing contracts and briefs" the allegations of the Petition of the Florida Bar were taken as admitted.

**2. Summary of the Decision Below**

The Florida Supreme Court entered its opinion and judgment on April 4, 1962 (R. 13-30). A Petition for Rehearing was denied on May 15, 1962 (R. 51), and the original opinion was then corrected to omit reference to a decision of a trial court in Ohio which had been reversed by an intermediate court in Ohio, and which is now on appeal to the Supreme Court of Ohio (R. 19, 31, 57).

The decision below may be summarized as follows:

*First,* in line with other state cases, the Court held that the judicial power to admit to the Bar and to disbar carries with it the power to prevent the practice of law by those who were not admitted to such practice (R. 53, 54).

*Second,* the Court held that the "acts committed by the Respondent constituted the practice of law." (R. 55) In so holding, the Court followed a strikingly similar case, *Petition of Kearney* (Fla. 1953), 63 So. 2d 630. In that case Kearney, who was admitted to practice before the Supreme Court, the Tax Court, and the Treasury Department, but not the Florida Bar, had sought permission to hold himself out to practice in Florida as "Federal Tax Counsel," with his Court appearances to be limited to the Federal Courts and the Departments above mentioned. The Court held that the activity involved constituted one phase of the practice of law in Florida, and that in order to so hold himself out and practice, Kearney would have to become a member of the Florida Bar under Section 2, Integration Rule.

The Court also cited a similar patent case, *Chicago Bar Association* v. *Kellogg* (1949), 338 Ill. App. 618, 88 N.E. 2d 519, where Kellogg, who was not a lawyer, but was admitted to practice before the United States Patent Office, was enjoined from practicing law relating to patents in Illinois, though without prejudice to his right to practice before the United States Patent Office.

*Third,* the Court below pointed out that the respondent had made the argument that the practice of "patent law" is not the "practice of law" (R. 58). But the Court rejected that argument, holding, in line with many other state cases that it is "*the character of the acts themselves*" which determine whether they constitute the practice of law (R. 58). Accordingly, the Court held that the practice of "patent law" is the "practice of law."

More specifically, the Court pointed out that

> "one who *holds himself out* to the public in this state as qualified to advise as to patentability and does so is engaging in the practice of law. The same is true of the act of advising as to the infringement of patent rights. Both require extensive knowledge of the law, statute and case, in a field of the law that is as technical and involved as any known today." (Emphasis added.)

The Court then went on to cite legal authorities to the effect that

> "The specifications and claims of a patent constitute one of the most difficult legal instruments to draw with accuracy,"

quoting from *Topliff* v. *Topliff* (1892), 145 U.S. 156, 36 L.Ed. 658, 12 S.Ct. 825. And the Court accordingly held that the preparation of applications for patents,

and amendments thereto, among the other acts, constitute the practice of law.

*Fourth*, the Court answered in the negative the question "whether the respondent, by virtue of his admission to practice before the Patent Office as a patent attorney, has the right to do these things in this state without admittance to The Florida Bar." After pointing out at some length and in some detail the legal character of applications for patents (R. 59-62), the Court followed the *Kearney* case, in which "we held that anyone who *holds himself out* to practice 'in any field or phase of the law' must be a member of The Florida Bar." (Emphasis added.) *Supra* p. 12.

### 3. The Decision Below Did Not Enjoin Petitioner "From Practice Before the Patent Office"

Now, in this Court, however, Petitioner asserts strenuously that the decision below "has denied him" the "right" "to practice before the Patent Office." Petitioner's brief, p. 9. It is also asserted on the same page that "The present case is the first time that any state has ever held that patent agents could not practice before the Patent Office, . . ." Similar statements abound in Petitioner's brief, pp. 2, 7, 10, 11; and there is at least one comparable statement in the brief of the United States as *amicus curiae* where it is said that the question presented is "whether a state may prohibit such Patent Office practice : . ." (brief p. 2). In our view, however, these assertions do not fairly describe the decision below.

Also, the Court below did *not*, as asserted in the brief for Petitioner (p. 7), hold that "even though the Patent Office had licensed petitioner to practice before it, the state's police power permits it 'to deny [him] the

right to so practice' in Florida (R. 55)." A fair reading of the paragraph in question shows that what the Court meant by "practice" was not the right to "practice before the Patent Office," but the right to "*practice law in Florida.*" Moreover, the implication given by this assertion of Petitioner is rebutted elsewhere in the Opinion (R. 67), and is unsupportable.

For the fact is that the Florida Supreme Court went out of its way to make clear that it was not in any sense endeavoring to interfere with Petitioner's right to practice before the Patent Office, saying that "*The issuance of an injunction . . .*" *will not* "*in any way affect his right to practice before the Patent Office in Washington, D. C.*" (R. 67). (Emphasis added.)

#### 4. The Injunctive Provisions and Holding of the Court

Accordingly, the Court enjoined Petitioner from the following activities "*in this state*":

> "1. using the term 'patent attorney' or holding himself out to be an attorney at law in this state in any field or phase of the law (we recognize that the respondent according to the record before us has already voluntarily ceased the use of the word 'attorney').
>
> "2. rendering legal opinions, including opinions as to patentability or infringement on patent rights;
>
> "3. preparing, drafting and construing legal documents;
>
> "4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;

"5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and

"6. otherwise engaging in the practice of law."

**5. Significance of the Fact that Petitioner "Holds Himself Out" to Practice Patent Law in Florida**

In the foregoing discussion we have emphasized the phrase "*holding himself out*", which appears in eleven different places in the decision below. This repeated use of the phrase shows that the Florida Supreme Court was not concerned with activities of patent practitioners in Florida who do not hold themselves out to the public as entitled to practice patent and trademark law, such as full-time employees of corporations, government officials, etc.; and that the court carefully confined its decision, as required by the allegations of the Petition, for a Rule to Show Cause, to the case of a patent practitioner in Florida who admittedly "*holds himself out* to the public as authorized to engage in the practice of law in the patent field" (R. 2). (Emphasis added.)

That is the only type of practitioner involved in this case. And in this connection it is noteworthy that Petitioner's brief suggests that the decision below provides a direct precedent for enjoining the activities of 62 of the 73 patent practitioners who have given the Patent Office a Florida mailing address. But the fact is that of the 73 patent practitioners there listed, The Florida Bar records show that 16 are members of The Florida Bar. Of the remaining 57, only 3, in addition to Sperry, appear to be "holding themselves out" to the public as entitled to practice patent law in Florida, by advertising themselves in the classified section of various Florida Telephone Directories.

In summary, excluding Sperry, 16 out of 19, or 82.6 per cent of those who are "holding themselves out" to the public as entitled to practice patent law in Florida, are members of the Florida Bar. The remaining 53 practitioners, excluding Sperry also, are apparently either (1) enjoying their retirement in the Florida sunshine, or (2) enjoying full time employment in the patent departments of corporations, governmental agencies or other organizations usually working under the supervision of a patent lawyer. There is no reason to believe on this record that they are holding themselves out to the public as entitled to practice law, or that the decision below can affect them.

The marked difference between the true facts about the number of persons who are improperly "holding themselves out" in Florida and the Petitioner's suggestion that the decree will lead to enjoining 62 out of 73 Florida "practitioners", serves to demonstrate Petitioner's fundamental error in his interpretation of the source of material for his statistics (Brief p. 4).

The Department of Commerce booklet, "Patent Attorneys and Agents Available to Represent Inventors Before the United States Patent Office", which Petitioner states is his authority for his representation, is merely a published list of all persons who (1) have been recognized by the Patent Office and (2) have never specifically advised the Patent Office that they are *not* available to represent inventors.

Yet there are practitioners who accept full time employment which precludes their representing applicants. Others retire, or die. And neither group is bound by any Rule or custom to advise the Patent Of-

fice of this fact. Accordingly, it is plain that this list cannot be construed as a list of practitioners who are "holding themselves out" to the public in the communities which that publication lists as their residence. Indeed, the publication itself acknowledges this in its "Foreword", which states:

> "The list includes all registrants who have not informed the Patent Office that they are employees of the United States Government or full-time employees of corporations."

Moreover, it must be noted that while the Rules[2] require a lawyer, who had been duly recognized as a patent attorney to advise the Patent Office when he changes his address, there is no parallel requirement that the Office be advised when the attorney obtains admission to the local bar of his new residence. That being the case, the Patent Office records concerning bar membership cited by the Petitioner are only competent to establish the initial bar membership of a given registered practitioner as opposed to the sum total of his bar affiliations.[3]

The Petitioner makes precisely the same error when he represents (brief p. 4), that the 3,307 practitioners (over 45 per cent of the sum total of recognized patent practitioners) who are not listed in the Patent Office

---

[2] Rule 347, Rules of Practice of the United States Patent Office in Patent Cases (37 C.F.R. 1.347).

[3] For example, according to the records of The Florida bar and the Patent Office, 4 of the 16 Florida patent lawyers (25%) had moved to Florida since their recognition by the Patent Office and had never had occasion to advise the Patent Office of the fact that they had joined the Florida bar.

as being members of the bar of the states where they reside, will be adversely affected by a universal application of the holding of the Florida court.[4]

For the Patent Office does not itself know how many of its practitioners are "holding themselves out." It does not know how many of its practitioners are engaged in full time employment with various types of organizations. It does not know how many of its practitioners have joined the bars of the jurisdictions wherein they now reside. Finally, it does not know how many of its practitioners have retired, or died. Accordingly, there is no conceivable way to support any of the figures suggested by the Petitioner or by the United States.

But we think it fair to say that even a universal application of the decision below throughout the states would affect only a minute percentage of the estimates suggested by the briefs of the Petitioner and the United States—only those who are *"holding themselves out"* to the public as lawyers entitled to practice patent law.

## SUMMARY OF ARGUMENT

Contrary to the assertions of Petitioner and the United States, the Court below did not enjoin Petitioner from "practice before the Patent Office." It did enjoin him from performing certain acts in Florida which do not constitute practice before the Patent Office. The Patent Office is located only in Washington, D. C.

---

[4] The brief of the United States makes a similar representation, but with a slightly different number being quoted. "Thus, 3488 practitioners would be immediately affected by the ruling in the instant case and others like it, if it were followed." (p. 3)

Petitioner does not contest the entire decree, particularly those items enjoining him from holding himself out to the public as a "Patent Attorney," preparing, etc., legal documents generally, or otherwise practicing law. But the necessary thrust of Petitioner's contention is that he has a federal license, by virtue of having been "recognized" by the Patent Office, to do other things enjoined by the decree, that is, to prepare patent applications in Florida and give legal opinions in Florida, as to patentability and infringement, and to hold himself out as qualified to do so. Thus he contends that, although not a lawyer, he should be permitted to practice law relating to patents—outside the Courtroom—in Florida. While the practice of law by unqualified persons inside the Courtroom was a problem in early English and American history, today the main problem area of unauthorized practice, following the industrial revolution and the Civil War, is the practice of law by unqualified persons *outside* the courtroom.

Petitioner's contention should be rejected for the following reasons:

*First,* only the States, in the exercise of the police power, have the right to control and regulate the practice of law. This right stems from a lawyer's relation to the responsibilities of a court, and is part of the system of administration of justice of the State. *Bradwell* v. *Illinois* (1873), 16 Wall 130; *Theard* v. *United States* (1957), 354 U.S. 278, 281, 1 L.Ed. 2d 1342, 77 S.Ct. 1247. Moreover, where the judicial power is vested in the Courts, the State legislature or an administrative agency has no power to authorize people to practice law. Also, what constitutes the practice of law in a particular State is a matter of State law, not subject

to review by this Court. Accordingly, the acts which the decision below found to constitute the practice of law in Florida should be accepted as such by this Court.

The fact that the practice of law involves federal matters does not diminish the power of the States to regulate the practice of law; and the fact that a person may be admitted to practice before this Court, or a federal administrative tribunal, confers no right upon a person to practice law in a State.

*Second,* in our case Congress has not, in the 1922 statute providing for "recognition" of persons entitled to represent applicants before the Patent Office, attempted to authorize the Commissioner to authorize the Petitioner to practice law relating to patents in Florida. Nor has the Commissioner of Patents attempted to so authorize the Petitioner.

*Third,* if it could be claimed that both Congress in the statute and the Commissioner have attempted to authorize the Petitioner to practice law relating to patents in Florida, then the statute would be unconstitutional on several grounds.

A. It would be an unconstitutional delegation of legislative power, inasmuch as the "practice of law" is not defined in the statute as the subject matter of any attempted delegation of power; and there is a complete absence of standards as to when, whether, how or on what basis the Commissioner should authorize the Petitioner to practice law.

B. Neither Congress nor a federal administrative agency may authorize anyone to practice law in the federal field or elsewhere. The power to admit to the bar and to disbar, and to define what constitutes the

practice of law and to exclude unauthorized persons therefrom is a *judicial* power, vested in that branch of the Government in which the judicial power is vested. See ***Ex Parte Garland*** (1867), 4 Wall. 333, 18 L.Ed. 366. In the Constitution of the United States the judicial power is vested in this Court and other federal Courts. Accordingly, in the Federal field only the Courts may authorize people to practice law. Any attempt by Congress or an administrative agency to authorize people to practice law would be a nullity.

C. In Article I, section 8, of the Constitution of the United States, the States conferred only very limited power relating to discoveries on the Federal Government. The only real power conferred is the right to "secure," that is, to "shield," "guard" or "protect" the exclusive right to discoveries. So long as a State does not unreasonably interfere with that right, the patent laws passed by Congress are "subject to" the State police power. *Patterson* v. *Kentucky* (1879), 97 U.S. 501, 24 L.Ed 1115, *Webber* v. *Virginia* (1881), 103 U.S. 344, 26 L.Ed. 565, *Allen* v. *Riley* (1906), 203 U.S. 347, 5 L.Ed. 216, 27 S.Ct. 95. The decision below certainly does not unreasonably interfere with that right—indeed, it does not interfere with it at all. Accordingly, if it could be claimed that the statute in question attempted to authorize Petitioner to practice law relating to patents in Florida, then it would exceed the power conferred on Congress and invade the police power of the States.

## ARGUMENT

### POINT ONE

### HISTORICAL BACKGROUND: THE BAR IS A RESULT, NOT A CAUSE. IT AROSE AS THE RESULT OF A PUBLIC DEMAND FOR THE EXCLUSION OF UNQUALIFIED PERSONS FROM THE PRACTICE OF LAW.

#### A. In General

The legal profession originally grew up around the Courts. In 1178 a spectacular development occurred, when Henry II appointed five clerks to devote full time to the business of acting as judges in litigation, that is "to do justice habitually." This was "a measure of great permanent importance." The Central Courts of England then began to develop, and, within the next century or so, a legal profession began to develop around them. See *Pollock and Maitland, "The History of English Law,"* 153-155, 211, (2nd ed.)

Interestingly enough, however, the Bar did not just mysteriously appear from nowhere. The fact is that the Bar arose as the *result* of the practice of law by unqualified persons—as the result of a public demand for the exclusion of those who assumed to practice law without adequate qualifications therefor. And today the practice of law by unqualified persons is generally called the "unauthorized practice of law," a phrase which will frequently appear in this brief.

Indeed, the first unauthorized practice statute goes back to 1292. In that year Edward I authorized John de Metingham, then Lord Chief Justice of the Court of Common Pleas, to appoint a certain number of "attornies and lawyers of the best and most apt for their learning and skill, who might do service to his court and people; and that those so chosen only, and no other," should practice. The king and his council then

deemed "the number of seven score to be sufficient for that employment," although the number was thenceforth left to the discretion of the justices. See Herbert, *"Antiquities of the Inns of Court and Chancery,"* 165-67 (1804). 1 Pollock and Maitland, *"The History of English Law"* 216 (2nd ed.).

Herbert, in a footnote, also describes another incident of judicial exclusion of unqualified persons from the practice of law in a rural society. "In 1454," he states, "an act of parliament notices, 'that there had used formerly six or eight attornies only, for Suffolk, Norfolk, and Norwich together; that this number was now increased to more than eighty, most of whom being not of sufficient knowledge, came to fairs, etc., etc., inciting the people to suits for small trespasses, etc., etc.; wherefore there shall be hereafter but six for Suffolk, six for Norfolk, and two for the city of Norwich.'—Andrew's Chron. Hist. of Great Britain, book ii, p. 148." Herbert, op. cit. *supra,* at 167 n. 2.

In the leading case of *Rhode Island Bar Assn.* v. *Automobile Serv. Assn.* (1935), 55 R.I. 122, 179 A. 139, Judge Condon carefully reviewed the 1292 ordinance of Edward I and the statute, 4 Henry IV, c. 18 (1402), which provided "that all the attornies shall be examined by the justices, and by their discretions their names put in the roll, and that they be good and virtuous, and of good fame, shall be received and sworn well and truly to serve in their offices . . . and the other attornies shall be put out . . ." He concluded: "This statute . . . is of interest to us here, however, only to illustrate that *the bar arose out of a public demand for the exclusion of those who assumed to practice law without adequate qualifications therefor.* It is also of importance because it shows beyond question that *the*

*duty of excluding unauthorized persons was left to the discretion of the justices.*" (p. 144) (Emphasis added.) 55 R.I. at 133-34, 179 A. 144. Similar limitations were placed on membership in the bar in ancient Rome. See Pound, "*The Lawyer From Antiquity to Modern Times*" 51 (1953).

Until about the period of the industrial revolution, unauthorized practice problems revolved primarily around the courtroom. We submit, however, that the same standards should apply with regard to the practice of law outside the courtroom as to practice inside it. The unqualified person should no more be permitted to practice law *outside* the courtroom than in it, and the Courts have generally so held:

*People* v. *People's Stock Yards State Bank* (1931), 344 Ill. 462, 176 N.E. 901, 905.

*In Re Duncan* (1909), 83 S.C. 186, 65 S.E. 210, 211.

*Opinion of the Justices* (1935), 289 Mass. 607, 194 N.E. 313, 317.

*Gray* v. *Justice's Court of Williams Judicial TP* (1937), 18 Cal. App. 2d 420, 63 P. 2d 1160, 1162.

*Fink* v. *Peden* (1938), 214 Ind. 584, 17 N.E. 2d 95, 96.

*People* v. *Alfani* (1919), 227 N.Y. 334, 125 N.E. 671.

*Eley* v. *Miller* (1893), 7 Ind. App. 529, 34 N.E. 836.

*Boykin* v. *Hopkins* (1932), 174 Ga. 511, 162 S.E. 796, 799, 800.

**B. The Industrial Revolution: the Great Increase in the Practice of Law Outside the Courtroom: and the Rise of Legal Ethics**

With the industrial revolution following the Civil War, however, the types and quantity of property useable by humanity enormously increased, requiring the application of legal principles with respect to such

things as its creation, management, transfer, disposition, etc. Toward the end of the nineteenth century this became accompanied by a striking increase in government regulation. Along with these factors came corresponding increases in paper work and desk work, and a tremendous increase in the practice of law outside the courtroom.

This is even illustrated in the field of patents. Until about 1870 there were no written applications for patents as we know them now. The "application" then ordinarily consisted of the filing of a model; and the inventor was not required to make any claims other than to say "I claim the invention as herein shown and described."[5] But as the industrial revolution pro-

---

[5] Arthur P. Greely, who as Assistant Patent Examiner participated in the "refusal" of the Patent Office "to recognize" the notorious John T. Wedderburn in 1897, and in 1926 a prominent patent attorney, stated before the House Committee on Patents in that year at a hearing on H.R. 5811, 69th Cong., 1st Sess., "Prevention of Fraud in Practice Before Patent Office," at page 79, as follows: "Now the law originally did not contemplate anything more than putting into the Patent Office a description of his invention. For many years he was not required to make any claims other than to say, 'I claim the invention as herein shown and described.' That was the practice up to, I think, 1870. It was supposed to be a simple thing. If you had an invention you could properly describe it well enough to meet the requirements of the Patent Office; that later it became apparent that a good many inventors could not do it well. *For many years they depended on models, required models of all inventions. That was the practice up to about 1880*, and the Patent Office got so filled up with models and the skill that was required to prepare an application had developed to such an extent that it could really be better presented in a good drawing and a good description than in a model. So they dispensed with models. But the idea of an application for a patent primarily was something that the inventor himself could put into the office."

While Mr. Greely's reference to 1880 may be accurate as to the practice before the Patent Office, section 26 of the Act of July 8,

gressed and property and society became more complex, a written patent application became essential. Thus a legal document came into existence to serve as a substitute for a physical model; and another area of the practice of law outside the courtroom was created, in turn requiring competent legal assistance outside the courtroom of a kind never before glimpsed.

At the same time a number of doubtful practices arose. But it was not until President Theodore Roosevelt came along at the close of the nineteenth century that anything of importance had been said or written in this country about ethics in connection with the legal or any other profession. However, he demanded decency, morality, honor, integrity and fair play by business generally, and he insisted that the public interest required the application of ethics in both business and professional life. Speaking before the Alumni of Harvard University in 1905, he said:

> "This nation never stood in greater need than now of having among its leaders men of lofty ideals, which they try to live up to and not merely talk of."

And he also said:

> "*The great profession of the law* should be that whose members ought to take the lead in the creation of just such a spirit. * * * Surely Harvard has the right to expect from her sons a high standard of applied morality, whether their paths lead them into public life, into business or into the

---

1870, 16 Stat 201, later Rev. Stat. § 4888, for the first time required each patent application to be supported by a "written description," in which, among other things, the inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

*profession of law, whose members are so potent in shaping the growth of the national soul.*" (28 A.B.A. Rep. (1905) 383-4). (Emphasis added)

Largely because of this speech, in 1908 the American Bar Association prepared and adopted its Canons of Ethics. Within ten or twelve years, more than 200 ethical codes were adopted by many professional and business groups including, for example, The American Medical Society in 1912.

**C. The Current Trend—An Increasing Prohibition of the Practice of Law by Unqualified Persons as the Frontier Recedes**

Since about 1900 there appears to have been a steady trend in the direction of further prohibiting the practice of law by unqualified persons outside the courtroom. For prior to that time, the growth of the practice of law outside the courtroom had not at the same time been accompanied by any prohibition against the practice of law by lay agencies and corporations. However, soon the problem became so serious that the State legislatures began to deal with it. Thus, in 1909, the great industrial State of New York enacted Section 280 of the Penal Law, probably the first statute prohibiting corporations from practicing law. Since that time similar statutes have been enacted in the other states generally. See *State Bar Association* v. *Connecticut Bank and Trust Co.* (1958), 145 Conn. 222, 140 A. 2d 863, and the *Unauthorized Practice Statute Book* of the American Bar Foundation.

In 1917 the Appellate Division of the State of New York in *People* v. *People's Trust Co.* (2d Dept. 1917), 180 App. Div. 494, 167 N.Y. Supp. 767, had occasion to refer to "the growing tendency of corporations to enter the field of practicing law." And shortly after the

legal profession finally awoke, about 1930, to the growing evils of the practice of law outside the courtroom, the Supreme Court of Illinois in one of the great, landmark cases of unauthorized practice, *People* v. *People's Stock Yards State Bank* (1931), 344 Ill. 462, 176 N.E. 901, had occasion to point out that the corporation involved in that case had "transacted for its customers and others almost every form of legal business except the handling of divorce cases." (p. 903). It was found guilty of contempt and enjoined from practicing law in any respect.

In 1930 what is now the Standing Committee on the Unauthorized Practice of Law of the American Bar Association was formed. And in 1934 at the Annual Meeting of the American Bar Association, which was devoted to the subject of the "*Effect of the Unauthorized Practice of Law on the Administration of Justice,*" 59 A.B.A. 153, Mr. John A. Jackson of New York pointed out that the Committee on the Unauthorized Practice of Law "was created as the result of pressure from outside the Association." 59 A.B.A. 154.

Since 1930 and the formation of the American Bar Committee, many committees on unauthorized practice of State and local bar associations have been created, with the result that litigation began and a number of judicial decisions began to be handed down. While these decisions are not all harmonious, it appears to be fair to say that there has been a steady trend in the direction of increasingly prohibiting the practice of law outside the courtroom by unqualified persons, and of increasing concern on the part of the Courts with respect to the damage to the public, the thwarting of the control of the Courts over the practice of law and

the impairment of the sound administration of justice which takes place when persons not members of the Bar practice law.

Moreover, it is noteworthy that the whole problem of unauthorized practice stems, in part at least, from the original pioneer or frontier character of American society. By 1607, when the first settlers arrived in Virginia, the legal profession in England had become fairly well stabilized. That is, in 1235, Henry III had prohibited the study of law at any place in London other than the Inns of Court. See *Warren, "A History of the American Bar,"* p. 28; *Standards of Admission for Practice Before Administrative Agencies," A Report for the Survey of the Legal Profession,*[6] p. 25. And in 1606 it was provided by statute that admission to practice in the courts was limited to those brought up in the Inns of Court and who were "well practiced and skilled and of an honest disposition." *Warren, idem*, p. 29, *Standards of Admission, etc.*, p. 25.

In 1607, however, while the practice of law had become pretty well stabilized in England, America was a wilderness. And in Colonial America laymen were permitted to practice in the courts; and even the courts themselves were first composed of laymen. Thus in all the American colonies, the General Assembly or legislature at first constituted the sole court of law; and in many colonies it was not until half a century after settlement that separate and independent courts were established. Even then, with the possible exception of the Chief Justice, those courts were composed of laymen. It was not until the end of the Revolution that it was deemed necessary or even advisable to have

[6] Hereinafter referred to as "Standards of Admission, etc."

judges learned in the law. And as for the practitioners themselves, the word "attorney" as used in early records of Colonial cases and statutes, did not imply necessarily a man bred to the law or who made its practice an exclusive employment. These attorneys were very largely traders, factors, land speculators and laymen of clever penmanship and easy volubility whom parties employed to appear and talk for them in the courts. As late as 1758, John Adams complained that "he found the practice of law was grasped into the hands of deputy sheriffs, pettifoggers and even constables." *Warren, idem* 3, 4, 80. *Standards of Admission*, etc., 25, 26.

In a pioneer civilization, these things are understandable. But as the frontier recedes and society becomes more complex and law more intricate, a person seeking to advise the public on legal matters must have a constantly growing knowledge of law if the public is to be adequately served. Accordingly, the standards for admission to the Bar have steadily risen, and it has become correspondingly more important to protect the public from the dangers of permitting persons not members of the Bar to practice law. Moreover, even before federal administrative agencies there has been a recent trend away from permitting laymen to appear before Federal administrative agencies. *Standards of Admission, etc.*, pp. 16-18.

### D. The Rising Requirements for Practicing Patent Law and the Evolving Requirement That Persons Practicing Patent Law Be Members of The Bar if the Public Is to be Protected

The considerations which led to the evolvement of the organized bar as the mechanism for excluding unqualified persons from the practice of law, are as significant in the field of patent law as elsewhere. For modern patent law is an intricate legal field. As set

forth in Appendix B, even the preparation of a patent application now includes making determinations as to a host of complex legal problems.

These problems are so intertwined that not one can be properly determined in the absence of a consideration of some, if not all, of the others.

Moreover, the field has now grown to be far more complex than in past years. It is presently burdened with greater refinements from within,[7] and with new legal doctrines and complicating factors from without (misuse, anti-trust, and special statutes and regulations pertaining to inventions subject to a secrecy order, or pertaining to developments in atomic power in space exploration). This increasing complexity in the field of patent law means that, to properly advise the public, a person must know a great deal more patent law than was necessary even 50 years ago. Accordingly, even if it could be argued that, in years gone by, there was no reason for having patent practitioners know more than a few rudimentary procedures that day is now long past.[8]

---

[7] The only recognized *summary* of interference practice has now grown to four volumes, *Interference Law and Practice*, Rivise & Caesar, The Michie Co., 1947.

[8] For specific legislation on inventions subject to Secrecy Orders see 35 U.S.C. 181-188. See also specific statutory provisions relating to inventions in the Atomic Energy Act of 1954, Sections 151-158 (42 U.S.C. §§ 2181-2188), and in the National Aeronautics and Space Act of 1958, 42 U.S.C. § 2457. A Patent practitioner must be equipped to advise his client upon all of the ramifications of these statutes, as well as on the plethora of rules and regulations that have been promulgated thereunder.

**Indeed, the breadth of development of the field of patent law in parallel with the development of other fields of law, has long since reached the stage wherein the public is entitled to demand that practitioners in this field be not merely "recognized" by a distant Patent Commissioner in Washington, D. C., but should have the broader knowledge in the patent field of law as a seamless web, afforded by patent practitioners who are members of the Bar.***

---

* In the *amicus* brief filed by the American Association of Registered Patent Attorneys and Agents, pages 9-10, it is suggested that the preparation and prosecution of a patent application "do not require legal training." (p. 9). Insofar as this brief manifests the attitude of lay practitioners as a class it serves to demonstrate the need for higher standards if the public is to be protected.

## POINT TWO

## "THE RIGHT TO CONTROL AND REGULATE THE GRANTING OF LICENSE TO PRACTICE LAW IN THE COURTS OF A STATE IS ONE OF THOSE POWERS THAT WAS NOT TRANSFERRED TO THE FEDERAL GOVERNMENT."

### A. In General

It is settled that "The right to control and regulate the granting of license to practice law in the courts of a state is one of those powers that was not transferred to the Federal Government," *Bradwell* v. *Illinois* (1873), 16 Wall. 130, 139, 21 L.Ed. 442.

To the same effect:

*Theard* v. *United States* (1957), 354 U.S. 278, 281, 1 L.Ed. 2d 1342, 77 S.Ct. 1274.

*Ex Parte Secombe* (1857), 19 How. 9, 15 L.Ed. 565.

*Schware* v. *Board of Bar Examiners* (1957), 353 U.S. 232, 1 L.Ed. 2d 796, 77 S.Ct. 752.

*Martin* v. *Walton* (1961), 368 U.S. 25, 7 L.Ed. 2d 5, 82 S.Ct. 1.

*In Re Isserman* (1953), 345 U.S. 286, 97 L.Ed. 1013, 73 S.Ct. 676.

*In Re Summers*, (1945), 325 U.S. 561, 89 L.Ed. 1795, 65 S.Ct. 1307.

*Randall* v. *Brigham* (1869), 7 Wall 523, 19 L.Ed. 285.

*In Re Lockwood* (1894), 154 U.S. 116, 38 L.Ed. 929, 14 S.Ct. 1082.

*Cummings* v. *Missouri*, 4 Wall. 277, 18 L.Ed. 356.

*Saier* v. *State Bar of Michigan* (CA 6, 1961), 293 F. 2d 756, cert. den. 368 U.S. 947, 7 L.Ed. 2d 343, 82 S.Ct. 388.

*Starr* v. *State Board of Law Examiners* (CA 7, 1947), 159 F. 2d 305.

*Mitchell* v. *Greenough* (CA 9, 1958), 100 F. 2d 184, cert. den. 306 U.S. 659; 83 L.Ed. 1056, 59 S.Ct. 788.

*Emmons* v. *Smitt* (CA 6, 1945), 149 F. 2d 869, cert. den. 326 U.S. 746, 90 L.Ed. 446, 66 S.Ct. 59.

And see Point Three, B, post p. 60.

In addition, "the right to admission to practice in the courts of a state" is not a privilege and immunity of the citizens of the United States, *Bradwell* v. *Illinois* (1873), 16 Wall. 130, 139, 21 L.Ed. 442.

In *Theard* v. *United States* (1957), 354 U.S. 278, 1 L.Ed. 2d 1342, 77 S.Ct. 1274, the Supreme Court of Louisiana had disbarred an attorney. The U.S. District Court for the Eastern District of Louisiana then ordered that the attorney be stricken from its rolls, and the Court of Appeals affirmed. On certiorari this court reversed, holding that "disbarment by Federal courts does not automatically flow from disbarment by state courts," for the District Court had apparently felt itself bound by the state court disbarment. Accordingly, this court remanded the case to the District Court, in accordance with the standards set forth in *Selling* v. *Radford*, 243 U.S. 46, 61 L.Ed. 585, 37 S.Ct. 377. However, in an opinion by Frankfurter, J., the following important statement was made with respect to the "*autonomous control*" by state judicatures of officers of their courts, including lawyers. Thus this Court, among other things, said (p. 281):

> "It is not for this court, except within the narrow limits for review open to this court, as recently canvassed, in *Konigsberg* v. *State Bar of California*, 353 U.S. 252, 1 L.ed. 2d 810, 77 S. Ct. 722, and *Schware* v. *Board of Bar Examiners*, 353 U.S. 232, 1 L.ed. 2d 796, 77 S. Ct. 752, to sit in judgment on Louisiana disbarments, and we are not in any event sitting in review of the Louisiana judgment.

> While a lawyer is admitted into a federal court by way of a state court, he is not automatically sent out of the federal court by the same route. The two judicial systems of courts, the state judicatures and the federal judiciary, *have autonomous control over the conduct of their officers, among whom, in the present context, lawyers are included. The court's control over a lawyer's professional life derives from his relation to the responsibilities of a court.* The matter was compendiously put by Mr. Justice Cardozo, while Chief Judge of the New York Court of Appeals. 'Membership in the bar is a privilege burdened with conditions' (Matter of Rouss, 221 N.Y. 81, 84, 116 N.E. 782). The appellant was received into that ancient fellowship for something more than private gain. *He became an officer of the court, and, like the court itself, an instrument or agency to advance the ends of justice." People ex rel. Karlin* v. *Culkin*, 248 N.Y. 465, 470, 471, 162 N.E. 487, 489, 60 A.L.R. 851. (Emphasis added)

**B. The Fact that the Practice of Law Involves Federal Subject Matter does Not Diminish the Power of the State to Regulate It**

The cases appear to universally hold that the power of the State to regulate the practice of law within the State is not diminished by the fact that the subject matter of such practice may be federal in character.

Here perhaps the leading case is *Ginsburg* v. *Kovrak* (1958), 392 Pa. 143, 139 A. 2d 889. Kovrak was admitted to practice before the United States Supreme Court, the Court of Appeals of the District of Columbia, and the United States District Courts of the District of Columbia and the Eastern District of Pennsylvania. He was not a member of the Pennsylvania Bar, but he set up an office in Philadelphia and advertised himself as "Attorney at Law. Proctor in Federal Tax-

ation." The Committee on the Unauthorized Practice of Law of the Philadelphia Bar Association then sued to enjoin Kovrak from unlawfully practicing law in the State. The Defendant's position was that "he has a legal right to practice law anywhere in the Eastern District of Pennsylvania with regard to any legal matter in which a Federal question was involved, no matter how remote." 139 A.2d 890. In enjoining the Defendant from practicing law in Pennsylvania, the Court among other things, said:

> "When a stranger comes to our community he must meet the standards set out by our people, just as our citizens must expect to meet the local standards if they go elsewhere to live and work. *No case has been suggested to us which holds that membership in the Bar of the United States Supreme Court entitles an attorney to practice anywhere in the United States without reference to local State requirements.* If we are not obliged to accept the man from Oregon merely because he may practice before the Supreme Court, neither should we have to accept the stranger from Pike County as a practicing lawyer merely because it is also within the Eastern District of Pennsylvania.
>
> "We do not presume to tell the Federal Courts whom they should or should not appoint as referees, special masters, amici curiae, and the like, for the prosecution of their work as they see it. That is a different matter from deciding what qualifications are needed by Pennsylvania citizens facing and affecting each other before the Bar in any court of law, State or Federal. In such matters we are State citizens before we are federal citizens, which is another way of saying that the States have not ceded to the Federal Government the right to qualify their lawyers." (Emphasis added.) Page 892.

* * * * * * * * *

"Merely because the Federal courtrooms are open does not mean that the Federal Courts have approved anyone as a qualified lawyer. The *most it means is that a man may practice there if he is qualified by local law.*" (Emphasis added.) Page 893

* * * * * * * * *

"It is readily apparent that the injunction is intended to, and does, prohibit only the maintenance of an office and the practice of law in Philadelphia County (and, of course, anywhere else in the Commonwealth of Pennsylvania). *It in no way affects the appellant's right to engage in the practice of law in Washington, D. C., or to try cases in the United States District Court for the Eastern District of Pennsylvania* or in any other federal court or jurisdiction where he may be entitled to practice." (Emphasis added.) Page 893

In *Richmond Association of Credit Men* v. *Bar Association* (1937), 167 Va. 327, 189 S.E. 153, the credit association was enjoined from practicing law in Virginia, "to include such acts of the credit association in handling its collections in bankruptcy." 189 S.E. 161.

Similarly in *Depew* v. *Wichita Ass'n of Credit Men* (1935), 142 Kan. 403, 49 P. 2d 1041, the Supreme Court of Kansas enjoined the Defendant from participating in bankruptcy proceedings in the Federal Court as part of the practice of law in Kansas. In turn, this Court declined to review the decision of the Supreme Court of Kansas by denying a writ of certiorari, 297 U.S. 710, 80 L.Ed. 997, 56 S.Ct. 574. To the same effect, see also *Meisel & Co.* v. *Nat'l Jewelers' Board of Trade*, 90 Misc. 19, 152 N.Y.S. 913 (affirmed without opinion, 173 App. Div. 889, 157 N.Y.S. 1133).

In addition, in *State Ex. Inf. McKittrick* v. *C. S. Dudley & Co.* (1937), 340 Mo. 852, 102 S.W. 2d 895, *cert. den.*, 302 U.S. 693, 82 L.Ed. 535, 58 S.Ct. 12, a

collection agency contended that to restrain collection of the purchase price of interstate sales would interfere with commerce between the States. The Court, however, held that the interstate feature did not justify the prosecution by the agency of assigned claims, and that a corporation could not practice law regardless of the source of the subject matter. It enjoined the agency from practicing law in any respect.

*In Re Roel* (1957), 3 N.Y. 2d 224, 144 N.E. 2d 24, appeal dismissed 355 U.S. 604, a Mexican lawyer asserting his right to practice Mexican law in the State of New York, and was enjoined from practicing law in that State.

### C. Admission to Practice Before a Federal Tribunal Does Not Entitle One to Practice Law in a Particular State

#### 1. Admission to practice before a Federal Court does not entitle one to practice in a particular state

Here again perhaps the leading case is *Ginsburg* v. *Kovrak* (1958), 392 Pa. 143, 139 A. 2d 889, *supra*, page 36. Kovrak was a member of the Bar of this Court and of Courts in the District of Columbia, and of the United States District Court for the Eastern District of Pennsylvania. The Supreme Court of Pennsylvania held that he could not practice law in the State of Pennsylvania inasmuch as he was not a member of the Pennsylvania Bar. The quotations given above, pages 37, 38, are also specially pertinent on this point.

And in *Petition of Kearney*, 63 S. 2d 630 (Florida 1953), extensively relied upon by the Court below, Kearney was duly admitted to practice before this Court, the Tax Court of the United States, and the Treasury Department. He was not a member of The

Florida Bar, but he sought permission to practice in Florida as "Federal Tax Counsel," with Court appearances to be limited to the Federal Courts and departments described. The Florida Supreme Court held that such practice would constitute the practice of law in Florida and that in order to engage in such practice Kearney would have to become a member of The Florida Bar "subject to the jurisdiction of this Court" (R. 56). In its opinion the Florida Supreme Court stressed Section 2, Integration Rule, which provides that no person shall engage in any way in the practice of law in the State unless he is an active member of The Florida Bar.

**2. Admission to practice before a Federal Administrative Agency does not entitle one to practice law in a particular state**

There are cases, *DePass* v. *B. Harris Wool Co.* 1940, 346 Mo. 1038, 144 S.W. 2d 146, *Auerbacher* v. *Wood* 1947, 139 N.J.E. 599, 53 A. 2d 800; *In re Lyon* 1938, 301 Mass. 30, 16 N.E. 2d 74; and *Noble* v. *Hunt* 1957, 95 Ga. 804, 99 S.E. 2d 345, which indicate that a state will not interfere with the *appearance* of a layman before a Federal administrative agency, where such appearance has been authorized by the agency. But the other state cases hold that admission to practice before a federal administrative agency does not entitle a person to practice law in a state, as distinguished from appearances before the agency.

There are two landmark cases in which State courts have so decided. In *Chicago Bar Association* v. *Kellogg*, 338 Ill. App. 618, 88 N.E. 2d 519 (1949), the Illinois Court of Illinois held that admission to practice before the Patent Office in 1918 did not authorize the practice of law relating to patents in Illinois by a "pat-

ent attorney" not a member of the Illinois bar. We quote from the opinion at length (88 N.E. 2d 519, 521-528) because it is so directly pertinent to our case.

> "The complaint charges substantially that the defendant maintains an office in the City of Chicago; that he is not licensed to practice law in the State of Illinois, but notwithstanding has for a long time engaged in, and continues to engage in, the practice of law and holds himself out as an attorney and induces, or attempts to induce, the public to believe that he is an attorney at law. The complaint itemizes a number of specific acts which it charges constitutes the practice of law, and prays that the defendant be restrained from a continuation of these specified practices.
>
> "The answer admits that defendant is a resident of Cook County and states that on December 16, 1918, while defendant resided in the City of Washington, the Commissioner of Patents of the Patent Office of the United States caused the name of the defendant to be duly registered on the Roster of Attorneys entitled to practice before it, and by virtue of such license he became entitled to perform certain services before the Patent Office and elsewhere.
>
> "Defendant's contention is based on his interpretation of the rules of the United States Patent Office in force in the year 1918 at the time of his registration in the United States Patent Office, the pertinent rule 17 then being as follows:
>
> "'*A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent.* * *
>
> "'(b) Any person not an attorney at law who is a citizen or resident of the United States who has had three years' experience in patent work under

the personal direction and supervision of a duly registered patent attorney * * * and who shall file proof to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.'

* * * * * * * * *

"The decree found substantially as follows: that the defendant is not licensed to practice law in the State of Illinois or elsewhere, but on December 16, 1918 was registered to practice before the United States Patent Office; that about January, 1930, defendant moved to Chicago and opened offices at 35 East Wacker Drive, has maintained offices there continuously, and has practiced during all of such time as a patent attorney upon a paid basis; that from 1931 to 1941 he had as office associates men who had been admitted to the bar of the State of Illinois; that the stationery used in the early part of his practice described himself as an attorney without qualifications as to his limitations, and had associated with him as 'of counsel' men who were admitted to the bar of the State of Illinois; that his stationery was changed in 1941 to read, 'Patent Attorney' and 'Patent and Trade Mark Attorney'; that in several instances the defendant employed attorneys whom he paid for legal services from fees which he collected from his clients and that he employed attorneys for work to be done for clients whom such attorneys had never met and without the relationship of attorney and client ever having been established; that defendant in his correspondence has repeatedly held himself out as 'attorney at law' and that he has also participated as an attorney at law in legal proceedings; that the defendant

repeatedly construed patent licenses and gave opinions with respect to the infringement of patents and on at least one occasion wrote a letter charging a company with violation of, and infringement upon, certain patents of a client of defendant, threatening it with litigation; that defendant has been paid for legal services involved in the preparation of infringement opinions and has made a charge in relation to an infringement suit, including the study of patent claim, extension of time in which to file defendant's answer, study of license agreement and preparation of an answer in the infringement suit.

* * * * * * * * *

"The decree enjoins the defendant, his agents and employees from:

"'(1) Rendering legal opinions relating to infringement and enforcement of patents and trade marks;

"'(2) Preparing, drafting and filing pleadings and other legal documents and papers in suits at law and in equity in courts of record and before administrative tribunals, *other than the United States Patent Office;*

"'(3) Participating as an attorney in legal proceedings *other than United States Patent Office;*

"'(4) In behalf of persons represented by him, threatening to bring suit against other parties;

"'(5) Preparing and serving notice of and asserting attorney's lien under Section 14 of Chapter 13, Illinois Revised Statutes; and

"'(6) Charging and collecting fees for legal services rendered by him or rendered by him and by others in legal proceedings, *other than wherein the United States Patent Office has jurisdiction.*'

* * * * * * * * *

"We have come to the conclusion that the evidence before us clearly indicates that for a long period of time defendant was engaged in the unauthorized practice of law within the meaning of the Illinois authorities; *and we are of the opinion that the courts of the State of Illinois have the power to determine what contravenes its policy in this respect independent of any other authority.* Article I, Section 8, of the constitution of the United States, under which provision defendant claims his rights were violated, provides, 'The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries * * *.' *Defendant further maintains that the power to regulate patents was by an Act of Congress conferred upon the Department of the Interior at the time the license was issued to him, and that under its authorization the Patent Office was empowered to permit certain practitioners, including the defendant, to practice before it.*

*"The fallacy of defendant's argument lies in the implication that the Patent Office had the right to permit the exercise of prerogatives which are forbidden under the laws of the State of Illinois as constituting unauthorized practice. No such authorization was issued by the United States Patent Office to defendant, nor was any power inherent in the Patent Office to permit defendant to practice law.*

*"Defendant argues that* the United States Patent Office makes no distinction as to the rights or duties of attorneys at law and patent attorneys who were not attorneys at law, but who were admitted prior to the change in the rules; and that *patent attorneys who were not attorneys at law* and were admitted prior to the change *have the same rights, privileges, and duties as the patent*

*attorneys at law* who solely are admitted under the new rule. *With this proposition we thoroughly disagree. The Patent Office did not undertake to invest non-attorneys with the same rights, privileges, and duties as those had by attorneys at law in contravention of the well defined rulings of the courts of Illinois.* The police power and the procedure thereunder covering the enrollment and disbarment of lawyers and the punishment of unauthorized practitioners subject to its jurisdiction is a matter reserved for determination by the Judicial Department of the State of Illinois. As was said in Pennoyer v. Neff, 95 U.S. 714, at page 722, 24 L.Ed. 565:

"'* * * every State has the power to determine for itself the civil status and capacities of its inhabitants; to prescribe the subjects upon which they may contract, the forms and solemnities with which their contracts shall be executed, the rights and obligations arising from them, and the mode in which their validity shall be determined and their obligations enforced; and also to regulate the manner and conditions upon which property situated within such territory, both personal and real, may be acquired, enjoyed, and transferred. * * *'

* * * * * * * * * *

"The Patent Office, however, did not attempt to enlarge upon its authority as it never attempted to authorize defendant to practice law. *Rule 17 in effect prior to 1938 merely provided that, in the very limited field defined, qualified non-attorneys might represent applicants 'in the presentation and prosecution of applications for patents.' This is a far different proposition from the one for which counsel contends, namely, that non-attorneys at law have the same rights, privileges, and duties as patent attorneys at law. The injunctional order does not take away any constitutional rights of defendant because the defendant never*

*had any right, either directly or indirectly, to practice law.*

* * * * * * * * *

"Another consideration which weighs heavily with this court is the fact that up until the date of the filing of the bill in this case defendant used letterheads which would lead any layman who viewed them to conclude that defendant was a patent attorney vested with all the capabilities and privileges of an attorney at law. In a case of this kind, the general welfare of the public is of primary concern. The public are entitled to protection against unauthorized practitioners of the law, and the courts should lend a ready hand to suppress the evil by way of injunctional relief wherever it appears. The fact that the unauthorized practice may have been without malevolence, under a misapprehension as to rights, renders the menace none the less formidable nor the remedy by injunction none the less appropriate.

* * * * * * * * *

"From what we have heretofore said, it is obvious defendant has no right to charge or collect fees for legal services. *In restricting defendant's disability to charge and collect fees for legal services rendered in proceedings other than where the Patent Office has jurisdiction, the chancellor was in error*, and the cross-error of plaintiffs on this score is well assigned. *Defendant has no right to collect fees for legal services wherever rendered.*

"Plaintiff assigns cross-error on finding 18 of the chancellor, which finding is as follows:

"'18. The Court further finds that the defendant has been preparing, drafting and construing assignments, leases and other documents relating to letters patent. The rules of the United States Patent Office provide forms for the preparing of certain papers, including the assignment of patents, licenses for royalty and many other forms.

Whether such forms may be used and are intended for the use of Patent Attorneys, whether they are licensed to practice in a state or have a license similar to the license issued to the defendant, should properly be determined by the United States Patent Office. *In the preparation, drafting and construing of assignments, leases and licenses, the defendant has not been practicing law in violation of the law of the State of Illinois,*'

"*This finding of the decree, to which cross-error is assigned, is erroneous. The courts of the State of Illinois, and not the United States Patent Office, may determine what constitutes the illegal practice of law in this State.* The fact that the defendant used forms instead of original documents is not controlling upon the question of whether or not he was engaged in the practice of law. We have heretofore said that the preparing, drafting, and construing of assignments, leases, and other such documents relating to letters patent, constitute the practice of law; and insofar as the decree authorizes the preparation, drafting, and filing of pleadings anywhere, it is erroneous.

"Defendant in his answer has asserted that he has the right to perform certain specified services. In his reply brief he asserts that the only issue before this court is to determine whether or not he has the legal right to perform these acts. The issue before us is not what things defendant may do under the authority he claims from his license to appear before the United States Patent Office, but what things, if any, he has done in violation of the laws of the State of Illinois and what, from his past conduct, he may reasonably be expected to do in the future. . . .

• • • • • • • • • •

"Accordingly, the decree of the Superior Court is reversed and the cause is remanded with directions *to enter a decree which shall be without prej-*

*udice to defendant's rights to advise and assist applicants for patents in the presentation and prosecution of their applications for patents before the United States Patent Office, but which shall enjoin the defendant from the following activities:*

"1. *Giving legal advice;*

"2. *Preparing, drafting and construing legal documents,* contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property;

"3. *Rendering legal opinions,* including legal opinions relating to title to, and validity, infringement and enforcement of, patents and trade marks and rights therein and thereto;

"4. *Preparing, drafting and filing pleadings and other legal documents* and papers *in suits at law and in equity,* in courts of record and before administrative tribunals, *other than the Patent Office;*

"5. *Participating, as an attorney, in legal proceedings;*

"6. In behalf of persons represented by him, threatening to bring suit against other parties;

"7. Preparing and serving notice of and asserting attorney's lien under Section 14 of Chapter 13, Illinois Revised Statutes;

"8. *Charging and collecting fees for legal services rendered by him and rendered by him and others.*" (Emphasis added.)

While the court's decree expressly was "without prejudice to defendant's rights to advise and assist applicants for patents in the presentation and prosecution of their applicants before the United States Patent Office," the Florida Supreme Court pointed out that "Apparently the court was not asked to and did not enjoin the preparation of applications for

letters patent and of amendments to such applications. However, it did enjoin the charging of fees for legal services, including those wherein the Patent Office had jurisdiction." (R. 57) Also, it enjoined the "preparing, drafting and construing legal documents," *supra*, p. 28.

**The Tax Field:** Here the same question has been similarly decided. Here the contention was that recognition of an accountant to practice before the Treasury Department pursuant to the Act of July 7, 1884, 23 Stat. 236, 5 U.S.C. § 261 (which is virtually identical to Rev. Stat. § 487), included authorization to practice law relating to federal taxation in California. That suggestion was decisively rejected in *Agran* v. *Shapiro* (1954), 127 Cal. App. 2d 807, 273 P. 2d 619. There, the court denied recovery of a fee for legal services incident to federal taxation rendered in California by an accountant admitted to practice before the Treasury Department but not admitted to practice law in California, on the ground that the accountant was engaged in the unauthorized practice of law. Again, we quote from the opinion at length (273 P. 2d 619, 627-630) because of its pertinence to the question.

> "From what has been said, we would have but little hesitancy in concluding that the services rendered by plaintiff other than those involved in the preparation of the income tax returns and possibly others of an accounting character constitute the practice of law as that term has been judicially defined in this State. Kountz v. Rowlands, 1943, 46 Pa. Dist. & Co. 461, 463. The more serious questions which present themselves, however, are (1) whether the controlling test of what constitutes the practice of law in the field of federal income taxation is dictated by federal legislation, congressional or administrative, and (2) the effect of the federal regulations which have been adopted in

this field. Upon behalf of the plaintiff, it is urged by *amicus curiae* that an affirmative answer is required to the first inquiry and that, inasmuch as plaintiff was enrolled as an agent in the Treasury Department, and by virtue thereof licensed to practice before that Department, all of his activities in the instant case were within the scope of such license, and any action by a state court which would interfere with or curtail the right so granted is not only unwarranted but unconstitutional.

"By the Act of July 7, 1884, sec. 3, 23 Stats. 258, 5 U.S.C.A. § 261, the Secretary of the Treasury is authorized to prescribe 'regulations governing the recognition of agents * * * representing claimants before his departments * * *.' Pursuant to this statutory authority, the Secretary issued Circular 230 (now parts 10 and 13, Subtitle A, Tit. 31, Code Fed. Reg.), which insofar as material here reads as follows: 'An agent enrolled before the Treasury Department shall have the same rights, powers and privileges and be subject to the same duties as an enrolled attorney; *Provided*, that an enrolled agent shall not have the privilege of drafting or preparing any written instrument by which title to real or personal property may be conveyed or transferred for the purpose of affecting Federal taxes, nor shall such enrolled agent advise a client as to the legal sufficiency of such an instrument or its legal effect upon the Federal taxes of such client: *And provided further, That nothing in the regulations in this part shall be construed as authorizing persons not members of the bar to practice law.*' Code Fed. Reg., sec. 10.2(f), Tit. 31, Subtit. A, Part 10.

"Practice before the Treasury Department shall be deemed to comprehend all matters connected with the presentation of a client's interests to the Treasury Department, including the preparation and filing of necessary written documents, and correspondence with the Treasury Department relative to such interests. Unless otherwise stated, the term 'Treasury Department,' as used in this para-

graph and elsewhere in this part, includes any division, branch, bureau, office, or unit of the Treasury Department, whether in Washington or in the field, and any officer or employee of any such division, branch, bureau, office or unit. Id., sec. 10.2(b).

"In this connection also, reference should be made to Rule 2 of the former United States Board of Tax Appeals, 26 U.S.C.A. Int.Rev.Code, following sec. 5011, now Tax Court of the United States,[10] for the admission to practice, after examination, of citizens without restriction to members of the bar or certified public accountants, and the validity of such rule has been recognized. Goldsmith v. U. S. Board of Tax Appeals, 1926, 270 U.S. 117, 46 S.Ct. 215, 70 L.Ed. 494, 496; Crane-Johnson Co. v. Commissioner of Internal Revenue, 8 Cir., 1939, 105 F. 2d 740, 744. . . .

• • • • • • • • • •

"No case which we have been able to discover has undertaken to directly decide the precise question with which we are confronted, namely, whether the Treasury Regulations referred to have the effect of declaring that service performed by an enrolled agent in connection with federal income tax matters do not constitute the practice of law in the sense that such practice is prohibited, by state law, when engaged in by other than members of the bar. . . .

• • • • • • • • • •

"More closely in point and supporting plaintiff's position is De Pass v. B. Harris Wool Co., 1940, 346 Mo. 1038, 144 S.W. 2d 146, wherein plaintiff, a non-lawyer licensed to practice before the Interstate Commerce Commission, sought to recover for services rendered *before that body in certain rate reduction cases* on behalf of the defendant.

[10] 26 U.S.C.A. § 1111.

Defendant demurred upon the ground that the alleged contract called for services which, under the law of Missouri, constituted the practice of law, and hence plaintiff was barred from recovery. The Supreme Court of Missouri, though apparently of the view that, judged by Missouri law, the services in question constituted the practice of law, held that the question was foreclosed by the Rules of Practice of the Interstate Commerce Commission, 49 U.S.C.A. Appendix following sec. 1185, which permitted laymen licensed by it to practice before it. Says the court, 144 S.W. 2d at page 148: 'Defendant seems to argue that the right to define the practice of law and to regulate persons engaging in such practice falls within the police power of the state. So it does, except in so far as that right does not run contra to an Act "made in pursuance" to the Federal constitution.'

"It does not appear, however, that the rule of the Interstate Commerce Commission there involved contained any limitation with respect to the practice of law as does the Treasury Regulation under consideration.

"In re Lyon, 1938, 301 Mass. 30, 16 N.E. 2d 74, cited on behalf of plaintiff, and relied upon in De Pass v. B. Harris Wool Co., just considered by us, is, we believe, factually distinguishable. Moreover, it must be viewed in the light of the discussion in the more recent decision of the same court—Lowell Bar Ass'n v. Loeb, 1943, 315 Mass. 176, 52 N.E. 2d 27, wherein the court adverted to but did not undertake to determine the effect of the Treasury Regulations previously referred to. The court there said, 52 N.E. 2d at page 33: *'Neither do we consider at this time whether the permission granted to certified public accountants and other persons not members of the bar to practise in tax matters by the rules of the United States Treasury Department and of* the administrative tribunal (Helvering v. Rankin, 295 U.S. 123, 131, 55 S.Ct.

732, 79 L.Ed. 1343; Higgins v. Commissioner of Internal Revenue, 312 U.S. 212, 61 S.Ct. 475, 85 L.Ed. 783) now called *the Tax Court* of the United States, *can have the effect of granting by implication to holders of "Treasury enrollment cards" a right to perform in this Commonwealth services in connection with Federal taxes which in their nature are comprised in the practice of law.* It may deserve consideration whether the rules of a Federal administrative tribunal can legalize acts done in the States in matters not actually before the tribunal, though of a class that might eventually come before it. Matter of Lyon, 301 Mass. 30, 34-36, 16 N.E. 2d 74; De Pass v. B. Harris Wool Co., 346 Mo. 1038, 144 S.W. 2d 146.'

"*We are convinced that the effect of the Treasury Regulations is to declare that acts constituting the practice of law in the accepted sense could lawfully be performed by non-members of the bar, we would entertain the same doubts as those suggested by the Supreme Judicial Court of Massachusetts* in the portion of the opinion quoted above. Cf. Chicago Bar Ass'n v. United Taxpayers of America, 1941, 312 Ill.App. 243, 38 N.E. 2d 349, holding the rule of Department of Finance permitting non-lawyers to appear before it in behalf of taxpayers void insofar as it purported to authorize such to perform acts constituting practice of law. *We do not, however, believe that the regulations in question were intended to or have the effect contended for on behalf of plaintiff. We regard as highly significant the concluding clause in section 10.2(f) 'that nothing in the regulations in this part shall be construed as authorizing persons not members of the Bar to practice law.'* This statement must be read in context with the opening sentence of the section providing that 'An agent enrolled before the Treasury Department shall have the same rights, powers and privileges * * * as an enrolled attorney' and as qualifying the same. As ad-

mittedly the Treasury Department is without authority to prescribe the rights and privileges to be exercised by persons except those appearing before it upon behalf of others, this provision could only have been intended as a disavowal of any intent upon the part of the Secretary of the Treasury to confer authority upon enrolled agents, not members of the bar, to perform acts upon behalf of others in connection with matters before the department which would otherwise constitute the practice of law. We cannot subscribe to the argument advanced upon behalf of the plaintiff that this provision was merely 'a catch-all clause designed to prevent enrolled agents from holding themselves out as general attorneys' and 'to limit the authority granted an enrolled agent to the precise field of Federal income taxation.' Rather it suggests a recognition that 'practice before the Treasury Department,' while it may include acts which do not constitute the practice of law, and hence within the authority of enrolled agents, though not lawyers, to perform, also comprehends others of such character as to bring them within this classification. See Petition of Kearney, Fla. 1953, 63 So. 2d 630.

"In essence plaintiff's contention is that the effect of the Treasury Regulations is to declare that an enrolled agent, though not a lawyer, may, in the representation of others in tax matters before the Treasury Department, lawfully perform all of the services which a member of the bar is authorized to perform except 'the privilege of drafting or preparing any written instrument by which title to real or personal property may be conveyed or transferred for the purpose of affecting Federal taxes' or advising 'a client as to the legal sufficiency of such an instrument or its legal effect upon the Federal taxes of such client.' If this be true, we see no reason for the concluding proviso in 10.2(f), disavowing any intent to there-

by authorize non-lawyers to perform acts in connection with tax matters before the Department which would constitute the practice of law." (Emphasis added.)

In the second *Agran* case, decided September 20, 1956 (Unauthorized Practice News, Volume XXII, December, 1956, No. 4, page 34) the California Court, among other things, made the following potent statement:

"Reduced to its simplest form, plaintiff's argument in effect is this: by virtue of the Treasury Regulation (31 C.F.R. 10.2) an enrolled agent though a non-lawyer is at liberty to perform any and all services and give advice upon legal questions which constitute the practice of law, within the meaning of that term as generally understood so long as the work is performed or the advice is given in connection with a matter involving or arising under the federal Internal Revenue Code and pending before the Treasury Department. This is pointed up by plaintiff's suggestion that the decision in the *Bereu case* (78 N.Y.S. 2d 209) would have been different if the respondent there had been enrolled (which he was not) as an agent by the Treasury Department, but if that court was correct, as we believe it was, in concluding that the services rendered by Mr. Bereu constituted the practice of law, the necessary effect of plaintiff's argument is that a state may not regulate the practice of law within its borders by prohibiting laymen from practicing law at least insofar as relates to matters and questions arising under Internal Revenue Code so that what constitutes the practice of law no longer depends upon what is done but by whom. If this be true, the same act which would constitute the practice of law under the law of this State if performed here and which if performed by a non-lawyer not en-

rolled as an agent by the Treasury Department would subject him to criminal prosecution, would not constitute the practice of law if performed by a non-lawyer so enrolled. *To accept the plaintiff's argument would simply mean that the individual States are in effect deprived of their traditional and long recognized right to regulate the practice of law within their borders at least insofar as such practice involves matters of so-called 'tax law.'* If this is to be the rule we feel it should be announced by some higher authority.

"Nothing said herein or in our previous opinion implies a holding, as plaintiff seems to think, that the Treasury Department may not prescribe the qualifications of those whom it will recognize as agents or attorneys of others having business with the Department but rather that *by such recognition it may not confer upon persons who are not members of the bar authority to perform services within a State which, under its laws, constitute the practice of law in violation of that State's laws.*" (Emphasis added.)

In *In Re Bercu* (1948), 273 App.Div. 524, 78 N.Y.S. 2d 209, 9 A.L.R. 2d 787, affirmed 299 N.Y. 728, 87 N.E. 2d 451, the New York Court recognized that admission by an accountant to the Treasury Department did not give him a right "to practice tax law at large," saying:

"We are unable, therefore, to regard the admission of accountants, subject to certain qualifications and regulations of the Treasury Department and the Tax Court, to practice before these agencies, as an authorization to accountants to practice tax law at large or as an eradication of the distinction between the lawyer's and the accountant's function in the tax field."

Other cases in which the courts have recognized that admission to practice before Federal agencies does not

constitute a license to practice law without compliance with State regulation of the practice of law include the following:

*Petition of Kearney* (Fla. 1953), 63 So. 2d 63 (practice before the Treasury Department pursuant to 5 U.S.C. § 261, does not authorize practice of federal tax law in Florida).

*In re Gibbs* (Arizona 1929), 278 P. 371 (practice before the Interior Department pursuant to 5 U.S.C. § 493 does not authorize Arizona member of the bar to solicit such practice).

## POINT THREE

### WHERE VESTED WITH JUDICIAL POWER, THE COURTS ALONE HAVE THE RIGHT TO ADMIT PERSONS TO THE BAR AND TO DISBAR, AND TO DEFINE THE PRACTICE OF LAW AND TO EXCLUDE UNAUTHORIZED PERSONS THEREFROM. THE LEGISLATURE HAS NO POWER TO AUTHORIZE PEOPLE TO PRACTICE LAW

#### A. The Courts Vested with Judicial Power Have the Right to Admit to the Bar and to Disbar

As with the Constitution of the United States, State constitutions generally vest the judicial power of government in the Courts; and where the judicial power is vested in the courts, it is the universal weight of authority that, as an incident of judicial power, the courts have authority to admit to the Bar and disbar.

Thus in *Ex Parte Garland*, 4 Wall. (1867) 333, 18 L.Ed. 366, Garland made a motion for leave to practice as an attorney and counselor of this Court. The Congress, however, by act of January 24, 1865, had undertaken to impose a requirement of its own as a qualification for the right of an attorney and counselor of this Court to continue to practice in it. This qualification was a test oath, that the applicant had never "sought nor accepted, nor attempted to exercise, the functions of any office whatever . . . in hostility to the United States," etc. In fact, Garland had been a leading citizen in Arkansas and had been a member of the State Senate of the Confederate State of Arkansas, and a member of the Congress of the Confederacy, during the Rebellion. But in July 1865, he received from the President of the United States a full pardon for all offenses committed by his participation therein. Accordingly, Garland produced his pardon, and moved for leave to continue to practice as an attorney and

counselor of the Court without making the oath required by the act of January 24, 1865.

This Court granted the motion. It held that the admission of attorneys of this Court is the "*exercise of judicial power*" (4 Wall. 379), for which Congress could not prescribe qualifications. Thus, this Court, in an opinion by Mr. Justice Field, among other things, said (p. 379):

> "Attorneys and counselors are not officers of the United States; they are not elected or appointed in the manner prescribed by the Constitution for the election and appointment of such officers. They are officers of the court; admitted as such by its order, upon evidence of their possessing sufficient legal learning and fair private character. It has always been the general practice in this country to obtain this evidence by an examination of the parties. In this court the fact of the admission of such officers in the highest court of the states to which they respectively belong, for three years preceding their application, is regarded as sufficient evidence of the possession of the requisite legal learning, and the statement of counsel moving their admission sufficient evidence that their private and professional character is fair. The order of admission is the judgment of the court that the parties possess the requisite qualifications as attorneys and counselors, and are entitled to appear as such and conduct causes therein. From its entry the parties become officers of the court and are responsible to it for professional misconduct. They hold their office during good behavior, and can only be deprived of it for misconduct ascertained and declared by the judgment of the court after opportunity to be heard has been afforded. *Ex parte Heyfron*, 7 How. (Miss.) 127; *Fletcher* v. *Daingerfield*, 20 Cal. 430. *Their admission or their exclusion is not the exercise of a*

*mere ministerial power. It is the exercise of judicial power, and has been so held in numerous cases.*"

The Court then cited several State cases so holding.

*Theard* v. *United States* (1957), 354 U.S. 278, 1 L.Ed. 2d 1342, 77 S.Ct. 1274 and *Ex Parte Secombe* (1857), 19 How. 9, 15 L.Ed. 565, *supra* p. 34, are to the same effect.

The State cases hold similarly that, where the judicial power of the sovereign is vested in the Courts, the Courts have the authority to admit to the Bar and to disbar. See the cases cited in the next section, B.

**B. "Authority to Admit to the Bar and to Disbar Necessarily Carries With It Power to Define What Constitutes the Practice of Law and to Exclude Unauthorized Persons Therefrom"**

The quotation in the heading is from the leading case of *Rhode Island Bar Association* v. *Automobile Service Association* (1935), 55 R.I. 122, 179 A. 139, 142. Again, it is the universal weight of authority that, when the judicial power is vested in the Courts, carrying with it the right to admit persons to practice law, such power also carries with it the power to define what constitutes the practice of law and to exclude unauthorized persons therefrom. State legislatures—and also Congress—have no power to authorize people to practice law.

Thus, in *In Re Opinion of the Justices* (1935), 289 Mass. 607, 194 N.E. 313, which is frequently cited on this point, the Supreme Court of Massachusetts rendered an advisory opinion to the State Senate on the question as to whether it was "constitutionally competent" Legislature to enact legislation admitting or forbidding corporations or others to practice law outside the courts of Massachusetts. In answering this ques-

tion in the negative, the Court, among other things, said:

> "It is inherent in the judicial department of government under the Constitution to control the practice of the law, the admission to the bar of persons found qualified to act as attorneys at law and the removal from that position of those once admitted and found to be unfaithful to their trust. While the judicial department cannot be circumscribed or restricted in the performance of these duties, appropriate and essential assistance in discharging them may be afforded by the enactment of statutes. As the questions are framed and as a general proposition, *valid permission to practice law cannot be given by the General Court* except subject to the requirements for admission to the bar established by the judicial department. Opinion of the Justices, 279 Mass. 607, 180 N.E. 725, 81 A.L.R. 1059." (p. 316) (Emphasis added)

In another leading case, *People* v. *People's Stock Yards State Bank* (1931), 344 Ill. 462, 176 N.E. 901, *supra*, a bank, which was practicing law in the real estate and other fields, was found guilty of contempt of Court for engaging in the practice of law and enjoined from continuing to do so. The Court, among other things, made the following cogent statement, which has been frequently quoted or referred to:

> "Under the Constitution of this state, the judicial power is vested solely in the courts. Const. art. 6 par. 1, and article 3; Missouri River Telegraph Co. v. First Nat. Bank, 74 Ill. 217; in re Day, 181 Ill. 73, 54 N.E. 646, 50 L.R.A. 519. Included in this grant are all powers necessary for complete performance of the judicial functions. State of Illinois v. Illinois Central Railroad Co., 246 Ill. 188, 92 N.E. 814. Although the Constitution does not expressly confer upon this court

power and jurisdiction with respect to the admission of attorneys to practice law, such power and jurisdiction are necessarily implied and are inherent in this court. In re Day, supra. As a part of such inherent power, this court may not only determine the educational and moral qualifications of applicants for admission to the bar, but may also discipline or disbar attorneys for misconduct. People v. Chamberlain, 242 Ill. 260, 89 N.E. 944; People v. Czarnecki, 268 Ill. 278, 109 N.E. 14. Attorneys are officers of this court, and their conduct as such is subject to supervision by it. They are, in effect, a part of the judicial system of the state. In re Day, supra. People v. Czarnecki, supra; Ex Parte Secombe, 19 How. 9, 15 L. Ed. 565; Ex parte Wall, 107 U.S. 265, 2 S.Ct. 569, 27 L.Ed. 552. The power to prescribe the qualifications which will entitle an applicant to be admitted to the bar is judicial, as is also the power to discipline or disbar attorneys for professional misconduct either in court proceedings or their relations with clients outside of court." (p. 905)

"Having inherent and plenary power and original jurisdiction to decide who shall be admitted to practice as attorneys in this state, this court also has all the power and jurisdiction necessary to protect and enforce its rules and decisions in that respect. Having power to determine who shall and who shall not practice law in this state, and to license those who may act as attorneys and forbid others who do not measure up to the standards or come within the provisions of its rules, it necessarily follows that this court has the power to enforce its rules and decisions against offenders, even though they have never been licensed by this court. Of what avail is the power to license in the absence of power to prevent one not licensed from practicing as an attorney? *In the absence of power to control or punish unauthorized persons who presume to practice as attorneys and officers of*

*this court the power to control admissions to the bar would be nugatory.* And so it has been held that the court, which *alone* has authority to license attorneys, has as a necessary corollary ample implied power to protect this function by punishing unauthorized persons for usurping the privilege of acting as attorneys." (p. 906) (Emphasis added).

In *Bump* v. *District Court of Polk County* (1942), 232 Iowa 623, 5 N.W. 2d 914, a non-lawyer was found guilty of the unauthorized practice of law. The Court, among other things, said:

"Under the Constitution of Iowa, vesting judicial power exclusively in the courts, Article V, Section 1, and Section 12542 of the Code, the courts of this State are vested with complete authority to punish by contempt proceedings unlawful practice. See, also Johnson v. Purcell, supra, and cases cited therein.

"It is stated in Brand's 'Unauthorized Practice of the Law' (1937) at p. 12: 'The inherent power of the courts as to contempt and disbarment has been consistently recognized since a nearly date. In 1899, the principle of inherent judicial power was sustained as to bar admissions,' citing In re Day (1899), 181 Ill. 73, 54 N.E. 646, 50 L.R.A. 519. 'Subsequently it was judicially applied to ambulance chasing and to the unauthorized practice of the law,' citing among many others In re Morse (1924), 98 Vt. 85, 126 A. 550, 36 A.L.R. 527; People ex rel. Illinois State Bar Assn. v. People's Stock Yards State Bank (1931), 344 Ill. 462, 176 N.E. 901; Unger v. Landlords' Management Corp., 114 N.J. Eq. 68, 168 A. 229; State ex rel. Boynton v. Perkins, 138 Kan. 899, 28 P. 2d 765; Fitchette v. Taylor, 191 Minn. 582, 254 N.W. 910, 94 A.L.R. 356; Rhode Island Bar Assn. v. Automobile Service Assn. (1935), 55 R.I. 122, 179 A. 139, 100 A.L.R.

226; In re Opinion of the Justices (1935), 289 Mass. 607, 194 N.E. 313; Meunier v. Bernich, La. App., 170 So. 567; State ex rel. Wright v. Barlow (1936), 131 Neb. 294, 268 N.W. 95; Richmond Assn. of Credit Men, Inc. v. Bar Assn. of City of Richmond (1937), 167 Va. 327, 189 S.E. 153; State ex rel. Freebourn v. Merchants' Credit Service, Inc. (1937), 104 Mont. 76, 66 P. 2d 337; People ex. rel. Chicago Bar Assn. v. Goodman (1937), 366 Ill. 346, 8 N.E. 2d 941, 111 A.L.R. 1" (p. 917).

The following more recent cases are to the same effect, most of them appearing subsequent to the publication of Brand's "*Unauthorized Practice of the Law*" in 1937.

*Grand Rapids Bar Assn.* v. *Denkema* (1939), 290 Mich. 56, 287 N.W. 377;

*State* v. *Kark* (1937), 133 Neb. 625, 276 N.W. 380;

*State Bar Assn.* v. *Connecticut Bank & Trust Co.* (1958), 145 Conn. 222, 140 A. 2d 863;

*Nelson* v. *Smith* (1944), 107 Utah 382, 154 P. 2d 634;

*Washington State Bar Assn.* v. *Washington Assn. of Realtors* (1952), 41 Wash. 2d 697, 251 P. 2d 619;

*Clark* v. *Austin* (1937), 340 Mo. 467, 101 S.W. 2d 977;

*In re Lavine* (1935), 2 Cal. (2d) 324, 41 P. 2d 161;

*In re Baker* (1951), 8 N.J. 321, 85 A. 2d 505;

*Arkansas Bar Assn.* v. *Union Natl. Bank* (1954), 224 Ark. 48, 273 S.W. 2d 408;

*Opinion of the Justices* (1932), 279 Mass. 607, 180 N.E. 725;

*Curry* v. *Dahlberg* (1937), 341 Mo. 897, 110 S.W. 2d 742;

*Gardner v. Conway* (1951), 234 Minn. 468, 48 N.W. 2d 788;

*New Jersey State Bar Assn.* v. *Northern N.J. Mtg. Assn.* (1956), 22 N.J. 184, 123 A. 2d 498;

*West Virginia State Bar* v. *Earley* (1959), 144 West Va. 504, 109 S.E. 2nd 420.

The foregoing cases are clear that, under the doctrine of separation of powers in American constitutional theory generally, only the Courts vested with judicial power may admit to the Bar and disbar, and define what constitutes the practice of law and exclude unauthorized persons therefrom.

Conversely, under the separation of powers, a State legislature—or Congress—may assist the judiciary with statutes prohibiting unauthorized practice, but may *not* exclude the judiciary from or interfere with its exercise of Constitutional power to regulate and define what constitutes the practice of law, and to exclude unauthorized persons therefrom. This is pointed out in *Opinion of the Justices* (1935), 289 Mass. 607, 194 NE 313, *supra*. And in *Meunier* v. *Bernich* (La. App. 1936), 170 So. 567, a statute excepting lay adjusters from the regulation of the practice of law was held unconstitutional as a violation of the separation of powers of the Louisiana Constitution. Other cases to the same effect are:

*State ex rel. Wright* v. *Barlow*, 131 Neb. 284, 268 N.W. 95 (1936); 132 Neb. 166, 271 N.W. 282 (1937).

*Grievance Committee* v. *Dean*, 190 S.W. 2d 126 (Tex. Civ. App. 1945)—legislature may pass stat-

utes in aid of the judiciary but cannot exclude the judiciary from its constitutional power to regulate and define practice of law.

*Grievance Committee* v. *Corgell*, 190 S.W. 2d 430 (Tex. Civ. App. 1945).

*Appeal of Cichon*, 227 Wis. 62, 278 N.W. 1 (1938).

*People ex rel. Chicago Bar Ass'n* v. *Motorists Ass'n*, 354 Ill. 595, 188 N.E. 827 (1933).

*Washington State Bar Ass'n* v. *Wash. Ass'n of Realtors*, 41 Wash. 2d 697, 251 P.2d 619 (1952).

Accordingly, neither a State legislature—nor Congress—has the power to authorize people to practice law. That power rests solely in the Courts vested with judicial power.

### C. Neither the Legislature Nor an Administrative Agency May Authorize a Person to Practice Law Before the Agency

It appears to be the universal weight of authority that, where the judicial power is vested in the Courts, neither the State legislature nor a State administrative agency may authorize a person to practice law before the agency.

In *State of Wisconsin* v. *Keller*, 16 Wis. 2d 377, 114 N.W. 2d 796 (1962), petition for *certiorari* filed Oct. 12, 1962, 31 U.S. Law Week 3104 (No. 429, Oct. Term, 1962), the respondent below, not a member of the Wisconsin Bar but a licensed practitioner before the Interstate Commerce Commission and the Public Service Commission of Indiana, was enjoined from practicing law before the Wisconsin Public Service Commission notwithstanding that the relevant Wisconsin statute and rule authorized laymen to represent persons before the Public Service Commission. The court below found respondent's unauthor-

ized activities to include the following (114 N.W. 2d 796, 799, 800):

> "... Respondent, admittedly not a member of the Wisconsin bar, has engaged in considerable activity before the Wisconsin Public Service Commission for the past seven years. He has made applications to the P.S.C. in behalf of his clients for authority to conduct teaching operations, handled proceedings on behalf of teachers with respect to several applications, appeared before the P.S.C. on behalf of various teachers and in opposition to the granting of permits to other teachers. In the course of these proceedings respondent has examined witnesses and taken such steps as necessary to make a record upon which formal action may be taken by the commission adjudicating the rights of the parties."

The statute involved authorized the Public Service Commission "to adopt rules to govern its proceedings." Pursuant thereto, the Public Service Commission had adopted rules of practice authorizing persons appearing before it to be represented by an "agent or attorney."

In answer to respondent's contentions that practice was authorized by this statute and also by the fact of his license to practice before the Interstate Commerce Commission and Public Service Commission of Indiana, the court stated, among other things, the following (114 N.W. 2d 796, 801):

> "*The Legislature's creation of the Public Service Commission does not in any way supersede the exclusive power of the judiciary,* ultimately residing in the Supreme Court, to *determine what is or is not the practice of law and to restrict such practice to persons licensed by the court to engage in it.* For purposes at least, accepting respondent's

interpretation of the scope of the P.S.C. Rule 2.32, the *Commission can listen to or be advised by anyone it likes on any matter coming before that body. But its tolerance does not avert the consequences* to *an individual who is guilty of practicing law without a license. The admission of a person to practice law is constitutionally an exclusive power of the court and the attempt to exercise it by the Legislature itself (or its agency) is unconstitutional and void. . . .*

• • • • • • • • • •

*"In like manner the Public Service Commission* may countenance appearances before it by laymen but it *may not by any rule or otherwise empower any person not licensed to practice law* to practice before it, or to *grant immunity to one who does. We hold, further, that the alleged lawfulness* of *respondent to engage in similar activities* in *other jurisdictions, such as in the State of Indiana or before the Interstate Commerce Commission, is immaterial in the case at bar.* Respondent's activities in Wisconsin and his compliance or the lack of it with Wisconsin law are the controlling facts and the law applicable. *Foreign bodies can no more authorize persons unlicensed in this state to practice law here than could the Public Service Commission of Wisconsin."* (Emphasis added).

In *Hoffmeister* v. *Todd* (Mo. 1961), 349 S.W. 2d 5, Todd, a layman, was charged with unlawful practice of law before the divisions of Workmen's Compensation and of Employment Security of the Missouri Department of Labor and Industrial Relations. The court held that his activities before these agencies constituted the practice of law for which he was held in contempt of court, fined $250 and enjoined from continuing such practice. His defense that his activities before the Division of Employment Security was au-

thorized by statute was overruled. In so holding, the court stated, among other things, the following (349 S.W. 2d 5, 16, 17):

> "Wholly apart from statute, Todd has been practicing law. . . . He has long engaged in the business of, and *has held himself out* as being capable of advising members of the public as to their rights under the Workmen's Compensation law including the evaluation of their claims, legally and otherwise, and he has regularly negotiated and brought about, through his advocacy, compromise settlements of a multitude of such claims. This can be nothing other than the practice of law. . . .
>
> • • • • • • • • • •
>
> ". . . We recognize full well this profusion of administrative tribunals, of lay 'experts' and specialists, and of multiplied governmental function; many of course are federally created and operate under federal laws and regulations. These developments, from whatever perspective we view them, have not relieved or deprived this court of its inherent duty and power to determine what is and what is not the practice of law. . . .
>
> • • • • • • • • • •
>
> "Todd's activities in the field of Employment Security may be considered very briefly. He regularly attended and participated in various hearings of record before Appeals Referees and advised employees as to what their rights are under the Unemployment Compensation law. . . . There can be no substantial doubt that this was the practice of law. Todd's reliance upon [the statute and rule thereunder authorizing claimants to be represented by counsel or other duly authorized agent] is wholly unavailing. In so far as that subsection of the statutes purports to permit a layman to appeal before these tribunals as a 'duly

> authorized agent,' and to do there what we deem to be the practice of law, it is wholly void, as is the rule enacted thereunder."

In *People* v. *Goodman* (1937), 366 Ill. 346, 8 N.E. 2d 941—a leading unauthorized practice case—Goodman was not a lawyer. However, he practiced before the Industrial Commission of Illinois, a State administrative agency. The Industrial Commission had adopted a rule permitting a party to appear before it by his "attorney or agent" and had permitted Goodman, as "agent" of a claimant, to appear before the Commission and try cases there. The Supreme Court of Illinois, however, held that neither the State legislature nor an administrative agency could "grant a layman the right to practice law" and adjudged Goodman in contempt of Court for having engaged in the unauthorized practice of law. The Court, among other things, said, page 945:

> "[8] It is urged that the practice by the respondent before the Industrial Commission is before an administrative body, and that the respondent, therefore, is not practicing law because he is not before a court. That precise question is one of first impression in this court. It is elementary that a great portion of the present-day practice of law is conducted outside the courtroom. The respondent urges that because the legislative act relating to the Industrial Commission grants to that body the right to promulgate rules governing the procedure before it, and the commission has adopted a rule permitting a party to appear before it by his attorney or 'agent,' he, as agent of the claimant, may lawfully appear before the commission as the representative of the client and try his claim there. Even though the Industrial Commission is merely an administrative body, yet, if what the respondent did for a fee, in the presentation

> of and hearing of a petitioner's claim before that body, amounted to the practice of law, a rule of the commission purporting to grant him that privilege is of no avail to him. *The General Assembly has no authority to grant a layman the right to practice law.* In re Day, supra. It follows that *any rule adopted by the Commission, purporting to bestow such privileges upon one not a duly licensed attorney at law, is void.* Nor can the General Assembly lawfully declare not to be the practice of law, those activities the performance of which the judicial department may determine is the practice of law." (Emphasis added.)

In another Illinois case, *Chicago Bar Association* v. *United Taxpayers of America* (1941), 312 Ill.App. 243, 38 N.E. 2d 349, the Court held a rule of the Department of Finance permitting non-lawyers to appear before it on behalf of taxpayers was void insofar as it purported to authorize non-lawyers to engage in the practice of law.

In another leading case, *Clark* v. *Austin* (1937), 340 Mo. 467, 101 S.W. 2d 977, the Respondents were engaged in practice before the Public Service Commission of Missouri, where they appeared and tried motor vehicle cases. The Court held that "whether or not one is engaged in the practice of law depends upon the character of acts he performs and not the place where he performs them." 101 S.W. 2d 983; that this applied to the practice of law outside the Courtroom as well as in it (page 984); and the fact that laymen had practiced before the Public Service Commission from the date of its creation was immaterial. The Court adjudged each of the Respondents in contempt of Court for having engaged in the unauthorized practice of law.

In *State ex rel. Johnson* v. *Childe* (1941), 139 Neb. 91, 295 N.W. 381, the defendant also represented motor carriers before the Railway Commission, a constitutional tribunal. The Court held that neither the State statutes nor the rules of the Railway Commission issued under their grant could authorize the practice of law by a layman before an administrative agency. The Court, among other things, said, page 383:

> "These sections of the statute convey broad powers upon the railway commission with reference to its procedure, but *they do not authorize one not admitted to the bar to engage in the practice of law. The determination of the persons to be licensed to practice law is a judicial function over which the courts have exclusive control.* The issue therefore resolves itself into the question whether the acts performed by respondent amounted to the practice of law." (Emphasis added.)

In *Appeal of Bailey* (1956) (Ohio App. 1956), 137 N.E. 2d 528, the Ohio Court enjoined appellant, who was not a lawyer, from representing persons and firms before the Bureau of Unemployment Compensation and Board of Review, such practice constituting the unauthorized practice of law.

In *State ex rel. Daniel* v. *Wells* (1939), 191 So.Car. 468, 5 S.E. 2d 181, the Court also enjoined a layman from practicing before the State Industrial Commission. It held that the State Industrial Commission's rule making power did not authorize laymen to practice law.

## POINT FOUR

### WHAT ACTS CONSTITUTE THE PRACTICE OF LAW IN FLORIDA IS A MATTER OF STATE LAW DECIDED BY THE FLORIDA SUPREME COURT, NOT SUBJECT TO REVIEW BY THIS COURT

It appears to be elementary that this Court will recognize the decisions of the highest court of a State on matters of State law. *Greenough* v. *Tax Assessors* (1947), 331 U.S. 486, 91 L.Ed. 1621, 67 S.Ct. 1400. What acts in this case constitute the practice of law in Florida is a question of State law. Accordingly, the decision of the Florida Supreme Court as to the acts which constitute the practice of law in Florida should be accepted by this Court. Indeed, this is not contested by Petitioner, and the United States has acquiesced therein (brief p. 9).

However, in the event that the Court is interested in further analyzing the legal character of the acts enjoined by the Florida Supreme Court, particularly the preparation of patent applications, such an analysis is set forth in Appendix B hereof.

## POINT FIVE

### CONGRESS HAS NOT ATTEMPTED TO AUTHORIZE THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE LAW RELATING TO PATENTS, BUT ONLY TO PREVENT INCOMPETENT AND DISREPUTABLE PERSONS FROM REPRESENTING INVENTORS BEFORE THE PATENT OFFICE.

#### A. The Statute On Its Face Is Essentially of a Housekeeping Character and Does Not Purport to Authorize Anyone to Practice Patent Law:

In 1928, when Petitioner was registered by the Patent Office as a "patent attorney," practice before the Patent Office was governed by section 487 of the Revised Statutes as amended by section 3 of the Act of February 18, 1922, 42 Stat. 390, 35 U.S.C. § 11 (1946). Section 487, and its current codification as 35 U.S.C. §§ 31 and 32, provides authority for the Commissioner of Patents only to prescribe rules (subject to approval by the agency head) appropriate to "the recognition of agents, attorneys, or other persons" to represent inventors and others "in the presentation or prosecution of their applications or other business before the office," and to "suspend or exclude" "incompetent or disreputable" persons from further practice before his office. We think it clear from this language that there was no intention on the part of Congress to authorize anyone to practice patent law in Florida or anywhere else.

This is confirmed by the cases. The language of section 487 is essentially of a housekeeping character. See *Goldsmith* v. *United States Board of Tax Appeals* (1926), 270 U.S. 117, 70 L.Ed. 494, 46 S.Ct. 215; *Phillips* v. *Ballinger*, 37 App. D.C. 46, 49 (1911), *appeal dismissed sub. nom. Phillips* v. *Fisher* (1913), 229 U.S. 630, 57 L.Ed. 1358; 16 *Ops. Att'y Gen.* 488 (1880).

In *Goldsmith* v. *United States Board of Tax Appeals* (1926), 270 U.S. 117, 70 L.Ed. 494, 46 S.Ct. Rep. 215,

this Court held that the statutory authority of the Board of Tax Appeals to conduct its proceedings "in accordance with such rules of evidence and procedure as the Board may prescribe" included the power to adopt rules for the admission of attorneys and accountants to practice before the Board. In that case the Board had excluded the petitioner, an accountant, from admission to practice on *ex parte* considerations. In a mandamus proceeding to compel his admission the petitioner argued that the Board had no power to limit the taxpayer's choice of representative. In rejecting this argument, this Court likened the Board's statutory power to prescribe rules of procedure to express statutory provisions authorizing the Secretary of the Treasury and the Secretary of the Interior to prescribe rules "governing the recognition of agents, attorneys, or other persons representing claimants before his department" under the Acts of July 7, 1884, 23 Stat. 258, 5 U.S.C. § 261, and July 4, 1884, 23 Stat. 101, 5 U.S.C. § 493 (270 U.S. 117, 121, 122):

> "We think that the character of the work to be done by the board, the quasi judicial nature of its duties, the magnitude of the interests to be affected by its decisions, all require that *those who represent the taxpayers in the hearings* should be persons whose qualities as lawyers or accountants will secure proper service to their clients and to help the board in the discharge of its important duties. *In most of the executive departments in which interest of individuals as claimants or taxpayers are to be passed on by executive officers or boards, authority is exercised to limit those who act for them as attorneys to persons of proper character and qualification to do so. Not infrequently, statutory provision is made for requiring a list of enrolled attorneys to which a practitioner must be admitted by the executive officer or tri-*

> *bunal.* Act July 7, 1884, 23 Stat. at L. 236, 258 . . . [5 U.S.C. § 261]; Act of July 4, 1884, 23 Stat. at L. 98, 101 . . . [5 U.S.C. § 493]; Act of June 10, 1921, 42 Stat. at L. 25 . . . [31 U.S.C. § 52(f)]. In view of these express provisions, it is urged that the absence of such authority in case of the board of tax appeals should indicate that it was not intended by Congress to give it the power. *Our view, on the contrary, is that so necessary is the power and so usual is it that the general words by which the board is vested with the authority to prescribe the procedure* in accordance with which its business shall be conducted *include as* part of the procedure *rules of practice for the admission of attorneys. It would be a very curious situation if such power did not exist in the board of tax appeals when in the Treasury Department and the office of the Commissioner of Internal Revenue there is a list of attorneys enrolled for practice in the very cases which are to be appealed to the board.*" (Emphasis added.)

In no way did this Court intimate that the statutory authority of the Board or of the Secretaries of the Treasury and Interior Departments under the 1884 Acts—the language of which is substantially identical to the statutory authority of the Patent Office under § 487 of the Revised Statutes—extended beyond the housekeeping power to exclude, by fair procedures, unsuitable persons from "representing" persons "in the hearings" before the Board. There is no suggestion that the admission of accountants to practice before the Board of Tax Appeals constitutes authorization to practice law relating to federal taxation throughout the several States without regard to State regulation of the practice of law.

In *Phillips, supra,* an attorney at law sought to enjoin the Secretary of the Interior from disbarring him

from practice before the Interior Department on the ground that the statute authorizing the disbarment (section 5 of the Act of July 4, 1884, 23 Stat. 101, 5 U.S.C. § 493) was void on due process grounds due to the vagueness of the term "disreputable" and due to the failure of the statute to provide for the swearing of witnesses in disbarment proceedings thereunder. This section of the 1884 Act contained essentially the same language as was added to section 487 of the Revised Statutes by the Act of February 18, 1922, *supra*. In affirming dismissal of the bill and upholding the statute, the Court of Appeals stated that "it is unnecessary to consider whether [the 1884 Act] constitutes anything more than a legislative sanction of the practice heretofore existing" since "prior to the passage of the Act," by virtue of section 161 of the Revised Statutes, 5 U.S.C. section 22, "the Secretary certainly had the power to prescribe rules governing the conduct of agents and attorneys in his department," and this "would seem to include the power to exclude such agents and attorneys as the Secretary, after notice and hearing, should find no longer entitled to enjoy the privileges theretofore granted." *Id.* at 49.

In 16 *Ops. Att'y Gen.* 148 (1880), the Attorney General pointed out the authority of agency heads to regulate practice before their departments, in the absence of express statutory authorization:

> "Referring to your informal note of the 21st of April, I would answer that the *Secretary of the Interior has authority to disbar for misconduct attorneys practicing before his department. This authority is not given by statute*, but seems to have been one exercised heretofore by heads of Departments in the protection of the Government. Its

limits were defined by Attorney-General Hoar [in 13 Ops. Att'y Gen. 150] as follows:

> 'It is competent to the head of a Department, as a measure for the protection of the public interests committed to his charge, *to decline to recognize or to suspend the transaction of business with an agent or attorney for frauds and fraudulent practices* attempted or committed by him in the prosecution of claims before the Department, and whose character is such that a reasonable degree of confidence cannot be placed in his integrity and honesty in dealing with the Government.
>
> 'The authority to pursue this course under those circumstances rests upon the very necessity that exists for its adoption as a safeguard against fraud in administering the laws relating to the settlement and payment of claims upon the United States.
>
> 'Besides, it is a just and necessary limitation upon the right of a party to be represented by an agent, and to select the agent by whom he will be represented, that he shall not employ a person offensive or dangerous to the other party with whom he is to deal.' " (Emphasis added.)

In the light of these statements of implied authority to regulate practice before Government departments, it is clear that the words of section 487 of the Revised Statutes largely restate the implied power previously exercised in the absence of statute; and that they do not go beyond sanction of the exercise of this housekeeping power at the level of the Commissioner of Patents. Like section 161, section 487 does not attempt to say that "recognition" is a federal authorization to practice law relating to patents in Florida or elsewhere.

Section 487 merely authorizes the Commissioner to exercise the power of recognition by requiring "such persons, agents, or attorneys, before being recognized as representatives of applicants," to show "that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants" in "the presentation and prosecution of their applications . . . before the office." It does not manifest any Congressional purpose to authorize Petitioner to practice law relating to patents in Florida or elsewhere. Rather, its purpose was to protect inventors against representation by incompetent or disreputable persons.

**B. Practice "Before" the Patent Office Means "in the Presence of" the Patent Office**

While Petitioner would have this Court interpret admission to practice "*before the Patent Office*" to constitute the grant of a federal license to practice law relating to patents in Florida, the language of the statute rejects Petitioner's claim. For the statutory phrase "presentation or prosecution" of applications for patents "*before*" the Patent Office limits the sphere and scope of "recognition" to activities conducted *in the presence of the Patent Office*. When not used in a temporal sense, the word "before" ordinarily means "in the presence of." Thus "an affidavit made before a magistrate" in 18 U.S.C. § 3182 means made "in the presence of" the magistrate, *State* v. *Murnane* (1927), 172 Minn. 401, 215 N.W. 803; *Ex parte Davis* (1933), 333 Mo. 262, 62 S.W. 2d 1086, 89 A.L.R. 589; *In re Murphy* (1947), 321 Mass. 206, 72 N.E. 2d 413. Acknowledgment of a deed by an officer over the tele-

phone is not an acknowledgment "before" that officer required by statute, *Hutchinson* v. *Stone* (1920), 79 Fla. 157, 84 So. 151, 155. "In the presence of the enemy" is synonymous with "before the enemy" in a court martial specification, *Bigrow* v. *Hiatt*, 70 F. Supp. 826, 829 (D. Pa. 1947). Also, the conclusion that "before the Patent Office" only means "in the presence of the Patent Office" is strengthened by the words "presentation or prosecution" which import activities of such a character that they could take place only "in the presence of" the Patent Office.

### C. In 1938 the Rules of the Patent Office Expressly Disclaimed Any Intention of "Authorizing Persons Not Members of the Bar to Practice Law"

Not only have the rules of practice before the Patent Office never purported to express or imply any attempt to authorize a person to practice law relating to patents in Florida or elsewhere. In addition, since 1938 they have expressly provided or recognized that admission to practice before the Patent Office is not to be construed as authorizing persons not members of the bar to practice law.[11]

Thus, in 1938, the Patent Office by amendment to Rule 17 of the Rules of Practice (495 O.G. 715) for the first time established a "register of attorneys" for attorneys at law, and a wholly separate "register of

[11] Prior to 1938, the rules show only an evolving power of exclusion of disreputable or incompetent agents from practice before the Patent Office that really began in 1898 when all persons recognized as eligible to represent inventors before the Patent Office were enrolled on a register of "patent attorneys" without regard to whether they were attorneys at law. The new significant details of this evolution are traced in Appendix C *post*.

agents" for persons not attorneys at law, "on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent." The purpose and significance of this separate recognition of patent lawyers and agents was made meaningful by express provisions of the rule accompanying the establishment of separate registers. Rule 17 was amended to provide that, with respect to both attorneys and agents:

> ". . . Registration under the provisions of this rule **shall not be construed as authorizing persons not members of the bar to practice law.**"

This amendment to Rule 17 is a persuasive administrative interpretation of § 487 that admission to practice before the Patent Office could not be construed to authorize the practice of law relating to patents in Florida or elsewhere.

Moreover, in 1949, incident to a comprehensive revision of the Rules of Practice, the portion of Rule 17 recognizing that registration "shall not be construed as authorizing persons not members of the bar to practice law" was incorporated in Rule 341 and restated as

> "Registration in the Patent Office under the provisions of these rules shall **only** entitle the persons registered to practice before the Patent Office." (29 C.F.R. § 1.341 (1949). (Emphasis added.)

This restatement of Rule 17 continues the substance of the provision that admission to practice before the Patent Office is not to be understood as authorizing the practice of law by persons "not members of the bar." The word "only" in the phrase that registration, whether of attorneys at law or agents, "shall *only* en-

title the persons registered to practice before the Patent Office," is not susceptible of any different meaning. Thus Rule 341 merely repeats in the affirmative what Rule 17 provided in the negative. Moreover, this philosophy as to the Commissioner's statutory authority was extended in 1955 when, acting under the successor statute to § 487 (35 U.S.C. §§ 31, 32), the Commissioner of Patents revised the rules of practice before the Patent Office in trademark cases to provide among other things that "Recognition of any person under this section is not to be construed as sanctioning the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law" (37 C.F.R. § 2.12(d) (1955)).

Accordingly, we think it clear that the very Rules of Practice of the Patent Office itself have taken special pains to specifically provide that they are not to be construed as authorizing anyone to practice law.

**D. The Legislative History of § 487 Confirms the Housekeeping Character of the Statute**

The legislative history confirms that Congress, in amending section 487 in 1922, had no thought of authorizing the Commissioner to authorize Petitioner to practice law relating to patents before the Patent Office or elsewhere. Responding to requests of the Patent Office, Congress was endeavoring solely to enlarge the housekeeping authority of the Commissioner to deny or refuse recognition to patent agents on grounds in addition to the "gross misconduct" ground previously authorized by section 487. It sought to provide the additional grounds of engaging in false or misleading advertising, and to give the Commissioner final administrative authority in the exercise of this power to

exclude without obtaining the prior approval of the Secretary of the Interior. See Appendix C *post*.

**E. Admission to Practice Before the Patent Office Does Not Entitle Petitioner to Practice Patent Law in the Federal Courts**

It is clear from the Rules of the Federal Courts that admission to practice before the Patent Office in patent and trademark cases does not entitle a person to practice law relating to patents in the Federal courts. For example, Rule II of the Rules of Practice of the United States Court of Customs and Patent Appeals expressly limits eligibility to admission to practice before that Court to "Any attorney who is entitled to practice in the Supreme Court of the United States or in the court of appeals of the United States or in the court of last resort in any State or Territory or the District of Columbia or in the United States Court of Claims" without regard, for the purposes of the jurisdiction of that Court in patent and trademark cases, to whether the attorney has also been admitted to practice before the Patent Office. Indeed, Petitioner can scarcely claim that, by virtue of "recognition" before the Patent Office, he can practice before the Court of Customs and Patent Appeals. The same is true of the United States District Courts.

It is clear, therefore, that laymen admitted to practice before the Patent Office may not practice law relating to patents in any courtroom. And there is no greater reason to believe that they should be permitted to practice law relating to patents outside the courtroom.

## POINT SIX

### IF THE STATUTE COULD BE CONSTRUED TO MEAN THAT CONGRESS HAS AUTHORIZED THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE LAW RELATING TO PATENTS IN FLORIDA, IT WOULD BE INVALID AS AN UNCONSTITUTIONAL DELEGATION OF LEGISLATIVE POWER

First, Congress has no power to authorize people to practice law. Any attempt by Congress to authorize people to practice law would at least be an invasion of the judicial power vested in this Court. See Point Three, *supra*, p. 58.

Second, however, if we should assume, for purposes of argument, that Congress has the power to authorize people to practice law in the federal field, nevertheless, as set forth in Point Five, *supra*, p. 74, Congress has never intended to authorize the Commissioner of Patents to authorize the Petitioner to practice law relating to patents in Florida. The statute in question is a mere housekeeping statute designed to exclude undesirable persons from "recognition" by the Patent Office. Dealing solely as it does with "recognition" by the Patent Office, it does not purport to confer any right whatever to practice patent law in Florida.

Third, even if we should consider, for the purpose of argument, that this statute could be interpreted to mean that Congress has attempted to authorize the Commissioner of Patents to authorize Petitioner to practice patent law in Florida, the statute would be invalid for the additional reason that it would be an unconstitutional delegation of legislative power.

Here it is significant that in 1938 the Rules of Practice of the Patent Office were amended to provide, with respect to both "attorneys" and agents that

> "Registration under the provisions of this rule *shall not be construed as authorizing persons not members of the bar to practice law.*" (Emphasis added)

Later, the Rules were amended to provide in substance the same thing, that

> "Registration in the Patent Office shall *only* entitle the persons registered to practice before the Patent Office." (Emphasis added.)

The foregoing provisions are in complete harmony with the decision below enjoining Petitioner from certain acts in Florida which constituted the practice of law.

Now, however, Petitioner contends that the Rules of Practice give him a federal license to do the precise thing that they clearly prohibited him from doing beginning in 1938, even if they could be differently construed now. Stated otherwise, in 1938 the Rules of Practice specifically provided that "Registration . . . shall not be construed as authorizing persons not members of the bar to practice law." Now Petitioner claims that the Rules specifically authorize him to engage in the practice of law relating to patents in Florida. And no particular reason appears as to why he should be prohibited in one year and permitted in another year, with respect to the very same act.

But if we assume the construction of the statute contended by Petitioner, the first significant feature of this from the standpoint of delegation of legislative power is that the *practice of law* as the *subject* of any such delegation by Congress is not even mentioned, let alone "defined" in the statute. Second, there is a com-

plete absence of standards [12] laid down by Congress as to when, how or whether the Commissioner of Patents may prohibit, and when he may authorize laymen to practice law relating to patents in the states or elsewhere. Accordingly, if today the Commissioner feels that it is a good idea to prohibit laymen from engaging in the practice of law relating to patents, he can promulgate a rule saying so. If tomorrow, he decides that such is not a good idea, he can promulgate a contrary ruling saying that the layman may practice law relating to patents in every State. In short, the very thrust of the Petitioner's claim is that the Commissioner of Patents may permit or prohibit laymen from practicing law or license them to practice patent law, as he pleases, in the complete absence of any standards laid down by Congress defining when, whether or how laymen should be permitted to practice patent law. This would be conferring an unfettered discretion upon a Government official—something not permitted in our system of government.

Both these points are settled by the cases. First, it is clear that, in order to validly delegate legislative power, the *"subject to which this authority relates"* must be *"defined."* Thus in *Panama Refining Co.* v. *Ryan* (1935), 293 U.S. 388, 79 L.Ed. 446, 55 S.Ct. 241, the Court, among other things, said:

> "Fourth. Section 9(c) is assailed upon the ground that it is an unconstitutional delegation of legislative power. The section purports to

[12] Such standards as appear in the statute relate solely to criteria under which the Commissioner may *exclude* unsuitable persons from representing applicants before the Patent Office, as distinguished from standards relating to the exercise of a power to authorize persons to practice law relating to patents in Florida.

> authorize the President to pass a prohibitory law. *The subject to which this authority relates is defined.* It is the transportation in interstate and foreign commerce of petroleum and petroleum products which are produced or withdrawn from storage in excess of the amount permitted by state authority. Assuming for the present purpose, without deciding, that the Congress has power to interdict the transportation of that excess in interstate and foreign commerce, the question whether that transportation shall be prohibited by law is obviously one of legislative policy. Accordingly, we look to the statute to see whether the Congress has declared a policy with respect to that subject; whether the Congress has set up a standard for the President's action; whether the Congress has required any finding by the President in the exercise of the authority to enact the prohibition. (293 US 414, 415) (Emphasis added.)

In the instant statute, however, there is no mention whatever of the "subject" of authorizing anyone to practice law relating to patents in Florida or elsewhere.

Second, it is also clear that the question as to whether and how the subject is to be regulated—assuming that one has been defined—"is obviously one of legislative policy." See the quotation from the *Panama* case immediately above. The statute must be scrutinized to see, first, whether Congress has declared a policy with respect to the subject defined, and second, whether the Congress has set up *standards* for the action of the delegate, *Panama Refining Co.* v. *Ryan* (1935), 293 U.S. 388, 79 L.Ed. 446, 55 S.Ct. 241, *supra, A.L.A. Schechter Poultry Corp.* v. *United States* (1935), 295 U.S. 495, 79 L.Ed. 1570, 55 S.Ct. 837, 97 A.L.R. 947.

The question presented, and the holding of the *Schechter* case that section 3 of the National Industrial

Recovery Act was an unconstitutional delegation of legislative power are set forth below:

> "Second. The question of the delegation of legislative power. We recently had occasion to review the pertinent decisions and the general principles which govern the determination of this question. *Panama Ref. Co.* v. *Ryan,* 293 U.S. 388, ante, 446, 55 S.Ct. 241. The Constitution provides that 'all legislative powers herein granted shall be vested in a Congress of the United States, which shall consist of a Senate and the House of Representatives.' Art. 1, § 1. And the Congress is authorized 'to make all laws which shall be necessary and proper for carrying into execution' its general power. Art. 1, § 8, Par. 18. *The Congress is not permitted to abdicate or to transfer to others the essential legislative functions with which it is thus vested.*" (295 US 529).
>
> • • • • • • • • •
>
> "To summarize and conclude upon this point: § 3 of the Recovery Act is without precedent. It supplies no standards for any trade, industry or activity. It does not undertake to prescribe rules of conduct to be applied to particular states of fact determined by appropriate administrative procedure. Instead of prescribing rules of conduct, it authorizes the making of codes to prescribe them. For that legislative undertaking, § 3 sets up no standards, aside from the statement of the general aims of rehabilitation, correction and expansion described in § 1. In view of the scope of that broad declaration, and of the nature of the few restrictions that are imposed, *the discretion of the President* in approving or prescribing codes, and thus enacting laws for the government of trade and industry throughout the country, *is virtually unfettered.* We think that the code-making authority thus conferred is an unconstitutional delega-

tion of legislative power." (295 US 541, 542.) (Emphasis added.)

Again, in the instant case, if we could assume that the statute could be construed to mean that Congress intended to authorize the Commissioner to authorize the Petitioner to practice law relating to patents in Florida, there is a complete absence of standards as to how, whether or when the Commissioner should authorize the Petitioner to practice law. There would be a conferring of an unfettered discretion on the Commissioner, and it would be an unconstitutional delegation of legislative power. As Justice Cardoza put it, concurring in the *Schechter* case, *"This is delegation running riot."* 295 U.S. 553.

## POINT SEVEN

### IF THE STATUTE COULD BE CONSTRUED TO AUTHORIZE THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE PATENT LAW IN FLORIDA, IT WOULD ALSO EXCEED THE POWERS CONFERRED ON THE FEDERAL GOVERNMENT IN THE CONSTITUTION AND INVADE THE POWERS RESERVED FOR THE STATES BY THE TENTH AMENDMENT

### A. Introduction

First, we have shown above in Point Three, p. 58, that where the judicial power of government is vested in the Courts, as it is in the Constitution of the United States, only the Courts have the power to admit to the Bar and to disbar, and to define what constitutes the practice of law and exclude unauthorized persons therefrom. The legislative branch—Congress—has no power to authorize persons to practice law, in the federal field or elsewhere.

Second, however, for purposes of argument only, and contrary to Point Three, we are assuming in this point that Congress could authorize people to practice law. And third, we also assume for purposes of argument only and contrary to Point Five, *supra*, p. 74, that the statute in question could be construed to mean that Congress attempted to authorize the Commissioner to authorize the Petitioner to practice law in Florida. Fourth we further assume, contrary to Point Six, again for purposes of argument only, that the statute, so construed, could be held to be a constitutional delegation of legislative power despite the fact that the practice of law is not even mentioned as the "subject" of any attempted delegation, and there is a complete absence of standards as to whether, when or how, the Commissioner should authorize people to practice law.

Only on the basis of these assumptions do we arrive at this point.

**B. Except for the Protection of an Inventor's Exclusive Right to an Invention, the Patent Clause of the Constitution and the Patent Laws Passed by Congress are Subject to the Police Power of the States**

Petitioner (brief p. 27) quotes from *McClurg* v. *Kingsland* (1843), 1 How. 202, 206, 11 L.Ed. 102, 103, to the effect that "the powers of Congress to legislate upon the subject of patents is plenary." He omits, however, to give the context in which the statement was made. The full paragraph involved is as follows:

> "The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not *must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made;* for though they may be retrospective in their operation, that is not a sound objection to their validity; *the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution*, and as there are no restraints on its exercise, *there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.*" (1 How. 206)

So we see that *McClurg* v. *Kingsland* did not involve State-Federal relations in the field of patents, as is implied by Petitioner in his brief, p. 27. Rather, it was a suit brought by the assignees, McClurg, *et al.*, of an inventor, Harley, against Harley's former employer, Kingsland, for infringement of a patent. The trial Court had submitted the case to the jury on a charge that the facts presumed a license to Kingsland to use the patent. Harley had developed the invention while employed by Kingsland, had given his employer free use of it before an application for a patent was made,

and had been given an increase in wages for making the invention. The case itself turned upon the consolidated effect of successive acts of Congress relating to the particular patent. And it appears to be plain that, when this Court said "the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution . . . there can be no limitation on their right to modify them, [i.e., patents] so long as they do not take away the rights of property in existing patents," this Court was discussing only the right of Congress to legislate, and amend its legislation, with respect to a particular patent, and as between employer and employee. It was not discussing relations between the State and Federal Governments.

But there are significant cases in the field of Federal-State accommodation relating to patents. Probably the leading case is *Patterson v. Kentucky* (1879), 97 U.S. 501, 24 L.Ed. 1115. And that case anaiyzed the substance, scope and limits of the power conferred by the States on the Federal Government in Article I, Section 8, Clause 8, which only provides that:

> "The Congress shall have Power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

It is to be noted that this clause of the Constitution does not mention the word "patents," and that, grammatically, the only "power" conferred is to promote science, etc., "*by securing* for limited times to authors and inventors *the exclusive right* to their respective writings and discoveries." (Emphasis added.) Thus the vitals of the power conferred, in our context, is to "secure . . . *the exclusive right to . . . discoveries.*" "Se-

cure" in this clause means to "protect." *Wheaton and Donaldson* v. *Peters and Grigg* (1834), 8 Pet. 591, 8 L.Ed. 1055, 1080; *Patterson* v. *Kentucky, supra,* 97 U.S. 501, 506; *Webber* v. *Virginia, post,* p. 97, 103 U.S. 344, 349. Nothing more was granted by the States, in this connection, to the Federal Government. In contrast to the commerce power, for instance, no broad power such as the power to "regulate discoveries and patents therefor, and the use thereof," was granted.

This very limited character of this grant of power was discussed in the landmark case of *Patterson* v. *Kentucky, supra.* In that case the Court of Appeals of Kentucky had affirmed a judgment imposing a fine of $250 for violation of a Kentucky statute prohibiting, with criminal penalties, the sale of certain oils which burned at temperatures considered unsafe for illuminating purposes. The plaintiff in error had manufactured the oil in question, known as "Aurora" oil in accordance with letters patent issued to her assignor. Accordingly, she claimed that "she had the right to sell the Aurora oil in any part of the United States, and that no State could, consistently with the Federal Constitution and the laws of Congress prevent or obstruct the exercise of that right . . ." by passing laws "to which the patented article could not be made to conform."

In affirming the judgment below, this Court had some very significant things to say on the limited character of Clause 8:

> "Congress is given power to promote the progress of science and the useful arts. To that end it may, by all necessary and proper laws, secure to inventors, for limited times, the exclusive right to their discoveries. That power has been exerted in the various statutes prescribing the terms and conditions upon which inventors may obtain letters patent. It is true that *letters patent, pursuing the*

*words of the statute, do, in terms grant to the inventor, his heirs and assigns, the exclusive right to make, use and vend to others his invention or discovery,* throughout the United States and the Territories thereof. *But, obviously, this right is not granted to or secured, without reference to the general powers which the several States of the Union unquestionably possess* in reference to their purely domestic affairs, whether of internal commerce or of police." (Emphasis added.) (97 US 503.)

• • • • • • • • • •

"The Kentucky statute being, then, an ordinary police regulation for the government of all engaged in the internal commerce of that State, the only remaining question is, whether under the operation of the Federal Constitution and the laws of Congress, it is without effect in all cases where the oil, although condemned by the State as unsafe for illuminating purposes, has been made and prepared for sale in accordance with a discovery for which letters patent have been granted. We are of opinion that *the right conferred upon the patentee and his assigns to use and vend the corporeal thing or article, brought into existence by the application of the patented discovery, must be exercised in subordination to the police regulations which the State has established by the Statute of 1874.*" (Emphasis added.) (97 US 505.)

• • • • • • • • • •

"These considerations, gathered from the former decisions of this court, would seem to justify the conclusion that *the right which the patentee or his assignee possesses in the property, created by the application of a patented discovery, must be enjoyed subject to the complete and salutary power with which the States have never parted,* of so defining and regulating the sale and use of property within their respective limits as to afford protec-

tion to the many against the injurious conduct of the few." (Emphasis added.) (97 US 506.)

* * * * * * * * *

"*The right which the patent primarily secures is the exclusive right in the discovery,* which is an incorporeal right, or, in the language of Lord Mansfield, in Millar v. Taylor, 4 Burr., 2303, 'a property in notion,' which 'has no corporeal tangible substance.' *The enjoyment of that incorporeal right may be secured and protected by national authority against all hostile state legislation;* but the tangible property which comes into existence by the application of the discovery is not beyond the control as to its use of state legislation, simply because the inventor acquires a monopoly in the discovery.

"An instructive case upon the precise point under consideration is *Jordan* v. *Overseers of Dayton,* 4 Ohio, 295. Jordan was sued in debt, to recover certain penalties for practicing medicine in violation of an Ohio Statute regulating the practice of physic and surgery. His defense rested, in part, upon the ground that the medicine administered by him was that for which letters patent had issued to his assignor, granting to the latter the exclusive right of making, constructing, using and vending to others to be used, the medicine in question, which was described in the letters patent as a new and useful improvement, and as being a mode of preparing, mixing, compounding, administering and using that medicine. The contention of Jordan was, that the State Government could not restrict or control the beneficial or lucrative use of the invention; and that, as assignee of the patentee, he was entitled to administer the patented medicine *without obtaining a license to practice physic or surgery as required by the state Statute.* The Supreme Court of Ohio said: 'This leads us to consider the nature and extent of such

rights as accrue from letters patent for useful discoveries." (Emphasis added.) (97 US 506, 507.)

* * * * * * * * *

"'*If the State should pass a law for the purpose of destroying a right created by the Constitution, this court will do its duty; but an attempt by the Legislature, in good faith, to regulate the conduct of a portion of its citizens*, in a matter strictly pertaining to its internal economy, we cannot but regard as a legitimate exercise of power, *although such law may sometimes indirectly affect the enjoyment of rights flowing from the Federal Government.*'"

* * * * * * * * *

"'In the case of *Livingston* v. *Van Ingen*, 9 Johns., 507, Chancellor Kent said that 'The national power will be fully satisfied if the property created by patent be, for the given time, enjoyed and used exclusively, so far as, under the laws of the several States, the property shall be deemed [fit] for toleration [and use]. There is no need of giving this power any broader construction in order to attain the end for which it was granted, which was to reward the beneficient efforts of genius, and to encourage the useful arts.'"

* * * * * * * * *

"Without further elaboration, we deem it only necessary to say that the *Kentucky Statute does not, in our judgment, contravene the provisions of the Federal Constitution, or of any statute passed in pursuance thereof. Its execution creates no necessary conflict with national authority, and interferes with no right secured by federal legislation*, to the patentee or his assigns." (Emphasis added.) (97 US 509.)

The Ohio case of *Jordan* v. *Overseers of Dayton*, relied upon by this Court in *Patterson* v. *Kentucky*, is specially pertinent to our case. For that was an un-

authorized practice case. There Jordan was sued for certain penalties for having violated the prohibition against the unauthorized practice of medicine. His defense was that he was administering certain patent medicine and was entitled to do so "*without obtaining a license to practice physic and surgery as required by the state statute.*"

Indeed, in the Ohio Supreme Court Jordan had insisted that

> "the power of the legislature is limited in this case because the patent, securing to Thompson [the plaintiff's assignor] the exclusive right of preparing and mixing medicines, emanated from the general government, under the authority of the constitution; and that its full effect cannot be had, unless it be holden altogether exempt from the state control."

But the Ohio Supreme Court overruled this defense on the ground that the patent power conferred by the Constitution could only be "indirectly affected" (97 U.S. 508) by the right of the State, in the exercise of its police power, *to regulate the practice of medicine in Ohio*—quoted with approval by this Court. Just as in that case the patent clause of the Constitution and the laws passed by Congress pursuant thereto were held to be subject to the police power of the State to regulate the practice of medicine, so in our case they are subject to the police power of the State to regulate the practice of law in Florida.

Similarly, in *Webber* v. *Virginia* (1881), 103 U.S. 344, 26 L.Ed. 565, Webber had been convicted for unlawfully selling and offering for sale certain Singer Sewing Machines without having first obtained a license for that purpose. Thus, the question was whether the

State could require a *license* for the sale of articles which had been patented. One of Webber's defenses was that the Singer Manufacturing Company held a patent of United States, "authorizing it to manufacture and sell them anywhere in the United States" (page 347). In holding that there was no error in overruling this defense, this Court significantly pointed out that "The combination of different materials . . . which constitutes the invention or discovery, cannot be forbidden by the State," but indicated also that the Constitution does not confer any general right on the Federal Government to regulate anything and everything that happens to be connected with patents. Instead, the Constitution only conferred very limited power, that is, only power with respect to "the right to the invention or discovery, the incorporeal right" and that that was the only right with which the State could not interfere. Thus, the Court expressly stated that "*Congress never intended that the patent laws should displace the police powers of the states,*" and that, except with respect to the right to the invention or discovery, whatever rights are secured to inventors under the patent laws of the United States must be enjoyed "*in subordination to*" the police power of the States. Thus this Court, among other things, said:

> "The patent for a dynamite powder does not prevent the State from prescribing the conditions of its manufacture, storage and sale, so as to protect the community from the danger of explosion. A patent for the manufacture and sale of a deadly poison does not lessen the right of the State to control its handling and use. The legislation respecting the articles which the State may adopt after the patents have expired, it may equally adopt during their continuance. **It is only the right to the invention or discovery, the incorporeal right.**

**which the State cannot interfere with. Congress never intended that the patent laws should displace the police powers of the States,** meaning by that term those powers by which the health, good order, peace and general welfare of the community are promoted. *Whatever rights are secured to inventors* must be enjoyed *in subordination* to this general authority of the State over all property within its limits." (Emphasis added.) (103 U.S. 348.)

* * * * * * * * *

"In accordance with the views thus expressed, we can find no objection to the legislation of Virginia *in requiring a license for the sale of the sewing-machines*, by reason of the grant of letters of patent for the invention." (Emphasis added.) (103 U.S. 349.)

Also, in the very important case of *Allen* v. *Riley* (1906), 203 U.S. 347, 51 L.Ed. 216, 27 S.Ct. 95, this Court upheld a Kansas statute which required one selling a patent right in any county in that state to file with the Clerk in such county an authentic copy of the letters patent, together with an affidavit of genuineness of the letters patent and as to other matters. It is noteworthy that this statute clearly affected the "exclusive right" to an invention. Moreover, there was a federal statute which dealt specifically with the subject of assignment of patents. But the Kansas statute was held not to violate Article I, Sec. 8, granting to Congress the right to "secure" to inventors the exclusive right to their discoveries.

What had happened was that the plaintiff in the trial court sued to recover the value of certain lands alleged to have been transferred by him to the defendant in part payment for the transfer to the plaintiff of certain rights under a patent for a washing machine. The

right to recover was based upon the failure of defendants to comply with the Kansas statute. In turn, the defendants insisted that the Kansas statute in question violated the patent clause of the Constitution "*and the Federal statute passed in pursuant thereof,*" Revised Statutes, Section 4898. This Federal statute related directly to the subject matter in that it provided that a patent or interest therein shall be assignable in law by an instrument in writing, which assignment is to be void against any subsequent purchaser or mortgagee without notice unless recorded in the Patent Office within three months from the date thereof.

It was asserted by the defendants in the trial court that the subject of the sale or assignment of an interest in a patent "is derived from the laws of Congress passed with reference to the constitutional provision quoted above, and that any regulations whatever, by any state authority, in regard to such assignment or sale, and making provision in respect to them, are illegal."

However, the Supreme Court of Kansas upheld the Kansas statute and affirmed a judgment for plaintiff. And on writ of error to this Court, the judgment was affirmed. After discussing *Patterson* v. *Kentucky, supra,* this Court had the following to say regarding *Webber* v. *Virginia, supra:*

> "*Webber* v. *Virginia, supra,* relates also to tangible property covered by a patent, and it was held that the patent did not exclude from the operation of the taxing or licensing law of the state the tangible property manufactured under a patent. It was said in that case that 'Congress never intended that the patent laws should displace the police powers of the states,' meaning by that term those powers

by which the health, good order, peace, and general welfare of the community are promoted. Whatever rights are secured to the inventors must be enjoyed in subordination to this general authority of the state over all property within its limits."

This Court then proceeded to uphold the statute in the following language:

"We think the state has the power (certainly until Congress legislates upon the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent, *to make reasonable regulations concerning the subject, calculated to protect its citizens* from fraud. And we think Congress has not so legislated by the provisions regarding an assignment contained in the act referred to."

* * * * * * * * *

It is noteworthy that when this Court remarked that "the State has the power (certainly until Congress legislates upon the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent," this Court was dealing with the very subject of Constitutional power—the "exclusive right" to an invention. But to repeat, in our case there is no Congressional legislation bearing any real relation to that subject, and nothing relating thereto with which the decision below could be said to interfere.

Indeed, in this very connection, the Court went on to point out that the State could not "prohibit" the sale of a patent, saying:

"To uphold this kind of a statute is by no means to authorize any state to impose terms which, possibly, in the language of Mr. Justice Davis, in Ex parte Robinson, 2 Biss. 309, Fed. Cas. No. 11,932,

> 'would result in a prohibition of the sale of this species of property within its borders, and in this way nullify the laws of Congress which regulate its transfer, and destroy the power conferred upon Congress by the Constitution.' Such a statute would not be a reasonable exercise of the powers of the state." (Emphasis added.)

To repeat, the last quotation is particularly significant. It points out that the State could not prohibit "the sale of this species of property," and by "property," meaning a patent. In short, the Constitution protects the exclusive right of the inventor to the patent, and the State could not prohibit the sale thereof. But, as the Court held, it may "make *reasonable regulations concerning*" the sale or assignment thereof.

Finally, the Court concluded, significantly, that:

> "The mere provision in the Federal statute for an assignment and its record as against subsequent purchasers, etc., *is not such legislation as takes away the rights of the states to legislate on the subject themselves in a manner neither inconsistent with, nor opposed to, the Federal statute.* We think the judgment is right, and it is affirmed." (Emphasis added.)

In *Long* v. *Rockwood* (1928), 277 U.S. 142, 72 L.Ed. 145, 48 S.Ct. 461, this Court held that a State could not tax royalties for the use of patents issued by the United States. Justices Holmes, Brandeis, Sutherland, and Stone, however, dissented, in a cogent opinion which, among other things, said:

> "Even with regard to patents some laws of a kind that might destroy the use of them within the state have been upheld. *Patterson* v. *Kentucky*, 97 U.S. 501, 24 L.ed. 1115; *Webber* v. *Virginia*, 103

U.S. 344, 26 L.ed. 565; *Emert* v. *Missouri*, 156 U.S. 296, 39 L.ed. 430, 5 Inters. Com. Rep. 68, 15 Sup. Ct. Rep. 367. They must be reasonable or they will be held void, but if this court deems them reasonable they stand. *Allen* v. *Riley*, 203 U.S. 347, 355, 51 L.ed. 216, 218, 27 Sup. Ct. Rep. 95, 8 Ann. Cas. 137."

*Long* v. *Rockwood* has now been overruled by *Fox Film Corp.* v. *Royal* (1932), 286 U.S. 123, 76 L.Ed. 1010, 52 S.Ct. 542, thus giving added significance to the potent language quoted above from the opinion by Mr. Justice Holmes. Also, the limited interest of the United States under the patent and copyright clause is mentioned in the opinion by Chief Justice Hughes in the *Fox Film* case, upholding a State tax on the gross receipts of royalties of licenses for copyrighted motion pictures, as follows:

"*The sole interest of the United States and the primary object* in conferring the monopoly lie in the general benefits derived by the public from the labors of authors. A copyright, like a patent, is 'at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals and the incentive to further efforts for the same important objects.' Kendall v. Winsor, 21 How. 327, 328, 16 L.ed. 167, 168; Grant v. Raymond, 6 Pet. 218, 241, 242, 8 L.ed. 376, 384, 385. (Page 1014) (Emphasis added).

The scope of the patent clause of the Constitution was also held to be limited in *Crown Die & Tool Company* v. *Nye Tool & Machine Works*, 261 U.S. 24, 67 L.Ed. 516, 43 S.Ct. 254. There the Plaintiff sued to enjoin the alleged infringement of a patent. In the course of an opinion by Chief Justice Taft the court had occasion to analyze the scope of the power granted to Congress by Article 1, Clause 8, and among other things said:

"The analysis of the rights which a patentee acquires under the grant is sustained by a line of authorities."

* * * * * * * * * *

"The fullest and most satisfactory discussion of the subject is found in the Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 52 L.ed. 1122, 28 Sup. Ct. Rep. 748."

* * * * * * * * * *

"The court held that the government did not confer on the patentee the right himself to make, use, or vend his own invention, that such right was a right under the common law, not arising under the Federal Patent Laws, *and not within the grant of power to Congress to enact such laws.*" (Emphasis added.)

* * * * * * * * * *

**C. Even with Respect to an Inventor's Exclusive Right to an Invention, the State May Make "Reasonable Regulations" Concerning It**

We think it clear that our case does not involve any interference with "securing," "protecting," "shielding" or "guarding" an inventor's "exclusive right" to an invention. But even if it did, *Allen* v. *Riley,* and Mr. Justice Holmes' opinion in *Long* v. *Rockwood, supra* in B above, make it perfectly clear that "reasonable regulations" of even that subject by the States in the exercise of the police power, will be sustained.

**D. Even a Broad Grant of Power Such as the Right of Congress to Regulate Interstate Commerce, Can be "Burdened" by the Police Power to Some Extent**

The grant of power relating to "securing . . . the exclusive right to . . . discoveries," by the States to the Federal government, is narrow and limited. In this

context the word "securing" appears to mean "shielding" or "guarding", or "protecting the exclusive right to . . . discoveries." This is in great contrast to the broad grant of power to the Federal government to "regulate" interstate and foreign commerce. Indeed, the very use of the word "regulate" imports a sweeping power of control not even hinted at in the narrow verb "securing" . . . the exclusive right to . . . "discoveries." For the word "regulate" means that Congress can "fix, establish, or control; to adjust by rule, method or established mode; to direct by rule or restriction; to subject to governing principles or laws." *Black's Law Dictionary,* 4th Edition, Page 1451. See *United States* v. *Darby,* 312 U.S. 100, 85 L.Ed. 609, 61 S.Ct. 451, 132 A.L.R. 1430.

Accordingly, with this vast gulf between the meaning of these two very different words, one might think that the States could not affect interstate commerce at all. The contrary, however, is true. Even the broad commerce power conferred upon the Federal government must be accommodated to the state police power to a very considerable extent, and may be "indirectly affected" or "burdened" by State regulation.

This is ably and concisely summarized in *Huron Portland Cement Company* v. *The City of Detroit* (1960), 362 U.S. 440, 4 L.Ed. 2d 852, 80 S.Ct. 813. In that case a corporation engaged in operating federally licensed steam vessels in interstate commerce sought to enjoin the enforcement against it of provisions of the Smoke Abatement Code of the City of Detroit under which the Corporation's steam vessels could not, without undergoing structural alterations, perform necessary

cleaning of their fires within the city. The Michigan Supreme Court affirmed a judgment for the defendant, and on appeal that judgment was affirmed by this Court. This Court held that the intent to supersede the exercise by the State of its police power as to matters not covered by Federal legislation is not to be inferred; and that the object of the Federal inspection statutes was different from the aim of the Detroit ordinance. The purpose of the Federal inspection statutes was to insure the seagoing safety of vessels subject to inspection, while the aim of the Detroit ordinance was the elimination of air pollution. This Court held that the Federal inspection legislation has not at all preempted local action, and repeated the admonition of earlier cases that conflicts between state and Federal regulation are not to be sought out where they do not clearly exist. And finally this Court held that the mere possession of a Federal license *"does not immunize a ship from the operation of the normal incidents of local police power not constituting a direct regulation of commerce."* This Court's opinion per Mr. Justice Stewart concluded:

> *"We cannot hold that the local regulation so burdens the federal license as to be constitutionally invalid."* (Emphasis added.)

**E. Cases Relied on by Petitioner Do Not Support Its Position**

The cases of *Leslie Miller, Inc.* v. *Arkansas* (1956), 352 U.S. 187, 1 L.Ed. 2d 231, 77 S.Ct. 257, and *Johnson* v. *Maryland* (1920), 254 U.S. 51, 65 L.Ed. 126, 41 S.Ct. 16, relied on by Petitioner, do not support its position. Both cases dealt with "the immunity of the instruments of the United States from state control" (352 U.S. 190), something which cannot be said to be pres-

ent in our case. In addition, in *Leslie Miller* v. *Arkansas*, the State had imposed license requirements which "would give the State's licensing board a virtual power of review over the federal determination of 'responsibility' and would thus frustrate the expressed federal policy of soliciting the lowest responsible bidder." In the instant case, however, the requirements with respect to "recognition" of persons by the Patent Office, and those of The Florida Bar with respect to the administration of justice by control of the Courts over the practice of law, relate to wholly different subject matter. The State of Florida has not exerted any "powers of review" over any "federal determination," and no "expressed federal policy" has been "frustrated."

*Kingsland* v. *Dorsey* (1950), 338 U.S. 318, 94 L.Ed. 123, 70 S.Ct. 123, does not support Petitioner's position. Unlike Petitioner, Dorsey was a lawyer, and was disbarred by the Patent Office. His disbarment was upheld by this Court. Petitioner quotes (brief p. 34) from the decision, p. 319, but omits to state that the quotation given related to a *lawyer* practitioner before the Patent Office. Moreover, it is obvious that Dorsey could have been the subject of separate disciplinary proceedings in the jurisdiction of his admission to the Bar. Petitioner can scarcely claim that Dorsey's disbarment by the Patent Office would prevent the bringing of disciplinary proceedings in such jurisdiction, or would be *res judicata* therein. Thus the case shows how different are the two subjects of (a) admission of a person to a State Bar, and (b) "recognition" by the Patent Office.

## POINT EIGHT

### THE THRUST OF PETITIONER'S CLAIM IS TO SEEK TO INJECT A HOST OF LAY PRACTITIONERS INTO THE PRACTICE OF LAW THROUGHOUT THE STATES, TO "THWART THE CONTROL OF THE COURTS OVER THE PRACTICE OF LAW AND IRREPARABLY IMPAIR THE SOUND ADMINISTRATION OF JUSTICE."

The brief of the United States (p. 3-5) contains more than a hint of disruption of the practice of law and the administration of justice in the various States which is the necessary thrust of Petitioner's claim. It is that other laymen would claim that they, too, have federal licenses to practice law in some federal field in every State of the Union, free from the supervision of the State Courts. Thus laymen admitted to practice before various administrative agencies might claim that, in every State, they now have federal licenses to practice tax law, transportation law, government contract law, probate, etc. law relating to Veterans, Immigration law, social security law, agricultural law, banking law, labor law, federal power and natural gas law, tariff law, etc. This would destroy the practice of law as a seamless web; decimate the legal profession; "thwart the control of the Courts over the practice of law, and irreparably impair the sound administration of justice," to quote Chief Justice Vanderbilt in *Stack* v. *P. G. Garage, Inc.* (1951), 7 N.J. 118, 80 A.2d 545, 547. See also *Theard* v. *United States* (1957), 354 U.S. 278, 1 L.Ed. 2d 1342, 77 S.Ct. 1274.

## POINT NINE

### A STRONG BAR IS POSITIVELY ESSENTIAL TO THE PUBLIC WELFARE

It is a fact of no small significance that one of the first acts of dictators such as Hitler, Mussolini, and Castro, upon assuming office, was to decimate the legal profession. And with the decimation of the Bar, there also disappears that protection of the public which the Bar affords—particularly protection of the civil rights of the citizens.

For a strong Bar is itself positively essential to the public welfare. It is the American lawyer who is the bulwark of individual rights in our country, whether these be denominated human rights or property rights. It is he who is the protector of the citizen against oppression, whether from a neighbor or from the government. If the practice of law is to be whittled away, chip by chip, and turned over to laymen and lay agencies, then the public will no longer have the protection which a strong Bar affords, and the public will suffer.

In the leading case of *Rhode Island Bar Ass'n* v. *Automobile Service Ass'n* (1935), 55 R.I. 122, 179 A. 139, where the defendants were held in contempt of court for unlawfully practicing law, the Court, among other things, said:

> "*The bar is an important element of our judicial system,* and all of its members are obligated to govern their professional conduct in full accord with the solemn responsibility which that entails. Under our system of law the most effective guaranty of equal justice to all in the commonwealth is a competent and learned bar composed of men of high personal character who govern their professional conduct at all times by the well known and generally accepted canons of legal ethics. *The lack*

*of such a bar,* or the coexistence with it of an array of individuals or groups operating under deceptive devices and catch-names to mislead the public into the belief that they are intrusting their causes to those learned in the law and competent to serve them, *would inevitably result in a deprivation of justice to many in the state.* In such an atmosphere, there would be a strong tendency for the bar to sink to the level of its unauthorized and unqualified competitors. (Emphasis added.)

As was cogently summarized in *West Virginia State Bar* v. *Earley* (1959), 144 West Va. 504, 109 S.E. 2d 420, 435, *supra:*

"[21, 22] The justification for excluding from the practice of law persons who are not admitted to the bar and for limiting and restricting such practice to licensed members of the legal profession is not the protection of the members of the bar from competition or the creation of a monopoly for the members of the legal profession, but instead the protection of the public from being advised and represented in legal matters by unqualified and undisciplined persons over whom the judicial department of government could exercise slight or no control. Chicago Bar Association v. United Taxpayers of America, 312 Ill. App. 243, 38 N.E. 2d 349; Lowell Bar Association v. Loeb, 315 Mass. 176, 52 N.E. 2d 27; In re Shoe Manufacturers Protective Association, Inc., 295 Mass. 369, 3 N.E. 2d 746; State ex rel. Wright v. Barlow, 132 Neb. 166, 271 N.W. 282; New Jersey State Bar Association v. Northern New Jersey Mortgage Associates, 22 N.J. 184, 123 A. 2d 498; People v. Alfani, 227 N.Y. 334, 125 N.E. 671; State ex rel. Daniel v. Wells, 191 S.C. 468, 5 S.E. 2d 181. The admission to membership in the legal profession is a privilege granted in the interest of the public to those who are morally fit and mentally qualified for the sole purpose of protecting the unwary and

the ignorant from injury at the hands of persons unskilled or unlearned in the law. Tumulty v. Rosenblum, 134 N.J.L. 514, 48 A. 2d 850. The licensing of lawyers is not designed to give rise to a professional monopoly but instead to serve the public right to protection against unlearned and unskilled advice and service in relation to legal matters. Auerbacher v. Wood, 142 N.J. Eq. 484, 59 A. 2d 863. The reason for the requirement that the practice of law be engaged in only by duly licensed practitioners of the law is to establish and maintain a legal standard by which the rights of persons may not be jeopardized or sacrificed by counsel and advice of unlicensed and incompetent persons who give or attempt to give legal advice, prepare documents and pleadings, file and prosecute proceedings and examine witnesses in courts or other tribunals. State ex rel. Hunter v. Kirk, 133 Neb. 625, 276 N.W. 380. *It is essential to the administration of justice and the proper protection of society that* unlicensed persons be not permitted to prey upon the public by engaging in the practice of law. Clark v. Austin, 340 Mo. 467, 101 S.W. 2d 977. The reason laymen are forbidden to engage in the practice of law is that it is detrimental to the public interest for them to represent themselves to the public that they are qualified to do so when in fact they are not so qualified. Liberty Mutual Insurance Company v. Jones, 344 Mo. 932, 130 S.W. 2d 945, 125 A.L.R. 1149.

"In In re Opinion of the Justices, 279 Mass. 607, 180 N.E. 725, 81 A.L.R. 1059, the court said: '*It is indispensable to the administration of justice* and the interpretation of the laws that there be members of the bar of sufficient ability, adequate learning and sound moral character. This arises from the need of enlightened assistance to the honest, and restraining authority over the knavish, litigant. It is highly important, also, that the public be protected from incompetent and vicious prac-

titioners, whose opportunity for doing mischief is wide. It was said by Cardozo, C.J., in People ex rel Karlin v. Culkin, 248 N.Y. 465, 470-471, 162 N.E. 487: "Membership in the bar is a privilege burdened with conditions." One is admitted to the bar "for something more than private gain." He becomes "an officer of the court, and, like the court itself, an instrument or agency to advance the ends of justice. His co-operation with the court" is due "whenever justice would be imperiled if co-operation was withheld." Without such attorneys at law the judicial department of government would be hampered in the performance of its duties. That has been the history of attorneys under the common law, both in this country and in England.' See also Meunier v. Bernich. (La. Court of Appeal), 170 So. 567." (Emphasis added.)

In *State* v. *Perkins* (1934), 138 Kan. 899, 28 P. 2d 765, a person not admitted to the Kansas Bar was ordered to cease and desist from the practice of law. The Court, among other things, had this to say about the importance to the courts and litigants of preserving the integrity of the Bar and prohibiting unauthorized practice:

"The importance to courts and litigants of well-informed trustworthy attorneys at law is well recognized, and frequently has been judicially noticed. Recently, in Re Opinion of the Justices, 279 Mass. 607, 180 N.E. 725, 727, 81 A.L.R. 1059 it was said: '*It is indispensable to the administration of justice and the interpretation of the laws that there be members of the bar of sufficient ability, adequate learning* and sound moral character. This arises from the need of enlightened assistance to the honest, and restraining authority over the knavish, litigant. It is highly important, also, that the public be protected from incompetent and vicious prac-

titioners, whose opportunity for doing mischief is wide.'

"In Re Cannon, 206 Wis. 374, 240 N.W. 441, 445, it was said: 'The relation of the bar to the courts is a peculiar and intimate relationship. The bar is an attache of the courts. *The quality of justice dispensed by the courts depends in no small degree upon the integrity of its bar. An unfaithful bar may easily bring scandal and reproach to the administration of justice and bring the courts themselves in to disrepute.*'

"The opinion contains an exhaustive history of *the development of the bar as an aid in the administration of justice.*

"In Rosenthal v. State Bar Examining Committee, 116 Conn. 409, 165 A. 211, at page 213, it was said:

'The practice of law is not a craft or a trade; it is a profession whose main purpose is to aid in the doing of justice according to law between the state and the individual and between man and man. The occasions upon which an attorney may be required to act touch, in many instances, the deepest and most precious concerns of men, women, and children. They may involve the liberty, the property, the happiness, the character, and the life of his client. Obviously, one not possessing an adequate degree of intelligence and education cannot perform this kind of service, nor should he be permitted to attempt to do so. * * *

'The ultimate purpose of all regulations of the admission of attorneys is to assure the courts the assistance of advocates of ability, learning, and sound character and to protect the public from incompetent and dishonest practitioners.'" (Emphasis added.)

In *Hexter Title & Abstract Co.* v. *Grievance Committee* (1944), 142 Tex. 506, 179 S.W. 2d 946, *supra*,

the Supreme Court of Texas also pointed out that it would be useless from the standpoint of the public interest to require high standards of the Bar if persons not members could practice the arts of the profession. The Court, among other things, said:

> "*The practice of law is a matter of vital interest to the public.* The lawyer is primarily engaged in the protection and preservation of the liberties and property rights of the people and the administration of justice among them, which is one of the primary purposes of good government. As society has become more compact the law has necessarily become more complex, requiring increased skill in its application. The Legislature in recognition of this fact has from time to time increased the prelegal and legal attainments required for admission to the Bar. These safeguards have been deemed necessary by the Legislature to protect the public against the loss of their liberty and property rights through ill advice from incompetent practitioners. It is readily apparent that it would serve no useful purpose to require high standards of efficiency for members of the legal profession if those who have not attained these standards of efficiency are to be permitted to practice the arts of the profession. Also, the relation between attorney and client is a most intimate one, involving the highest degree of confidence and trust, and in which, as a consequence, there is almost unlimited opportunity for fraud on the part of the attorney. It is apparent, therefore, that those who are to be entrusted with the opportunities of such a position should be possessed of a high degree of integrity. In recognition of this the Legislature has set up machinery for the establishment of canons of ethics for the profession, and the disbarment of those guilty of fraudulent or dishonorable practice or malpractice. *Again, it would be useless to establish high standards of morality for members*

> *of the profession if those who are not members, and therefore not bound by such canons, could practice the arts of the profession.* The State has a vital interest in the regulation of the practice of law for the benefit and protection of the people as a whole, and the legislation above referred to was adopted in furtherance of a wholesome public policy." (Emphasis added.) (pp. 947-8)

In *Clark* v. *Reardon* (1937), 231 Mo. App. 666, 104 S.W. 2d 407, *supra*, where a non-lawyer was adjudged in contempt of court for unlawfully practicing law, the Court, among other things, said:

> "This court has inherent powers to guard the administration of the law in its jurisdiction. That is the primary power. The regulation of attorneys is but secondary and supplemental. It is our duty to see that the law is administered by none except those deemed qualified, as evidenced by a license; and by them only as long as they remain ethically qualified. *It would be illogical* to say that we have the inherent power to revoke the license of, or to punish, one who was once deemed, by competent authority, to be fitted to advise the public in legal matters, and *also to hold that such inherent authority does not extend far enough to protect the public and the reputation of the law, the courts, and the ministers of the law and the courts, against one never considered qualified to advise in and practice the law.* 'To deny the power of the court to deal with such offenders would be tantamount to a destruction of the power itself.' People ex rel. Illinois State Bar Association et al v. People's Stock Yards State Bank, 344 Ill. 462, loc. cit. 473, 176 N.E. 901, 906; Clark et al v. P. H. Coon, supra." (p. 412) (Emphasis added.)

In *State* v. *Barlow* (1936), 131 Neb. 294, 268 N.W. 95, where an information charging a non-lawyer with the

unlawful practice of law was sustained, the Court, among other things, said:

> *"This court possesses inherent power to protect itself and its officers from any unlawful interference wit hits functions as a court.* This it may do, not only for the purpose of protecting the court and its officers, but in the interest of the public at large to prevent it from being exploited and injured by one unlawfully assuming to act as an officer of the court. *There are many instances where persons' rights have been jeopardized and sacrificed because of following the counsel and advice of unlicensed persons, giving or attempting to give legal advice."* (p. 98-99) (Emphasis added.)

In *Grievance Committee, etc.* v. *Coryell* (Tex. Civ. App. 1945), 190 S.W. 2d 130, a notary public who was drawing real estate conveyances and giving opinions on titles was held to have been engaged in the unauthorized practice of law. The Court, among other things, said:

> "The controlling purpose of all laws, rules and decisions with regard to the licensing of lawyers is to protect the public against persons inexperienced and unlearned in legal matters from attempting to perform legal services. Wrong legal advice by a layman is equally injurious whether given for or without consideration or compensation. *The instances are legion where litigation could have been avoided and expense saved had the deed, mortgage, will, or contract involved been drawn by an attorney instead of a layman inexperienced and unlearned in the legal effect of the language used in such instruments.* The paramount purpose of licensing practitioners of law is the protection of the people from the inexperienced and unlearned in law who attempt to practice law without first qualifying themselves in the courses of study and

as to the character requirements prescribed for lawyers. So, independently of any statutory provisions as to what may constitute practice of law, the court has the duty and the inherent power to determine in each case what constitutes the practice of the law, and to inhibit persons from engaging in the practice of law without having obtained a license to do so." (Emphasis added.) (p. 131)

There are many cases showing injury to the public through the incompetence or other deficiencies of unauthorized practitioners in the real estate field.

In *In re Baker* (1951), 8 N.J. 321, 85 A. 2d 505, where non-lawyers were held to have unlawfully engaged in the practice of law by drafting legal instruments, Chief Justice Vanderbilt said:

"We do not consider it to be necessary that a person be engaged in a 'course of conduct' over a period of time in order to be engaged in the practice of law. To impose such a test would result in the wholly absurd situation of this court being called upon to determine how many wills a layman may draw, or how many 'clients' he may advise, or, more bluntly, how many times he may defraud the public by his impositions before he be deemed to be engaged in the practice of law and thus subject to the superintending power of this court. We are of the firm opinion that a single act, e.g., the preparation of a will or the drawing of a power of attorney, may in appropriate circumstances constitute the practice of law. There is no sound reason why the doing of a single act calling for the skills and learning of an attorney does not constitute the practice of law just as most certainly the performance of a single operation by a surgeon constitutes the practice of medicine. *The amateur at law is as dangerous to the community as an amateur surgeon would be.*" (Emphasis added.) (pp. 513-14)

"The soundness of his position is the more evident if it is borne in mind that the *underlying purpose of regulating the practice of law is not so much to protect the public from having to pay fees to unqualified legal advisors as it is to protect the public against the often drastic and far-reaching consequences of their inexpert legal advice.*". (Emphasis added.) (p. 514)

## CONCLUSION

Petitioner is no more entitled, by virtue of his "recognition" by the Patent Office, to practice law relating to patents in Florida—that is, outside the courtroom, in Florida—than he is to practice law relating to patents inside the courtroom, that is, in this Court and the other federal Courts, and in the United States Court of Customs and Patent Appeals.

The judgment should be affirmed.

Respectfully submitted,

*For The American Bar Association:*

F. Trowbridge vom Baur, Washington, D. C.
H. H. Perry, Jr., Albany, Georgia
Wayland B. Cedarquist, Chicago, Illinois
Jonathan F. Ells, Winsted, Connecticut
Raymond Reisler, Brooklyn, New York
Warren H. Resh, Madison, Wisconsin
R. Carleton Sharretts, Jr., Baltimore, Maryland
George H. Turner, Lincoln, Nebraska
Melvin F. Adler, Fort Worth, Texas

Dated: 6 February, 1963

# APPENDIX A

## Constitution of the United States

Art. I, Sec. 8, cl. 8. The Congress shall have power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

• • • • • • • • • • •

Art. I, Sec. 8, cl. 18. The Congress shall have Power . . . To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.

• • • • • • • • • • •

Art. VI, cl. 2. This Constitution, and the Laws of the United States which shall be made in Pursuance thereof and all treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, anything in the Constitution or Laws of any State to the contrary notwithstanding.

---

Amendment X. The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the states respectively, or to the people.

## Constitution of the State of Florida

Art. II. The powers of the government of the State shall be divided into three departments: Legislative, Executive and Judicial. No person properly belonging to one of the departments shall exercise any powers appertaining to either of the other departments, except in cases expressly provided for by this constitution.

Art. V, § 1. The judicial power of the State of Florida is vested in a supreme court, district courts of appeal, circuit courts, Court of Record of Escambia County, criminal courts of record, county courts . . . and such other courts, including municipal courts, or commissions, as the Legislature may from time to time ordain and establish.

§ 23. The supreme court shall have exclusive jurisdiction over the admission to practice law and the discipline of persons admitted. . . .

*Section 2, Article 2, of the Integration Rule of The Florida Bar, 31 F.S.A.:*

"No person shall engage in any way in the practice of law in this state unless such person is an active member of The Florida Bar, in good standing, except that a practicing attorney of another state, in good standing, who has professional business in a court of record of this state may, upon motion, be permitted to practice for the purpose of such business only, when it is made to appear that he has associated and appearing with him in such business an active member of The Florida Bar."

**Acts of Congress**

**(1) In effect when Petitioner was admitted to practice before the Patent Office in 1928:**

Section 487 of the Revised Statutes, As Amended by § 3 of the Act of February 18, 1922, 42 Stat. 390, 35 U.S.C. § 11 (1946):

The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and

are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. And the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

Section 483 of the Revised Statutes (As Amended by § 12 of the Act of February 14, 1903, 32 Stat. 830, 35 U.S.C. § 6 (last sentence) (1946)

The Commissioner of Patents may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**(2) Currently in effect:**

35 U.S.C. §§ 31, 32, 33:

§ 31. The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

§ 32. The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney, shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

§ 33. Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

35 U.S.C. § 6 (last sentence):

The Commissioner of Patents may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, in the conduct of proceedings in the Patent Office.

**Rules of Practice of the United States Patent Office in Patent Cases**

**(1) Rules of Practice, U. S. Patent Office, Edition of February 1, 1929:**

ATTORNEYS

17. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent patent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims. The office can not aid in the selection of an attorney.

A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled

to represent applicants before the Patent Office in the presentation and prosecution of applications for patent. The names of persons in the following classes will, upon their written request, be entered upon this register:

(*a*) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and who shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing, and who shall file proof that he is possessed of the legal and technical qualifications enumerated in paragraph (*b*).

(*b*) Any person not an attorney at law who is a citizen or resident of the United States and who shall file proof to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

* * * * * * * * * *

(*e*) The Commissioner may require proof of qualifications other than those specified in paragraph (*a*) and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

(*f*) Any person or firm not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

(*g*) No person not registered or entitled to recognition as above provided will be permitted to prosecute applications before the Patent Office.

(*h*) Every attorney registered to practice before the United States Patent Office shall submit to the Commissioner of Patents for approval copies of all proposed advertising matter, circulars, letters, cards, etc., intended to

solicit patent business, and if it be not disapproved by him and the attorney so notified within 10 days after submission, it may be considered approved.

Any registered attorney sending out or using any such matter, a copy of which has not been submitted to the Commissioner of Patents in accordance with this rule, or which has been disapproved by the Commissioner of Patents, shall be subject to suspension or disbarment.

Before his name may be entered on the Register of Attorneys every applicant must subscribe and swear to an oath prescribed by the Commissioner of Patents and pay to the Patent Office a registration fee of $5.

18. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members be named in such power of attorney.

19. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third.

20. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and when so revoked the office will communicate directly with the applicant, or another attorney appointed by him. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney. An assignment will not operate as a revocation of the power previously given, but the assignee of the entire interest may be represented by an attorney of his own selection.

21. Parties or their attorneys will be permitted to examine their cases in the attorneys' room, but not in the rooms of the examiners. Personal interviews with examiners will be permitted only as hereinbefore provided. (See rule 13).

22. (*a*) Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and returned by his direct order.

(*b*) Complaints against examiners and other officers must be made in communications separate from other papers and will be promptly investigated.

(*c*) The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising, or who shall guarantee the successful prosecution of any application for patent or the procurement of any patent, or by word, circular, letter, or advertisement shall make any false promise or misleading representation, or who uses the name of any Member of either House of Congress or of any officer of the Government in advertising his business. (Act approved April 27, 1916.) The reasons for any such suspension or exclusion shall be duly recorded. And the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

(*d*) The Commissioner of Patents may appoint a Grievance Committee or Grievance Committees of those admitted to practice before the Patent Office. The Commissioner may refer to such committee such complaints against those admitted to practice before the Patent Office as he deems advisable. The committee or a subcommittee thereof may investigate and determine whether the complaint is well founded and, if so, present charges for suspension or exclusion from practice.

**(2) Current Rules of Practice, 37 C.F.R. §§ 1.31, 1.341—1.348:**

§ 1.31. Applicants may be represented by an attorney or agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. The Patent Office cannot aid in the selection of an attorney or agent.

§ 1.341. Registration of attorneys and agents. A register of attorneys and a register of agents are kept in the Patent Office on which are entered the names of all persons recognized as entitled to represent applicants before the Patent Office in the preparation and prosecution of applications for patent. **Registration in the Patent Office under the provisions of these rules shall only entitle the persons registered to practice before the Patent Office.**

(a) *Attorneys at law.* Any attorney at law in good standing admitted to practice before any United States Court or the highest court of any State or Territory of the United States who fulfills the requirements and complies with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of attorneys.

(b) *Agents.* Any citizen of the United States not an attorney at law who fulfills the requirements and complies with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of agents.

(c) *Requirements for registration.* No person will be admitted to practice and registered unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office. In order that the Commissioner may determine whether a person seeking to

have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has actively served for four years in the examining corps of the Patent Office.

(d) *Registration of firms.* Any firm, the individual members of which are each registered on the register of attorneys, may have its name entered upon the register of attorneys. Any firm, one of the individual members of which is registered on the register of agents and each of the remaining individual members are registered either on the register of attorneys or the register of agents, may have its name entered on the register of agents. If the membership of the firm is changed, application must be made for registration of the firm as changed.

(e) *Foreign patent attorneys and agents.* Any foreign patent attorney or agent not a resident of the United States who shall file proof to the satisfaction of the Commissioner that he is registered and in good standing before the patent office of the country in which he resides and practices, and is possessed of the qualifications stated in paragraph (*c*) of this rule, may be registered on the register of agents as entitled to represent applicants located in such country before the United States Patent Office in the presentation and prosecution of applications: *Provided*, That the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent Office. Such registration shall continue only during the period that the conditions specified obtain.

(f) *Government employees.* Officers and employees of the United States who are disqualified by statute (18 U.S.C. 281) from practicing as attorneys or agents in proceedings or other matters before Government departments or agencies, may not be registered, and if any registered attorney or agent becomes such an officer or employee, his name on the register shall be endorsed as inactive during the period of such employment, but officers or employees whose official duties require the preparation and prosecu-

tion of applications for patent may be registered (on compliance with these rules) or recognized to practice, to the extent necessary to carry out their official duties.

(g) *Former examiners.* No person who has served in the examining corps of the Patent Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending in any examining division in which he served, on the date he left said division; and (2) not to prepare or prosecute nor to assist in any manner in the preparation of prosecution of any application of another filed within two years after the date he left such division, and assigned to such division, without the specific authorization of the Commissioner. Associated and related classes in other divisions may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph.

(h) *Oath and registration fee.* Before his name may be entered on the register of attorneys or on the register of agents, every applicant for registration must, after his application is approved, subscribe and swear to an oath prescribed by the Commissioner of Patents and pay the prescribed registration fee. (See § 1.21.)

(i) *Committee on Enrollment.* The Commissioner may establish a Committee on Enrollment to receive and act upon applications for registration to practice before the Patent Office, to conduct and supervise the examinations provided for in paragraph (c) of this rule, to maintain the registers and to perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary; or such functions may be performed by designated officials of the Patent Office. Any action of such committee or official may be reviewed by the Commissioner.

§ 1.342. Limited recognition. Any person not registered and not entitled to be recognized under § 1.341 as an attorney or agent to represent applicants generally may,

upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent a specified application or applications, but this limited recognition shall not extend further than the application or applications specified.

§ 1.343. Persons not registered or recognized. No person or firm not registered or specifically recognized as provided in § 1.342 will be permitted to prosecute applications of others before the Patent Office.

§ 1.344. Professional conduct. Attorneys and agents appearing before the Patent Office must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts of the United States.

§ 1.345. Advertising. (a) The use of advertising, circulars, letters, cards, and similar material to solicit patent business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Patent Office or may be suspended, excluded or disbarred from further practice.

(b) The use of simple professional letterheads, calling card, or office signs, simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends, and insertion of listings in common form (not display) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories shall not be considered a violation of this rule.

(c) *No agent shall, in any material specified in paragraph (b) of this section or in papers filed in the Patent Office, represent himself to be an attorney, solicitor or lawyer.*

§ 1.346. Signature and certificate of attorney. Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits required of applicants). The signature of an attorney

or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief there is good ground to support it; and that it is not interposed for delay. When an applicant or party is represented by a registered firm, such papers must carry the signature of the firm, or the signature of an individual member of the firm or an individual registered attorney or agent employed by the firm and duly authorized to sign on behalf of the firm in addition to the firm name, and the certification constituted by the signing or presentation of the paper shall be a certification by and on behalf of the firm and by the individual.

§ 1.347. Removing names from registers. Attorneys, agents, and firms, registered to practice before the Patent Office, should notify the Office of any change of address for entry on the register, by letter separate from any notice of change of address filed in individual applications. The Office may address a letter to any person or firm on the registers, at the address of which separate notice for the register was last received, for the purpose of ascertaining whether such person or firm desires to remain on the register. The name of any person or firm failing to reply and give the information requested within a time limit specified will be removed from the register, and the names so removed published in the Official Gazette. Any name so removed may be reinstated, either on the register of attorneys or the register of agents, as may be appropriate.

§ 1.348. Suspension or disbarment proceedings. Except as otherwise provided, proceedings for suspension, disbarment, or exclusion from practice are before a Commissioner.

(a) *Investigating and prosecuting officer.* The duties of investigation, preparing charges, collecting and presenting testimony, and presenting a case for suspension, exclusion from practice or disbarment shall be performed by the Solicitor of the Patent Office or, at his direction, by a designated law examiner or other person, and neither the Solicitor nor such law examiner or other person shall participate in any manner in the decision of the case. If, upon investigation of a complaint or other informa-

tion concerning an attorney or agent, it shall appear to the Solicitor that grounds for suspension, exclusion from practice, or disbarment exist, he shall prepare and forward the necessary notice and statement.

(b) *Notice of proceedings.* Proceedings for suspension or disbarment shall be instituted by the Solicitor by mailing to, or otherwise serving on, the respondent a notice of such proceeding with a statement of the charges against him, at the same time forwarding a copy to the Commissioner. It shall be the duty of the respondent to answer the charges as specified in paragraph (c) of this rule.

(c) *Answer.* The respondent's answer shall be filed in writing with the Commissioner within thirty days from the time the notice is served on the respondent, or within such extension of time as may be allowed by the Commissioner for good cause shown. The answer shall be under oath. Failure to answer within the time allowed will be taken as an admission of the charges. The respondent in his answer should specifically admit or deny every material allegation of fact in the statement of charges; every allegation not denied shall be deemed admitted, unless the respondent states that he has no knowledge thereof sufficient to form a belief, which statement shall be considered a denial. Any special matters of defense shall be stated affirmatively in the answer. False statements in the answer may be made the basis of supplemental charges.

(d) *Hearing.* (1) Unless the Commissioner finds the answer sufficient to dispose of the charges, he will set the case for hearing before him, notifying the respondent and the Solicitor of the place, day and time of commencement of the hearing. Evidence as to the matters in issue may be submitted at the hearing, the testimony of witnesses being presented orally, under oath and reported.

(2) The hearing may be advanced and continued by the Commissioner, as far as may be deemed convenient and proper.

(3) Depositions for use at the hearing in lieu of personal appearance of witnesses may be taken by either the Solicitor or the respondent on application to and with the written consent of the Commissioner within such times and under such conditions as the Commissioner may prescribe.

(e) *Hearing officer.* The Commissioner may, in his discretion, delegate the conduct of the hearing to a hearing or trial examiner who shall be the presiding officer and who shall make a recommended decision.

(f) *Administrative Procedure Act.* Proceedings shall be governed, in matters not specially set forth herein, by the provisions of the Administrative Procedure Act, 60 Stat. 237; 5 U.S.C. 1001-1011, which may be applicable. (Emphasis added.)

**Current Trademark Rules of Practice of the U. S. Patent Office, 37 C.F.R. §§ 2.11—2.18:**

REPRESENTATION BY ATTORNEYS AND AGENTS

AUTHORITY NOTE: Rules 2.11 to 2.19 interpret or apply 66 Stat. 705; 35 U.S.C. 31, 32.

2.11 *Applicants may be represented by an attorney.* The owner of a trademark may file and prosecute his own application for registration of such trademark, or he may be represented by an attorney or other person authorized to practice in trademark cases. The Patent Office cannot aid in the selection of an attorney or agent.

2.12 *Persons who may practice before the Patent Office in trademark cases.* (a) Any person who is a member in good standing of the bar of the Supreme Court of the United States or of the highest court of any State, Territory, or the District of Columbia, and is not under any order of any court suspending, enjoining, restraining, disbarring, or otherwise restricting him in the practice of law, may represent others before the Patent Office in trademark cases. No application for recognition to practice in trademark cases by attorneys at law is required.

(b) Nonlawyers: *Persons who are not attorneys at law* as specified in paragraph (a) of this section *are not recognized to practice before the Patent Office in trademark cases, except that persons not attorneys at law who were recognized to practice under the rules prior to January 1, 1959* (former rule 100.42), and who in fact practiced in *connection with applications for registration filed since* July 5, 1947, *will be recognized as agents to continue practice in trademark cases in the Patent Office.*

(c) Foreign attorneys and agents: Any foreign attorney or agent not a resident of the United States who shall file proof to the satisfaction of the Commissioner that he is

registered and in good standing before the patent or trademark office of the country in which he resides and practices, may be recognized to represent applicants located in such country before the United States Patent Office in the presentation and prosecution of trademark applications: *Provided*, That the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent Office. Such recognition shall continue only during the period that the conditions specified obtain.

**(d) Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law.**

(e) No persons other than those mentioned in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Patent Office in trademark cases. Any person may appear for himself, or for a firm of which he is a member, or for a corporation or association of which he is an officer and which he is authorized to represent, if such person, firm, corporation, or association is a party to the proceeding.

(f) Persons otherwise entitled to be recognized to practice under this section may, nevertheless, be refused recognition for cause.

2.13 *Professional conduct.* Attorneys and other persons appearing before the Patent Office in trademark cases must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts.

2.14 *Advertising.* (a) The use of display advertising, circulars, letters, cards, and similar material to solicit trademark busines, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Patent Office or suspended or excluded from further practice.

(b) The use of simple professional letterheads, calling cards, or office signs; simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends, and insertion of professional cards, listings in common form (not dis-

play) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories are not prohibited.

(c) *No agent shall, in any material specified in paragraph (b) of this section or in papers filed in the Patent Office, represent himself to be an attorney, solicitor or lawyer.*

2.15 *Signature and certificate of attorney or agent.* (a) Every paper filed by an attorney at law or other person representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney at law or other person except those papers which are required to be signed by the applicant or party (such as the application itself and verifications required of applicants, registranst or others). The signature of an attorney at law or such other person to a paper filed by him, or the filing of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief there is good ground to support it; and that it is not interposed for delay.

(b) When an applicant or party is represented by a firm composed of attorneys at law, papers may carry the signature or name of the firm, with the signature of a member or associate of the firm.

(c) When an applicant or party is represented by a firm (registered in accordance with rule 1.341 (d) of this chapter) which includes one or more nonlawyers, papers may carry the signature or name of the firm, but in any case, they must carry the signature of an individual member of the firm or of an individual employee of the firm who is registered in the Patent Office and who is authorized to sign on behalf of the firm, the certification referred to in paragraph (a) of this section shall, in either case, be a certification by and on behalf of the firm and by the individual.

2.16 *Suspension or exclusion from practice.* The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office any person, attorney, or agent shown to be incompetent or disreputable, or guilty of unethical or unprofessional conduct or gross misconduct, or who refuses to comply with the rules and regulations, or who shall, with intent to

defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the Patent Office, by word, circular, letter, or in any other manner. The reasons for any such suspension or exclusion shall be duly recorded. Proceedings for suspension, disbarment or exclusion from practice are conducted as provided in rule 1.348. (See 35 U. S. C. 1952, sec. 32 for review of the Commissioner's action by the District Court of the United States for the District of Columbia.)

2.17 *Recognition for representation.* (a) When an attorney at law acting in a representative capacity appears in person or signs a paper in practice before the Patent Office in a trademark case, his personal appearance or signature shall constitute a representation to the Patent Office that under the provisions of these rules and the law he is authorized, and qualified under rule 2.12 (a), to represent the particular party in whose behalf he acts. Further proof of authority to act in a representative capacity may be required.

(b) Before any nonlawyer will be allowed to take action of any kind in any application or proceeding, a written authorization from the applicant, party to the proceeding, or other person entitled to prosecute such application or proceeding must be filed therein.

2.18 *Correspondence held with attorney or agent.* Correspondence will be held with the attorney at law, or other recognized person who shall have filed his written authorization, representing the applicant or party to a proceeding. Double correspondence will not be undertaken, and if more than one attorney at law appears or more than one agent is authorized, correspondence will be held with the one last appearing or appointed, as the case may be, unless otherwise requested.

2.19 *Revocation of power of attorney or authorization of agent.* Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Commissioner; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent Office will notify the person affected of the revocation of his authorization. (Emphasis added.)

## APPENDIX B

### The Inherently Legal Character of The Acts Enjoined by The Florida Supreme Court

A. In General:

The Court below permanently enjoined the Petitioner from the following activities in this State:

1. using the term "patent attorney" or holding himself out to be an attorney at law in this State in any field or phase of the law (we recognize that the respondent according to the record before us has already voluntarily ceased the use of the word "attorney");
2. rendering legal opinions, including opinions as to patentability or infringement on patent rights;
3. preparing, drafting and construing legal documents;
4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;
5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and
6. otherwise engaging in the practice of law.

First, Petitioner has admitted activities falling within the scope of each of the items enjoined, although his brief contests the injunctive provisions of each of these paragraphs with the exception of the first.

*Paragraph 2:* More particularly, he admits (R. 7) having rendered legal opinions, including opinions as to patentability or infringement upon patent rights as prohibited in Paragraph 2. But he seeks to justify this on the theory that anyone holding himself out to the public as being entitled to prepare applications must, during the course of those activities, reach conclusions on patentability and infringement and communicate those conclusions to his client before preparing the application.

We agree with Petitioner that the rendering of such opinions to members of the public is an inherent part of preparing patent applications. In the next section, B, we will develop the factual necessity for rendering legal opinions on patentability, as well as on numerous other legal questions, prior to the preparation of an application for a patent. And we will show how such decision will, if made in error (or, indeed, if made in ignorance of the fact that a legal problem exists), materially affect the ultimate strength and utility of the patent to be issued upon such an application. All in all, the giving of any legal opinion, the implementation of which will materially affect the legal rights and status of the opinionee, is the practice of law.

*Paragraph 3:* This paragraph is directed to the Petitioner's admitted activities (R. 7) in connection with the drafting of such legal documents as patent assignments and patent license agreements. Petitioner apparently does not contest this portion of the decree. We do not think extended argument is necessary to demonstrate that these are legal documents.

*Paragraph 4:* This paragraph goes to Petitioner's admitted activities (R. 7) in holding himself out in Florida as qualified to prepare applications for letters patent and amendments thereto. As we will develop in more detail in the next section, B, every stage of the preparing of a patent application, and every stage of the preparation of amendments thereto, necessarily involve an evaluation of complex legal questions which go not only to the question of whether or not the Applicant will get a patent but, even more important, go to the strength and breadth of that patent and hence the strength and breadth of the protection that the client can expect to obtain therefrom.

*Paragraph 5:* This paragraph is designed to prevent Petitioner from preparing patent applications and related

acts in the State of Florida. In our next section, B, we will develop the keenly-legal character of patent applications and the process of their preparation.

*Paragraph 6*, the omnibus clause, encompasses all other aspects of the practice of law set forth in the record but which are not specifically covered by the other portions of the injunction. Apparently petitioner does not contest it. One main item undoubtedly enjoined by this paragraph is trademark practice in Florida. For the Petitioner himself admits (R. 8) to his continued practice on trademark matters arising in Florida.

In addition to this admission of being engaged in trademark practice, the fact is that Petitioner has caused himself to be "recognized" by the Commissioner of Patents under Trademark Rule 2.12(b)* and now insists that such "recognition" gives him the right to engage in such practice in Florida, even though the same Trademark Rule states:

> "(d) Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts in the jurisdiction when performed as the unauthorized practice of law."

There can be no real question that the practice of trademark cases is the practice of law. Such practice includes, in every instance, a determination of whether a given mark is likely to be confused with other registered trademarks, and, in at least many instances, includes conducting inter partes proceedings before the Patent Office wherein that question is fully litigated.

Accordingly, paragraph 6 enjoined, among other things, Petitioner's trademark practice in Florida.

---

* See card index of persons admitted to practice under Trade Mark Rule 2.12(b). Room 205, Dept. of Commerce Annex, 18th and K N.W., Washington, D.C.

## B. The Preparation of Patent Applications Constitutes the Practice of Law:

### 1. *In General:*

That the preparation of patent applications constitutes the practice of law should be clear, first, from the very nature of a patent granted by the United States Patent Office. It is a formal legal document constituting a contract between the patentee and the United States in which, as consideration for a disclosure of an invention to the public, the patentee is granted by the government the right to exclude others from making, using and selling the subject matter of the patent for a limited period of time. Indeed, the basic character of a United States Patent has been recognized by the United States Supreme Court. Thus in *Topliff v. Topliff, et al.*, (1892), 145 U.S. 156, 171, the Court stated:

> "The specification and claims of a patent particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy— * * * "

In *National Carbon* v. *Western Shade Cloth Co.*, (7 Cir., 1937) 93 F. 2d 94, 96 the Court stated:

> "Specifications of the patent, including the description and the claims, constitute a contract between the public and the patentee, under which the public, through the government, agrees that, in consideration of the inventor's disclosure of his teaching and his grant of the right to use the same after his monopoly expires, he shall be protected in his exclusive use during the life of the patent."

See also *Strong-Scott Mfg. Co.* v. *Weller, et al.*, (8 Cir., 1940) 112 F. 2d 389, 394:

> "Letters patent are contracts between the United States and the patentee and should, like other contracts, be construed as a whole, not for the purpose of

varying their claims, but in order to ascertain the actual intent of the parties to the contract."

A thorough knowledge of the law including the patent statutes and the many decisions interpreting these statutes is essential to the preparation of this legal instrument, this contract, namely a United States letters patent.

It has been argued that the preparation of a patent application can be likened to the preparation of a deed. (Brief of American Association of Registered Attorneys and Agents, Amicus Curiae, p. 10). Assuming the validity of this analogy, the application thereof to the facts by the American Association of Registered Attorneys and Agents is incorrect. The Association claims that the patent attorney or agent should be compared to the surveyor who determines the metes and bounds. This is completely incorrect. The inventor gives the metes and bounds of his invention to the attorney as the surveyor gives the metes and bounds of a piece of property to the attorney. Thereafter, it is the attorney who prepares the deed or the patent application in accordance with the law, describing the property (either real property or an invention) as required by the law. The person preparing the patent application does not discover the metes and bounds. He is not the inventor. These facts are disclosed to him by the inventor. Like any attorney, he must be able to understand the terms used by the client, the inventor. But he is not an inventor any more than an attorney preparing a deed is a surveyor, or an attorney preparing a pension plan contract is an expert on pension plans, or an attorney preparing a labor contract is an expert on industrial relations, or an attorney trying a law suit requiring medical testimony is a doctor. In each case, the attorney draws the facts from the experts, the inventor, the surveyor, the pension planner, the industrial relation expert or the doctor, and presents them in the form required by law to protect his client's interests.

Thus it seems obvious that the preparation of these "*most difficult legal instruments*" is the practice of law. What are the legal determinations involved in the preparation of a patent application? Briefly stated, many may be summarized as follows:

(1.) Is there patentable subject matter? (35 U.S.C. 101)

(2.) Does the invention constitute a patentable advance over the art? (35 U.S.C. 103)

(3.) Has there been a statutory bar, a public use or a printed publication? (35 U.S.C. 102)

(4.) Who is the inventor of the patentable invention?

(5.) Who owns title to the invention?

(6.) Does the patent application contain a clear and concise description of the invention? (35 U.S.C. 112)

(7.) Do the claims in the patent application particularly point out and distinctly claim the patentable subject matter? (35 U.S.C. 112)

(8.) Does the oath and drawing comply with the statutes? (35 U.S.C. 113, 115)

(9.) Is the inventor entitled to an earlier filing date that should be asserted? (35 U.S.C. 119, 120)

Legal conclusions on these matters should be made before an application is filed. Later, many of these questions are raised by the Patent Office and new decisions reached in view of facts discovered by the Patent Office, which should be anticipated to the fullest extent practicable before the application is filed. Many additional questions are raised, such as:

1. What facts should be presented to the Patent Office by affidavit to establish a date of invention, commercial success, the state of the art, etc.?

2. Should an appeal be filed, and, if so, to what tribunal?

3. What facts should be included in a preliminary statement in an interference?

4. What motions should be prepared and filed in an interference?

5. What testimony should be taken in an interference proceeding?

Even after a patent has issued, difficult questions arise as to possible further proceedings in the Patent Office:

1. Should a portion of the patent be disclaimed?

2. Should a reissue application be filed?

The matter in which these questions pervade the entire subject of preparation of a patent application can only be fully understood by a more detailed examination of the proceeding leading to the issuance of letters patent.

2. *Legal Questions Requiring Decision Before a Patent Application Is Prepared:*

At the outset, before even a preliminary draft of a patent application can be prepared, the practitioner has many difficult legal questions to consider. First, he must determine whether the subject matter of the invention is in fact, patentable subject matter (35 U.S.C. 101). Is the subject matter a process, machine, manufacture or composition of matter which can be patented? Or, is it a mental process or merely an idea which are not patentable subject matter? Is the subject matter a writing which should be protected under the copyright laws? Is the subject matter a design which should be protected with a design patent rather than a utility patent? Finally, the practitioner must decide whether his client's interest would best be served by maintaining the invention a secret and relying on the laws relating to trade secrets, rather than applying for a patent. It seems reasonable to question whether a practitioner who is admittedly barred from

holding himself out as qualified to advise clients on the law of trade secrets and unfair competition can make an objective decision on which way his client should proceed.

After deciding these important questions, the practitioner must determine whether the invention constitutes a patentable advance over the state of the art (35 U.S.C. 103). This Court in *A & P Tea Co.* v. *Supermarket Corp.* (1950) 340 U.S. 147, held that the question as to whether an invention is patentable is a question of law.

Other difficult legal questions must also be answered before the decision is reached to file a patent application. Frequently, the subject matter of inventions are made, used or sold prior to the filing of an application, and the practitioner must determine whether that manufacture, use or sale constitutes a prior use which would amount to a statutory bar against the grant of a patent (35 U.S.C. 102). Or, is the manufacture, use or sale merely an experimental use under the authority which would not constitute a bar (see *Egbert* v. *Lippman* (1881) 104 U.S. 333). Likewise, a description of the invention may have been published raising the question as to whether that publication constitutes a "printed publication" which would constitute a statutory bar to the grant of a patent (35 U.S.C. 102).

An application must be filed in the name of the true inventor of the subject matter of the application (35 U.S.C. 111). Frequently, two or more persons work in the development of an invention. The question then arises as to which of these individuals is, in fact, the inventor or whether they were, in fact, joint inventors. In other words, in whose name should the application be filed? Which of the workers was responsible for the inventive concept and which was simply carrying out instructions? It is obvious that the knowledge on the part of the practitioner of the decisions on these questions is essential if his client's rights are to be protected. For a recent example of a patent being held invalid because a person deemed to be a joint

inventor was not listed as an inventor in the application papers see: *John Blue & Co.* v. *Dempster Milk Mfg. Co.*, 172 F. Supp. 23 (D. Neb. 1958), affirmed on other grounds 275 F. 2d 668 (8th Cir. 1960).

At this stage, it is frequently necessary for the patent practitioner to advise his client as to his rights in the invention in view of an employer-employee relationship in which the client is involved. Does the employer or employee own the invention? If the client is a corporation, should an assignment be filed with the patent application? If the client is the employee, does the client have the right to file a patent application without the consent of his employer? In many instances, there is a written contract of employment, and the patent practitioner must interpret this contract and give legal advice as to its effect before an application can be applied. These important questions as to title to the invention involve the application of State law.

3. *Legal Questions Arising During The Preparation Of An Application*

After determining these many preliminary legal questions, the actual writing of the application must be done. The patent statutes (35 U.S.C. 112) require that the specifications contain a written description of the invention in "full, clear, concise and exact terms" as to enable any person skilled in the art to which it pertains, to use the invention. In writing the patent application, the patent practitioner must constantly keep in mind the requirements of this statute as it has been interpreted by the Patent Office and by the Courts in innumerable decisions. What specific examples should be given? What is the best mode contemplated by the inventor for carrying out his invention? Is the specification sufficiently definite?

The patent statute (35 U.S.C. 112) also requires that the specification conclude with one or more claims "par-

ticularly pointing out and distinctly claiming the subject matter" of the invention. The claims of a patent define the scope of protection granted by the patent. In drafting these claims, the patent practitioner must refer to his earlier conclusion as to the patentable nature of the invention. Do the claims as written define the patentable invention previously determined? Are the claims sufficiently definite as required by law? Do the claims find support in the specification as required by the authorities? Are the claims limited to the actual patentable invention, or do they overclaim the invention?

The patent statute (35 U.S.C. 113) requires that a drawing be supplied with the application if "the nature of the case admits." The patent practitioner must determine whether a drawing is required by the statute, and, if so, what the drawing should show. The patent statute (35 U.S.C. 115) also requires an oath by the applicant. This oath must be prepared by the patent practitioner and a determination made that the oath, as prepared, complies with the requirement of the law.

If the inventor is deceased or incapacitated, the practitioner must fully comply with the provisions of 35 U.S.C. 117 pertaining to the filing of patent applications by the inventor's legal representatives. This includes establishing the legal identity of an executor, administrator, guardian or conservator under the State law of the jurisdiction in question and presenting suitable proofs of the representatives' compliance with the State law to the Patent Office.

4. *Legal Questions Arising During The Prosecution Of An Application Which Should Be Anticipated Before The Application Is Filed*

After a patent application is filed, there are one or more actions by the Patent Office in which it reviews the sufficiency of the application, cites prior patents and rejects all or some of the claims on the basis of these patents.

To the fullest extent possible, these actions should be anticipated and prepared for before the application is filed.

To each of these actions, the patent practitioner, after consulting his client, may file a reply (known generally as an "Amendment"). In these replies, the claims in the application are frequently amended and an argument, in the nature of a brief, is presented. In amending the claims, the practitioner must again decide whether the claims are directed to patentable invention. He must decide whether the claims, as amended, particularly point out the invention. In any amendment of the claims, the practitioner must keep clearly in mind the legal doctrine of "File Wrapper Estoppel," which has been established by the United States Supreme Court and followed by the lower Federal Courts. In the argument or brief which forms a part of the amendment, many points of law are argued and decisions in support of these points are cited, and the facts of the particular case are analyzed in view of these decisions. The points of law argued may encompass any or all of the matters referred to in connection with the preparation of the patent application, whether the patent application contains patentable subject matter, whether the invention is patentable over the art cited by the Patent Office, whether the claims are sufficient, whether the specification clearly discloses the invention claimed, etc.

In drafting such amendments, the practitioner must be sure to resist the Patent Office's suggestion that the claims be amended to add a recitation of environmental structure to the original recitation of structures which are believed to be the "heart of the invention." A failure to do so can cause an otherwise valid patent to be held unenforceable and, indeed, barred by "misuse" when the same is invoked against an infringer who confines his activities to copying the "heart of the invention" See *Mercoid Corp.* v. *Mid Continent Investment Co.* 320 US 661 (1944)

Frequently, during the prosecution of an application, the practitioner will find it necessary to file an affidavit of the inventor to establish that the invention was made prior to the effective date of a patent cited by the Patent Office. Again, this is something for which the practitioner should be prepared to the fullest extent possible, before the Application is filed. The preparation of these affidavits involves the application of the facts of the particular case to establish legal concepts such as the date of conception of the invention, the date of the reduction to practice of the invention, and diligence in reducing the invention to practice. These concepts have been established by a myriad of decisions by the Patent Office tribunals, the United States Supreme Court, and the lower Federal Courts. The preparation of such affidavits certainly constitutes the practice of law.

If the Patent Office finds that two or more persons are claiming the same invention, it will institute an adversary proceeding to determine which of the rival claimants was the first inventor and is entitled to a patent covering that subject matter. These proceedings are known as "Interferences," and, again, they should, where possible, be anticipated and prepared for before the application is filed. The preparation of preliminary statements which, in effect, are pleadings in the adversary proceeding is the first step of an interference. The inventors set out in the preliminary statement the facts which they believe establish their right to invention if the facts are proved. To file such a preliminary statement, the practitioner must consider the legal definitions of conception, reduction to practice and diligence, and apply these legal concepts to the facts before him.

In an interference, a procedure is provided wherein one party to the interference may move to dissolve the interference or add counts to the interference. The motions are decided on briefs and oral arguments in which authorities are cited in support of the various positions of the parties.

All such motions require knowledge of the requirements of the patent statutes as interpreted by the decisions of the Patent Office tribunals and the Federal Courts.

After preliminary motions have been disposed of, evidence is taken by deposition to establish the facts on which the parties base their claim to the invention. Such depositions are taken pursuant to rules promulgated by the Commissioner of Patents (37 C.F.R. §§ 1.271 to 1.278 and 2.285, 1.286), which rules substantially parallel the Federal Rules of Civil Procedure pertaining to the taking of depositions for use in the Federal Courts.

A thorough knowledge of trial practice, including a complete familiarity with the rules of evidence, is required if the practitioner is to satisfactorily protect the rights of his client during such depositions.

After the depositions have been completed, briefs are filed by each party citing the law and the evidence in support of their respective positions. An oral hearing is also had (37 C.F.R. 1.256). A formal decision is rendered, from which an appeal lies to the Court of Customs and Patent Appeals (35 U.S.C. 141-144).

As just noted, the interference proceedings involve the taking of a record which may subsequently be reviewed by a Court. This is likewise true of the prosecution of a patent application which does not become involved in an interference, because if the Examiner finally rejects an application, the applicant can appeal to the Patent Office Board of Appeals (35 U.S.C. 134), and, if the decision by that Board is unfavorable, the applicant can proceed by appeal to the Court of Customs and Patent Appeals (35 U.S.C. 141). The record in the Patent Office constitutes the whole and unalterable record before the Court of Customs and Patent Appeals.

Thus throughout the prosecution of a patent, a record is made which is binding on the inventor in later proceed-

ings, either in the Patent Office, or in the Courts. As stated by Mr. Justice Fuller in *John Dobson* v. *James Lee*, 137 U.S. 258, 34 L. Ed. 652, 655 (1890): "Nor, in the light of these protracted proceedings in the Patent Office, can the applicant be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake." The presentation of this evidence both by affidavit and by actual testimony, and the application of legal principles to the facts so established, clearly constitutes the practice of law.

5. *Legal Questions Arising In The Amendment And Correction Of Patents.*

The prosecution of a patent application may not end with the issuance of the original patent. The patent laws provide several remedies in the Patent Office for amendment and correction of patents.

A patent may be issued through inadvertence, accident, or mistake, which is wholly or partly inoperative or invalid by reason of a defective specification or by reason of the patentee claiming more or less than he had a right to claim. The patent laws (35 U.S.C. 251) provide for the reissue of such defective patents. Determination of the question whether a client can or should file an application for reissue patent involves the determination of difficult questions of law. First, it must be determined whether the original patent is defective within the meaning of the section of the patent laws pertaining to reissue patents and the decisions interpreting the same. Second, the facts giving rise to the defect must be considered to determine whether they are legally sufficient to justify the granting of a reissue patent under the statute and the decision. Again, all these possibilities should be considered before the application is completed.

The patent statutes also provide for a disclaimer when a claim is invalid without any deceptive intention on the

part of the patentee (35 U.S.C. 253). Determination of the question as to whether a client should file such a disclaimer again involves the determination of difficult questions of law.

The patent statute also provides for a correction of a patent for misjoinder or nonjoinder of inventors (35 U.S.C. 256). Determination of the question whether a client should correct an application for these reasons again involves difficult questions of law. Who, under the law as applied to the facts of the case, is the inventor? Again, these questions must be determined before the application is completed.

The foregoing clearly shows that throughout the steps resulting in the preparation of a patent application, the practitioner is constantly required to study the law, interpret that law and apply that law to the facts of the particular case. It is utterly impossible for a patent practitioner to fulfill his responsibilities to his client in the preparation of a patent application without full knowledge and full utilization of the laws and the authorities interpreting those laws.

C. In Like Manner, Engaging In Trademark Practice Before The Patent Office Constitutes The Practice Of Law

Before preparing an application for a trademark registration, the practitioner must first determine whether the symbol in question has been used in a manner which the law contemplates as a trademark usage and then must decide whether that mark has been used in "commerce" (15 U.S.C. 1051) which is otherwise defined as "all commerce which may lawfully be regulated by Congress" (15 U.S.C. 1127).

Next the practitioner must conclude whether the Patent Office will be likely to deem the mark in question as barred from registration by any of the provisions of 15 U.S.C.

1052, i.e., whether it is descriptive, mid-descriptive, geographically descriptive, primarily merely a surname or, most important of all, likely to cause confusion with an already registered mark.

If the mark is not being actually used by the organization which wishes to file the application, a legal opinion must be reached as to whether or not the user's use will be deemed a usage which inures to the benefit of the proposed Applicant. 15 U.S.C. 1055

Finally, determination must be made as to whether the mark is to be registered as a trademark (15 U.S.C. 1052) for a service mark (15 U.S.C. 1053) or as a collective mark or certification mark, (15 U.S.C. 1954), and whether the application should solicit registration on the Principal Register (15 U.S.C. 1057(a)) or on the Supplemental Register (15 U.S.C. 1091).

If, after the application has been drafted and filed in proper legal form, the same is rejected by the Examiner, an "amendment" must be filed with such briefs and points and authorities as are required to persuade the Examiner to withdraw the rejection.

Once *ex parte* approval of the application has been obtained, the mark is published for opposition. (15 U.S.C. 1062(a)). If any party opposes that registration (15 U.S.C. 1063), an *inter parte* proceeding is set up (15 U.S.C. 1067-1070) with the proceedings approximately following the modes of procedure of the trial and Federal court, i.e., with motions, discovery proceedures, the taking of testimony by deposition during trial periods, final briefing and oral arguments. See Trademark Rules of Practice of the Patent Office, Rules 2.117-2.136 (37 C.F.R. 2.117-2.136.)

Trademark practice before the Patent Office also includes interference proceedings (15 U.S.C. 1066), between copending applications for registration which involve identical or similar marks, and cancellation proceedings (15

U.S.C. 1064) wherein the validity of registered marks are challenged and these proceedings follow the format of opposition proceedings as discussed hereinabove (15 U.S.C. 1067).

Moreover, trademark practice before the Patent Office includes the preparation and filing of suitable periodic affidavits for maintaining valuable registrations on the Register (15 U.S.C. 1058(a)), 15 U.S.C. 1065), and the preparation and filing of such affidavits as are required to obtain renewal of a valuable registration after its 20th anniversary (15 U.S.C. 1060).

Finally, practice before the Patent Office includes the preparation of such assignment documents as will fully comply with both the property laws of the states in question and the requirements of the Patent Office under its Rule 2, 185 (37 C.F.R. 2.185) and its interpretations of 15 U.S.C. 1060.

Practice before the Patent Office in trademark cases by citizens of the United States is limited to attorneys at law in good standing admitted to the highest court of their respective jurisdictions, Trademark Rule 2.12 (37 C.F.R. 2.12) and to non-lawyers like the instant petitioner who have established that they were recognized to practice in trademark cases, and did practice in trademark cases, during the period between July 5, 1947 and Jan. 1, 1959.

In short, practice by citizens of the United States is limited to lawyers and certain non-lawyers allowed under a very limited "grandfather clause." The portions of the Rule relating to the limited recognition of non-lawyers are immediately followed by Rule 2.12(d) which states specifically that:

> "Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts regarded in the jurisdiction where performed as the *unauthorized practice of law*." (Emphasis added.)

a provision which implicitly recognizes that all of the activities discussed hereinabove are subject to prohibition by a state as the practice of law, and makes it explicit that "recognition" by the Commissioner must not be used as an excuse by a practitioner who is found, by the locality in question, to have engaged in the unauthorized practice of law.

Considering that every decision made in the course of proceedings before the Patent Office in trademark cases are legal decisions, and that all advices rendered on those proceedings constitute legal advice, the promulgation of which is the practice of law, there can be no real doubt that every aspect of the Petitioner's practice before the Patent Office in trademark cases constitutes the practice of law within the meaning of that term as applied by the Supreme Court.

# APPENDIX C

## HISTORY OF STATUTES AND REGULATIONS ON ADMISSION TO PRACTICE BEFORE THE PATENT OFFICE

The statute primarily dispositive of the scope of Congressional regulation in this case is section 3 of the Act of February 18, 1922, 42 Stat. 390, amending section 487 of the Revised Statutes. We shall show that this statute is the culmination of Congressional efforts commencing in 1861 to provide the Commissioner of Patents with unquestionable authority to prevent or exclude untrustworthy or incompetent persons from representing inventors in prosecuting applications for patents in the Patent Office. The statutes, legislative history and Patent Office regulation, hereinafter set forth, do not reveal any attempt by Congress to regulate the practice of law relating to patents or to authorize the Commissioner of Patents to authorize persons to practice law relating to patents in Florida.

### 1. The Act of March 2, 1861: First Congressional Enactment: Power of the Patent Commissioner to Refuse to Recognize Patent Agents for Gross Misconduct

Section 8 of the Act of March 2, 1861, 12 Stat. 247, provided in relevant part as follows:

> "and for gross misconduct he [the Commissioner of Patents] may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal of the President of the United States."

The origins of this language are obscure. The manager of the bill in the House stated that this and other sections of the bill "merely change details and adjust the machinery of the office . . ." (Cong. Globe, Feb. 6, 1861, Mr. Niblack) Nor did the contemporaneous administrative regulations evidence any purpose to go beyond exclusion of patent agents for gross misconduct. They merely provided that "Any person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant

upon filing a proper power of attorney," and that for "gross misconduct the Commissioner may refuse to recognize any person as a patent agent . . ." (Rules 127 and 130, Rules and Regulations for Proceedings in the Patent Office, Aug. 1, 1869.)

**2. The Act of July 8, 1870: Restatement of Power to Exclude Patent Agents for Gross Misconduct and Grant of Power To Regulate Proceedings in the Patent Office by Rules "Not Inconsistent with Law"**

By the Act of July 8, 1870, 16 Stat. 198, Congress substantially revised the patent laws. The Patent Office was assigned to the Department of Interior, claims of invention were required to be made in writing, and a comprehensive scheme of judicial review and judicial remedies was provided. Section 17 of this act (16 Stat. 200) continued the Commissioner's power of exclusion of patent agents for gross misconduct granted by the 1861 Act, but made exercise of that power subject to the approval of the Secretary of the Interior in lieu of that of the President under the the 1861 Act. In addition, section 19 of the 1870 Act (16 Stat. 200) provided that "the Commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the patent office." Legislative history reveals no significant change in the authority of Commissioner of Patents contemplated by the grant of this rule-making power (Cong. Globe, April 14, 1870, Mr. Jenckes, Chairman House Patent Comm.); and indeed the statutory limitation that such rules be "not inconsistent with law" negatives any possible implication that Congress intended to authorize the Commissioner to license laymen to practice law anywhere incident to representing applicants for patents before the Patent Office.

In 1874 most of this 1870 Act was codified without substantive change in the Revised Statutes. Section 17, re-

lating to the refusal to recognize patent agents for gross misconduct, became section 487 of the Revised Statutes; and the rule-making power of section 19 was codified as section 483 of the Revised Statutes.

Provision of the rule-making power in 1870 did not soon produce significant changes in the Commissioner's regulations on recognition of patent agents. By 1879 inventors were urged to exercise great care in employing honest and skillful patent agents. Rule 17 of the Patent Office Rules (Dec. 1, 1879 Ed.) provided as follows:

> 17. *Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant*, upon filing a proper power of attorney. As the value of patents depends largely upon the careful preparation of the specifications and claims, the assistance of competent counsel will, in most cases, be of advantage to the applicant; but the value of their services will be proportionate to their skill and honesty, and too much care cannot be exercised in their selection. The office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making selections. It will, however, be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time or with broader claims than others. (Emphasis added.)

### 3. 1897-1908: Development of a Register of Patent Attorneys Pursuant to Section 483 of the Revised Statutes

No further significant changes to the regulations relating to the recognition of patent agents were made until 1897. In that year in the aftermath of the Wedderburn case (12 App. D.C. 485), Rule 17 of the Rules of Practice was revised to establish a "register of attorneys" in the Patent Office "on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent." All persons entered on the register were registered as "patent attorneys," without regard to whether

they were attorneys at law, a practice that was continued until 1938 when separate registers were established prospectively for "patent attorneys" (attorneys at law) and "patent agents." Also in 1897 Rule 17 for the first time stated that persons not attorneys at law in good standing seeking entry on the register must furnish evidence of character and qualifications. As so revised (see Rules of Practice Dec. 1, 1897 Ed.), Rule 17 provided as follows:

> Rule 17 of the Rules of Practice, approved June 18, 1897, is amended to read as follows:
>
> 17. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims. The office can not aid in the selection of an attorney.
>
> *A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent.* The names of persons in the following classes will, upon their written request, be entered upon this register.
>
> (*a*) Any person who at the date of the approval of the present Rules of Practice, June 18, 1897, was engaged as attorney or agent in the active prosecution of applications for patent before this office, or had been so engaged at any time within five years prior thereto and is not disbarred, or is or was during such period a member of a firm so engaged and not disbarred, provided that such person shall, if required, furnish information as to one or more applications for patent so prosecuted by him.
>
> (*b*) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(c) *Any person who has been regularly recognized as an attorney or agent to represent claimants before the Department of the Interior* or any bureau thereof and is in good standing, provided that such person shall furnish a statement of the date of his admission to practice as such attorney or agent, and shall further show, if required by the Commissioner, that he is possessed of the necessary qualifications to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(d) *Any person not an attorney at law who shall file a certificate* from a judge of a United States, State, or Territorial court, duly authenticated under the seal of the court, *that such person is of good moral character and of good repute and possessed of the necessary qualifications to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.*

(e) Any firm which at the date of the approval of the present Rules of Practice was engaged in the active prosecution as attorneys or agents of applications for patents before the Patent Office or had been so engaged at any time within five years prior thereto, provided such firm or any member thereof is not disbarred, provided the names of the individuals composing the firm are stated, and provided, also, that such firm shall, if required, furnish information as to one or more applications prosecuted before the Patent Office by them.

(f) Any firm not entitled to registration under the preceding sections which shall show that the individuals composing the firm are each and all recognized as patent attorneys or agents or are each and all entitled to be so recognized under the preceding sections of this rule.

The Commissioner may demand additional proof of qualifications and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

> Any person or firm not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.
>
> *After January 1, 1898, no person not registered in accordance with this rule will be permitted to prosecute applications before the Patent Office.* (Emphasis added.)

By 1908 the portion of Rule 17 that was later applicable to Petitioner's entry on the register as a "patent attorney" had been revised to require the filing of "proof to the satisfaction of the Commissioner that such person [not an attorney at law in good standing] is of good moral character and repute and possessed of the necessary legal and technical qualifications* to enable him to renedr applicants

---

* During the period 1922 to 1934 both attorneys at law and laymen seeking admission to practice before the Patent Office ordinarily submitted affidavits of experience in patent work under the personal supervision of a registered practitioner. While this practice was not formalized in Rule 17 until 1933 (See Rule 17(b), Aug. 1, 1933 ed), the defects of the affidavit system were noted by Commissioner Robertson (Annual Report of the Secretary of Commerce (1933) p. 159):

> "The present system of registrations, based upon the submission of affidavits, is neither reliable nor satisfactory, and the result is that attorneys may have their names entered on the register who, in many instances, at least, are not qualified to render inventors the valuable advice and assistance which they are entitled to receive."

As a result, effective June 1, 1934 (441 O.G. 253), Rule 17 was amended prospectively to require all persons seeking admission to practice before the Patent Office to take written examinations.

for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office." (Rule 17(b), April 13, 1908 Ed.)

From this recital it is apparent that the system of registering patent agents evolved during the period 1897-1908. These steps were taken under the rule-making power of section 483 of the Revised Statutes, as were expressly recited in the revision of Rule 17 published in 1908. While it does appear that the purpose of the register system was to improve the means of excluding persons of questionable character on qualifications from representing applicants before the Patent Office in the presentation and prosecution of patent applications, it nowhere appears, nor may it reasonably be implied, that with the adoption of this register system the Commissioner sought to establish a licensing power of nation-wide sweep under which persons were to be authorized by virtue of the entry of their names on the register in the Patent Office to practice law to the extent that such practice involved the presentation and prosecution of patent applications. Moreover, had the Commissioner attempted to do this, plainly he would have overstepped the limits sections 483 and 487 of the Revised Statutes placed on his authority to act in this field.

#### 4. The Act of February 18, 1922, Amending Section 487 of the Revised Statutes

Section 487 of the Revised Statutes was amended by section 3 of the Act of February 18, 1922, 42 Stat. 390, to provide as follows:

> "Sec. 487. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the *recognition* of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of

good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. *And the Commissioner of Patents may*, after notice and opportunity for a hearing, *suspend or exclude*, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prosepective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine." (Emphasis added.)

The words used in this revision of § 487 were essentially copied from two substantially identical 1884 statutes in which Congress sought to protect veterans of the Civil War having pension, back pay, bounty, lost horses and other claims before the Interior or Treasury Departments from the depredations of claims agents. See § 5 of the Act of July 4, 1884, 23 Stat. 98, 101, 5 U.S.C. § 493, § 3 of the Act of July 7, 1884, 23 Stat. 236, 258, 5 U.S.C. § 261.

At a hearing before the House Committee on Patents, the Chairman of the Committee, Judge Davis of Tennessee, asked Commissioner Robertson to explain the necessity for the revision of section 487 of the Revised Statutes proposed by section 3 of the bill (Hearings Before the House Committee on Patents on H.R. 210, 67th Cong., 1st Sess. 14-17 (1921)):

"Mr. Davis. Mr. Commissioner, in view of the fact that this bill in section 3 prescribes the methods of

recognition of attorneys and also under certain conditions of suspending or excluding them from practice before the Patent Office, and in view of the fact that you and the former commissioner and various others have urged the importance of this enactment, but also in view of the further fact that, as the old members recall, there was considerable opposition to it on the part of certain patent firms here in Washington, I wish you would make a brief explanation to the new members of the necessity for that provision.

"Mr. Robertson. *The necessity for this provisions does not come from the necessity of protecting* wealthy corporations from unscrupulous attorneys. It is manifest they can take care of themselves, but the *poor inventor* in the agricultural districts of the country or in the mountainous districts, *many of whom* are 10 to 15 or 20 miles away from the railroad *are particularly susceptible to being fleeced by the unscrupulous attorney.** He has even been led on to file applications on so-called inventions that have been patented 40, 50, or hundreds of times before, and being located in the wilderness, so to speak, he has not any chance to tell, as the city man has, whether he is being fleeced. For one example, former Commissioner Ewing told of one attorney who had induced applicants to file applications on nut locks. There were 4,000 patents already granted on nut locks, and, as a result of this advertising, Commissioner Ewing stated that this particular attorney had filed almost 100 applications for different inventors in different parts of the country for nut locks, inducing them to believe that they would get patents for them. *Section 3 is designed to prevent a thing like that.*

"Mr. Lanham. What part of this section 3 is new matter? What part is amended?

"Mr. Robertson. So far as concerns patents, it is all new matter. *So far as concerns pensions, not one word is new. I will be glad to submit to the chairman the act of July 4, 1884 [5 U.S.C. § 191], which is identical with section 3,* except it refers to pension claims instead of patents, and to the Secretary of the Interior instead of to the Commissioner of Patents. Hence this same

* All practitioners before the Patent Office, whether or not attorneys at law, were registered as "patent attorneys" prior to 1938.

provision, word for word, has been in force for 25 years, applying to every attorney practicing before the Pension Office, *but the patent attorneys have been given free scope*. One of my predecessors under the administration just passed promulgated a rule, which he could do only with the approval of the Secretary of the Interior, Mr. Lane. *Under this new rule the advertising attorneys were compelled to submit their advertising to him for approval before they sent it out.* That same rule have been in force in the Pension Office for 25 years, *but the advertising attorneys are very much opposed to such supervision or such censorship*, as they call it, in the Patent Office . . . *It was for that purpose section 3 was designed.* Let me say that that section is heartily indorsed by the bar associations, and is only fought by a few attorneys who do not wish the supervision of the Patent Office, and yet that supervision can only be exercised under the authority of the Secretary of the Interior. The Commissioner of Patents cannot disbar, himself: he can only recommend disbarment, and it has to be approved by a Cabinet officer, the Secretary of the Interior, before it becomes effective."

* * * * * * * * * *

"Mr. Davis. Mr. Commissioner, with respect to the question of Mr. Lanham as to the change in the present law, as I understand it, *the present statute is very general, simply authorizing the suspension or exclusion of practitioners who are guilty of gross misconduct, and that by reason of the situation and the necessities, a previous Commissioner of Patents adopted some rules and regulations of practice, and some of these attorneys took the position that that was unauthorized, that there was no existing law authorizing him to make any rules or regulations. So this is simply to enlarge upon the original statute and make it more specific so that no question can be made*, and this applies, as Mr. Robertson has said, and has been the law with regard to practice before the Pension Office, without criticism apparently, since 1884.

"Mr. Robertson. *Correct.*"

* * * * * * * * * *

"Mr. Davis. As Mr. Robertson suggested, I do not think that those fellows who are engaged in this bad practice will fare as well in a regular court as they have been before the commissioner, because I think he would be more lenient with them. That is your view?

"Mr. Robertson. That is the experience. *The men are allowed to do things before the Patent Office that any court in the land would disbar them for forthwith.* I know your experience on the bench in Tennessee tells you that they would not be allowed to do half the things they do before the Patent Office.

"Mr. Davis. To get the matter clear before the new members, as I understand, *it is not the desire of your office to prevent legitimate advertising by attorneys, but you do want to prevent deception and fraud.*

"Mr. Robertson. The Patent Office has looked upon advertising upon the part of the young Washington attorney as almost a necessity, because his prospect for clients is the whole territory of the United States, and he has to advertise his business, and therefore the Patent Office will not be and has not been against any advertising that is fair and honest. It *simply wants to compel the practitioners to observe common honesty and not to deceive your constituents and induce them to file applications and pay them fees when they cannot render proper service in return.*" (Emphasis added.)

That the State courts are unable to prevent the solicitation of patent business not involving the practice of law by laymen through false or misleading advertising was pointed out at an earlier hearing by Commissioner Robertson and Assistant Examiner Russell (Hearings before the House Committee on Patents on H.R. 5011, 5012, 7010, 66th Cong., 1st Sess. 278-81 (1919):

"The Chairman. *It seems to me there ought to have been some effort made to clean up the situation, and I think it needs a cleaning up.* Members of Congress from day to day and from week to week are solicited by certain patent attorneys, or so-called patent attorneys, to distribute their literature, to solicit business for them, and it seems to me there ought to be a

clean-up; but I cannot understand why under present conditions a man who is guilty of gross misconduct—I cannot understand why the Patent Commissioner would hesitate a moment, or anybody else would hesitate, about exposing that man.

"Mr. Russell. One reason, I think, why he has hesitated to do it is because there are so many of that kind. It is not a matter of killing a few mosquitoes; it is disinfecting a marsh that is necessary.

"The Chairman. All the more reason why the thing ought to be done, even if it was in the shape of a dragnet.

"Mr. Johnston. *What is the practice now? Suppose a man is accused of misconduct, a practicing attorney of the patent bar, what is the first thing that happens? Who is he accused to, the Patent Commissioner?*

"Mr. Russell. I think the accusation is brought to the Patent Commissioner.

"Mr. Johnston. And has he got the authority to hear and determine the matter?

"Mr. Russell. I think he has.

"Mr. Robertson. Subject to the approval of the Secretary of the Interior.

"Mr. Johnston. That is the status now?

"Mr. Robertson. The law gives him power to disbar for gross misconduct, subject to the approval of the Secretary of the Interior.

"Mr. Johnston. *Just a moment—now, hasn't the court of which this man is a member also got jurisdiction?*

"Mr. Russell. *He is not a member of any court, sir—of the bar; no, sir.*

"Mr. McDuffie. *He is not a regular member of the bar?*

"Mr. Robertson. *No, sir.*

* * * * * * * * *

"Mr. McDuffie. *There is no question about a lawyer being disbarred* if he wrote and circulated a document of this kind [indicating] to get business." (Emphasis added.)

In the House debate of March 5, 1920, on the predecessor bill (H.R. 11984, 66th Cong.) containing the identical amendment to section 487 of the Revised Statutes, the limited purposes of the revision were further revealed by the following discussion:

> "Mr. Ramseyer. Does section 4 change existing law in any respect; and if so, in what way?
> "Mr. Davis of Tennessee. Well, *that is simply an amplification and a more detailed provision with regard to the admission of patent attorneys and their exclusion for misconduct.* (59 Cong. Rec. 3912.)
>
> • • • • • • • • • •
>
> "Mr. Cannon. What is the fee of the patent attorney?
> "Mr. Nolan. We make no attempt to regulate the fees of patent attorneys. We do make some attempt in this bill to put them under the control of the Commissioner of Patents, so that he can stop any improper practices.
> "Mr. Cannon. . . . I am under the impression from the number of letters I get . . . that if there was some way to have patent attorneys who would be fair and square, much money might be saved to people who are not able to afford the expense. I do not know that the gentleman has any suggestion to make along that line, and I do not know that my suggestion is worth anything. You say that the Commissioner of Patents is to watch the attorneys who merely want to get the money without regard to whether the patent is worth a snap or not?
> "Mr. Nolan. We are giving greater power to the Commissioner of Patents to admit men who are all right or disbar men who are guilty of improper practices.
> "Mr. Cannon. In order to become a patent attorney, does a man have to go through an examination? Does he have to establish good character and all that kind of thing? Attorneys who practice law have to do that.
> "Mr. Nolan. To the satisfaction of the Patent Commissioner. (59 Cong. Rec. 3926)
>
> • • • • • • • • • •

"Mr. Goodykoontz. . . . Mr. Chairman, can you tell us whether or not it is necessary to employ a patent lawyer in order to patent an idea?

"Mr. Nolan. It is not necessary at all . . . *the fact of the matter is that there is no standard or requirement for a man to be admitted to practice in the Patent Office, except the permission of the Commissioner.*

"Mr. Goodykoontz. Does the Patent Office provide technical experts, or men who are capable of putting down in correct words a statement of the essential facts upon which a patent may be predicated, without any special fee being paid by the applicant?

"Mr. Nolan. No; but they furnish blanks that any intelligent man can fill out and forward to the Patent Office . . . A general practice has grown up, however, in this as in all other lines where specialists are needed, of employing patent lawyers, who are in most instances men skilled in a technical way as well as in patent law.

• • • • • • • • • •

"Mr. Newton of Minnesota. Is it not a fact, however, as a practical matter, that it is almost necessary to retain a patent lawyer in order to obtain a patent or copyright?

"Mr. Nolan. In order to get action, yes; so that it is really in the interest of the inventor to retain a patent lawyer who will give him proper attention.

"Mr. Newton of Minnesota. And get it immediately when he wants it.

"Mr. Nolan. Exactly, and we are trying in this bill to give more power to the Commissioner of Patents, so that he can better control those who are attempting to exploit inventors. (59 Cong. Rec. 3927)

• • • • • • • • • •

"Mr. Caraway. *I am speaking about these so-called patent lawyers. Of course, it is a fiction to talk about them as lawyers, but when you hire one*, then you have to hire another one to find out what the first one did. That has been my experience. If this law will do anything to suppress the great horde of so-called patent lawyers who live off the people who think they have ideas, I am certainly for it, and I am for a commissioner with backbone enough to shut them out." (Emphasis added.) (59 Cong. Rec. 3928)

In 1952 Congress codified the patent statutes in Title 35 of the U. S. Code as positive law. Section 483 was codified without significant change as the final sentence of 35 U.S.C. § 6, and section 487 was codified as 35 U.S.C. §§ 31 and 32. While sections 31 and 32 somewhat changed the language of § 487, the Committee reports stated that there "has been no change in substance in these sections." S. Rep. No. 1979, H.R. Rep. No. 1923, 82d Cong., 2d Sess., 1952 U.S. Code Cong. & Admin. News, p. 2398.

From this recital of the legislative history of § 487 and its restatement as 35 U.S.C. §§ 31, 32 there can be no doubt that all Congress intended was to remove any question of the Commissioner's housekeeping power to deny recognition to any person who engaged in false or misleading advertising relating to patents, and to provide for the exercise of the power of exclusion at the level of the Commissioner without resort to the Secretary of Interior. The only reference to the practice of law was in recognition of the inability of the State Courts to prevent out of state practitioners, many of whom operated in Washington, D. C., from engaging in fraudulent advertising on a nation-wide basis, and in recognition of the power of the State Courts to disbar any attorney at law within their jurisdiction who solicited patent legal work. On this showing it cannot be held that Congress intended to oust State regulation of the practice of law relating to patents.